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KAMPALA INTERNATIONAL UNIVERSITY LAW JOURNAL is the official journal of the School of Law, Kampala International University. It is a peer-reviewed journal providing distinctive and insightful analysis of legal concepts, operation of legal institutions and relationships between law and other concepts. It is guided in the true academic spirit of objectivity and critical investigation of topical and contemporary issues resulting from the interface between law and society. The result is a high-quality account of in-depth assessment of the strengths and weaknesses of particular legal regimes with the view to introducing reforms. In furtherance of the requirements of advanced academic scholarship, the Journal places high premium on originality and contribution to knowledge, plain and conventional language, and full acknowledgment of sources of information among other things. It is superintended by a Board of respected academics, lawyers, and other legal professionals.

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Scope

Kampala International University Law Journal (KIULJ) is the official Journal of the School of Law, Kampala International University, Uganda. It is a peer-reviewed Journal providing an objective and industry focused analysis of national and international legal, policy and ethical issues. The Journal publishes well researched articles that are in sync with sound academic interrogation and professional experience on topical, legal, business, financial, investment, economic and policy issues and other sectors.

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FROM THE EDITORIAL SUITE

The primary objective of the **KAMPALA INTERNATIONAL UNIVERSITY LAW JOURNAL (KIULJ)** is to provide a platform for a robust intellectual discourse, through the publication of incisive and insightful articles and other contributions from a variety of scholars, jurists and practitioners across jurisdictions. The desire to accomplish this objective guides the choice of the materials being presented to the reading public in every edition. The peer review and editing processes of the papers that are finally selected for publication are equally influenced largely by the pursuit of this goal.

To this end, articles from seasoned scholars and practitioners in each edition address a wide spectrum of issues from different branches of the law, such as, International Criminal Law, Law of International Institutions, Environmental Law, Human Rights Law, Medical Law, Oil and Gas Law, Constitutional Law, Corporate Governance to mention but a few. You will, no doubt, find these scholarly works a worthy contribution to knowledge in their respective fields.

On behalf of the Editorial Board, I wish to appreciate all our reviewers, internal and external, for their constructive criticisms, comments and suggestions. These go a long way to enrich the quality of the papers published in this Journal. The various contributors who painstakingly addressed the observations and suggestions of the reviewers, thus facilitating the achievement of the purpose of the review process also deserve our commendation.

We also, with a grateful heart, acknowledge the interest our teeming readers have continued to show in the succeeding editions of the journal just as we assure them of our readiness to give them the best always. We equally thank our editorial consultants for their useful advice and comments that have contributed to the continuous improvement of the quality of the journal. Legal practitioners and scholars are hereby informed that contributions to our journal are received on a rolling basis. They should feel free to send in their manuscripts and ensure they comply with the submission guidelines as spelt out in the Call for Papers obtainable from the journal's website (www.kiulj.kiu.ac.ug). All contributions should be addressed to the Editor-in-Chief and forwarded to the email addresses supplied in this edition.

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OWNERSHIP OF INTELLECTUAL PROPERTY RIGHTS IN WORK RELATIONS UNDER OAPI: A BRIEF SURVEY

KELESE GEORGE NSHOM (PhD)^{*} & NDUKONG MINETTE
NFORKWE^{**}

Abstract

Ownership of intellectual property created during employment has always been a contentious issue since employers usually claim ownership of such rights for one reason or the other. Through doctrinal analysis, the paper demonstrates that modern intellectual property regimes have rules which determine who owns intellectual property created in work relations. It is revealed that in principle, ownership is recognised on the creator or inventor or whoever registers it. However, such ownership could be transferred by the creator to the beneficiary. Beside these general rules are specific rules of ownership which apply to different intellectual property rights. In any case, if the employee is not to enjoy the fruits of his invention, he must be compensated for intellectual property rights claimed by the employer.

Keywords: Ownership – IPRs – employment – work relations

Introduction

In today's knowledge-based global economy, most inventions, designs and copyrighted works can be created by various groups of persons such as contractors, employees or subcontracted manpower through their employers' Research and Development activities¹. Most frequently, development, research and creative activities are performed by employees. This means that a significant number and probably a majority of intellectual property rights (IPRs)² are created in a work or employment relationship³.

Intellectual property rights broadly mean the legal rights which result from intellectual activity in the industrial, scientific, literary and artistic fields⁴. It is a bundle of legally recognised rights when ideas or inventions are protected⁵. The holder/owner of an intellectual property right has a legal capacity to authorise or

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¹ Gupta V.K. & Krishnan K. S (2000), "Employer vs Employee Inventions: IPR Issues in R&D Organisations: National Institutes of Science", *Technology and Development Studies, Marg, New Delh, journal of intellectual property*, Vol.5, p 245.

² Hereinafter abbreviated IPRs.

³ Chandler P .A, (1992), "Employee's Inventions: Outstanding Compensation", *Journal of Business Law* 600, p.34.

⁴ WIPO (2001), *Intellectual Property Handbook*, Policy, Law and Use, Geneva, p.13.

⁵ Sati-Salmah S. & Olivia De Vega S. (2014), "The importance of intellectual property for SMEs; Challenges and moving forward", *UMK Procedia, Malaysia*, p. 2.

prevent others from acting in a certain way with respect to that property. Some of these rights include patents⁶, trademarks⁷, trade secrets⁸, industrial design⁹, copyrights¹⁰, etc.

With respect to the international intellectual property rights system, there is a global mechanism for the protection of intellectual property rights. However, international IPRs protection remains grounded in the national legal systems of each country and to a certain extent, in the legal systems of integrated regions such as the African Intellectual Property Organisation known by its French acronym OAPI¹¹.

As an employee or contractor, one may wonder whether he/she has a legal interest in what is being created at work, or whether the employer has a legal interest in what is created at home. The answer often depends on the type of intellectual property right created, the nature of the job one has been hired to do, and the agreement between the parties¹².

Intellectual property (IP) created by employees and independent contractors or consultants, particularly those in a technical or creative role has significant value for a company. However, if not careful, a company may be obliged to transfer ownership or permit the use of certain IP to employees, collaborators, customers, or other third parties. As such, the ownership of intellectual property in work relations can be a contentious issue¹³. Hence, the question of who owns intellectual property rights created in the course of employment needs to be determined.

Though most employees do not hold property rights on the things they invent on the job¹⁴, this has been widely criticised, mostly on the basis that it is unfair¹⁵. Many have questioned why the employer should own the fruits of the employee's unique talent, skill, and insight. Some moving beyond the fairness issue, say employer ownership dampens incentives to invent¹⁶. The trend towards more inter-firm

⁶ According to article 1 of Annex I to the Revised Bangui Agreement (RBA) of February 24, 1999 on the African Intellectual Property Organisation (OAPI), a "Patent" means the title granted for the protection of an invention.

⁷ A trademark is a sign or a combination of signs that a natural or legal person uses or intends to use to distinguish his goods and/or services from those of his competitors.

⁸ A trade secret consists of any confidential formula, device or piece of information which gives its holder a competitive advantage so long as it remains secret.

⁹ Article 1 (1) of Annex VI to the RBA defines a design as any arrangement of lines or colours provided that the said arrangement a special appearance to an industrial or product and may serve as a pattern for the manufacture of such a product.

¹⁰ According to Section 3 (1) of the 2000 Copyright law, are protected by this law all works of the literary and artistic field, whatever the mode, value, genre or destination of expression.

¹¹ The OAPI member states include Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Ivory Coast, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Mali, Mauritania, Niger, and Senegal.

¹² Chandler P. A., (1992), "Employee's Inventions: Outstanding Compensation", *Journal of Business Law* 600, p.34.

¹³ Boyle J. & Jenkins J. (2014), *Intellectual Property: Law & the Information Society*, Cases & Materials, 1st ed., Center for the Study of the Public Domain, p.231.

¹⁴ By default or, more commonly, contract, ownership usually rests with the firm that employs them.

¹⁵ Just being employed by the company is not enough to switch the presumption of ownership to the employer.

¹⁶ Unless the employee is hired for the specific goal of inventing something for the employer, and/or has a contract that says otherwise, the employee generally owns any inventions or creative products made while employed with the company.

cooperation in Research and Development (R&D)¹⁷ and the increasing fluid concepts of employment creates cases where default rules govern the ownership of intellectual property created in an employment relationship¹⁸. Fortunately, the modern intellectual property regime has established rules on ownership of intellectual property produced by employees¹⁹.

This paper aims, therefore, at conducting a survey of the rules and principles which govern the ownership of intellectual property rights created in work relations, that is, property created in the course of employment. This is achieved through doctrinal analysis of existing literature on the subject. Several rules or principles exist as to ownership of intellectual property rights in employment relations, some of which are common to all types of IPRs and others specific to each type of IPR.

General Rules of Ownership of Intellectual Property Rights in Work Relations

These refer to those rules of ownership which are applicable or common to all types of intellectual property rights and will include ownership by virtue of being the inventor/author of intellectual property, ownership obtained through registration of the right(s) concerned and ownership acquired by way of transfer of rights.

Ownership by the Inventor/Author of the Intellectual Property

One of the main rules which govern the ownership of IPRs in work relations is what is known as the creator principle. According to this principle, the creator is placed in the foreground, independently of their status as an employee or independent creator, and only the person who has actually created the work becomes the original holder of the right.²⁰ An employee-creator thus has the same intellectual property right as other non-employed creators, and their employer may only receive a derivative right from the employee by means of an agreement.

In the law of patents for example, the right to a patent belongs to the inventor²¹. The patent grants the inventor of a novel, non-obvious and useful invention, with the exclusive right to the benefits of that invention for a specific period of time²². According to article 10 (1) of Annex I to the RBA, the right to a patent shall belong to the inventor, the applicant shall be deemed to be the owner of the right. As such, where the inventor accordingly applies for a patent, he/she will be considered the rightful owner.

¹⁷ Hereinafter abbreviated R &D.

¹⁸ Robert P. Merges (1999), "The Law and Economics of Employee Inventions", *Harvard Journal of Law and Technology*, Vol.13, p.1.

¹⁹ Fisk L. Catherine (2009), *Working knowledge : employee Innovation and the Rise of Corporate Intellectual Property*, University of North Carolina Press, United States of America, p. 1.

²⁰ Cherpillod I. (2013), « Commentaire romand de la propriété intellectuelle », *Werra/Gillieron*, p.34.

²¹ Article 10 of Annex I to the RBA.

²² Usually 20 years.

In the same vein, the owner of copyright in a work is at least in the first instance, the person who created the work, that is to say, the author of the work²³. One of the main approaches as concerns the ownership of intellectual property is the work for hire doctrine in the tradition of Anglo-American copyright law²⁴. Here, the basic rule is that the author is the first owner of copyrights²⁵. A judicial interpretation of the term author indicates that it refers to the person who reduces the idea or information contained in the work into the relevant material form including electronic versions or formats. Therefore, the creator of a literary or artistic work owns the copyright in it unless this position is varied by a legal contract²⁶.

According to section 13 of law n°. 2000/011 of 19th December 2000 on Copyright and Neighbouring Rights in Cameroon:

authors of creative works shall in respect of such works and by reason of their creation, enjoy a right of exclusive ownership vis-à-vis all other persons. The right shall comprise patrimonial and moral implications. The patrimonial implications of copyright shall comprise the exclusive right of the author to use or authorise the use of his work in any form whatsoever and to reap the financial benefit therefrom.

This implies that he/she shall have the right to exploit the work. This right of exploitation shall comprise the rights of representation, reproduction, transformation, distribution and an indefeasible mortgage right²⁷.

As far as the moral implications are concerned, they shall confer on the author, independently of his patrimonial rights and even after the transfer of such rights, the right to decide on disclosure and determine the procedures and conditions of such disclosures²⁸. Also, he/she has the right to claim ownership of his work by requiring that his/her name or capacity be mentioned each time the work is made available to the public²⁹, defend the integrity of the work by objecting especially to its deformation or mutilation³⁰ and to put an end to the dissemination of the work and make changes thereto³¹. These rights are linked to the person of the author and are be perpetual, inalienable and imprescriptible³². Besides being a creator, ownership may be obtained through registration.

²³ Francois G. (2011), "Who owns Copyright: Employee or Employer?", *Intellectual Property magazine*, p. 20, available at www.intellectualpropertymagazine.com, visited 09/06/2020.

²⁴ Section 11(2) of the UK CDPA.

²⁵ The term "author" is not defined in the Copyright Act except in the case of photographs where, before 1 May 1969, the author was the person who owned the material on which a photograph was taken and, after this date, is the person who actually takes the photograph.

²⁶ One of the most important contracts in this context is a contract of employment.

²⁷ Section 15 *ibid*.

²⁸ Section 14(1) (a) of Law n°. 2000/011 of 19th December 2000 on Copyright and Neighbouring Rights in Cameroon.

²⁹ Section 14(1) (b) *ibid*.

³⁰ Section 14(1) (c) *ibid*.

³¹ Section 14(1) (d) *ibid*.

³² Section 14(4) *ibid*.

Ownership through Registration of Intellectual Property Rights

Article 6 of the Revised Bangui Agreement gives an overview of rules common to the registration of all IPRs and states that;

- (1) *Patent applications, applications for the registration of utility models, trademarks or service marks, industrial designs, trade names, geographical indications or layout-designs (topographies) of integrated circuits and applications for plant variety certificates shall be filed direct with the Organisation. The rules and procedures for registration activities by the OAPI, as well as its competences, are set out in two principal documents*³³... (2) *Notwithstanding paragraph (1), any member State may demand that the application be filed with the national administration of that State where the applicant is domiciled on its territory. The national administration shall convey the application to the Organisation within a period of five (5) working days from filing*³⁴.

The registration of IPRs under the OAPI system can either be done directly through an agent chosen for the purpose or through indirect filing which is reserved only for those applicants domiciled in the territory of the member countries. Indirect filing requires the nationals of member countries to file their applications with the ministry of Industrial Property in their home countries and the applications shall be transmitted by the ministries to the OAPI office within 5 working days from the date of filing. This has the effect of a national filing in each member state of the OAPI³⁵.

Upon receipt of the application for any IPR filing, it is numbered and dated and is given a formalities examination. Any objections or amendments found post examination are notified to the applicant or his agent for rectification within 90 days extendable by 30 days upon request, failing which, the application is deemed rejected. Upon completion of the formalities examination and all the compliances being met, the IPR is published. The IPR is then registered and a “Certificate of Registration” containing the registration number issued³⁶.

Registration of IPRs is proof of ownership and generally paves the way for their peaceful exploitation and commercialisation. It also prevents third parties from dealing with the IPR in an unauthorised manner and in case of any unauthorised use, the OAPI legislator provides legal remedies and procedures to claim damages³⁷.

³³ The Bangui Accord and the OAPI Administrative Guidelines.

³⁴ Article 6 of the Bangui agreement.

³⁵ Article 7 (2) of the RBA.

³⁶ Bassey P. Obiang (2007), “Cross-border Registration of IP rights in OAPI member states: the Cameroon perspective: Building and enforcing intellectual property value”, *Henri JOB Law Firm*, Douala, Cameroon, p.9.

³⁷ Richard P. Rozek, (1987), *Protection of Intellectual Property Rights*, op.cit, p.553.

The enjoyment or ownership of intellectual property created or registered may be transferred.

Ownership through Transfer of Intellectual Property Rights

Intellectual property rights arising out of an employment relationship can be owned by the employer either by operation of the law or through an agreement transferring such rights. The agreement also determines the scope of the transfer, that is, whether the transfer will be a licence or an assignment, the latter being larger in scope as it allows the recipient the right to transfer to third parties³⁸.

Assignment of intellectual property rights

An assignment refers to the transfer of rights from one person to another. It is usually done through an assignment agreement. In effect, an assignment agreement refers to a situation in which one party, known as the assignor, transfers rights to another party known as the assignee³⁹. As to what concerns intellectual property rights, intellectual property assignment is a transfer of ownership of rights such as patents, trademark, copyright etc. from one party (the assignor) to another (the assignee)⁴⁰. This is usually effected through an intellectual property assignment agreement, which is a written and enforceable contract that consummates and formalises an agreement between two parties for the sale and purchase of intellectual property rights⁴¹. The assignor transfers to the assignee all or part of the property in the intellectual property rights upon the payment of a lump sum or royalties. Consequently, the assignee becomes the new owner of the intellectual property rights⁴².

Assignment of Patents

As far as patents are concerned, after a patent has been granted, it can be sold to someone else. According to article 7(4) of Annex I to the RBA, the owner of a patent has the right to assign the patent, transfer it by succession and enter into license contracts. The law further provides that, the rights subsisting in an application for a patent or in a patent shall be transferable in whole or in part⁴³.

Assignment of Copyright

³⁸ *Ibid.*

³⁹ Sindhura C. (2009), "Importance of Assignment Agreements under intellectual property Laws in India", *op. cit.*, p. 1.

⁴⁰ Such transfer entails title and interest in intellectual property rights.

⁴¹ Sindhura C. (2009), "Importance of Assignment Agreements under intellectual property Laws in India", *op. cit.*, p. 1.

⁴² Since IP assignments transfer the title of intellectual property rights, they therefore reflect an equivalent process for intangible assets as sales agreements do for tangible assets.

⁴³ Article 33 of Annex I to the RBA.

Whereas it is the policy to reward the author of a work with copyright therein, it is now possible for a non-author to lay claim to ownership of copyright therein⁴⁴. This could be possible where such a person is a beneficiary of an assignment or transmission of interest in the copyright work⁴⁵. The assignment of copyrights entails the transfer of the copyright owner's economic rights. When a copyright is assigned, the assignee, that is, the individual or company to whom it is assigned becomes the owner of the exclusive rights of copyright in the protected work⁴⁶.

The ownership of copyright may be assigned in whole or in part. Examples of partial transfers are an assignment of the copyright for a term of ten years⁴⁷ and an assignment limited to a particular geographical area⁴⁸.

Assignment of Trademarks

The rights subsisting in a mark can be transferable in whole or in part⁴⁹. In the interest of legal security, assignments should be evidenced in writing. This is to say that, without such evidence, the assignment will be invalid. To this effect, The Bangui Agreement⁵⁰ provides that;

Acts involving transfer of ownership, the licensing of the right of exploitation or the assignment of that right, or a pledge or cancellation of a pledge, in respect of a mark shall, on pain of invalidity, be evidenced in writing

The application for recording of the assignment must also be made in writing, either by the assignor or by the assignee⁵¹. If it is the assignor who applies, a simple written request signed by himself or his legal representative should be sufficient. If on the other hand it is the assignee or any other new trademark owner who asks for the change of ownership to be recorded, the request generally needs to be accompanied by supporting documents⁵². However, in such cases the mere signature of the demand for change of ownership by the new trademark owner or his legal representative should also be sufficient⁵³.

Licensing of Intellectual Property Rights

After a patent has been granted, someone else can be permitted to use the claimed

⁴⁴ Odion J. (2017), "Contending Issues Relating to Copyright Ownership in Commissioned Works in Nigeria: A Case of Robbing Peter to Pay", *Intel Prop Right.. an open access journal*, Vol. 5, Issue 1, p. 4.

⁴⁵ *Ibid*.

⁴⁶ For example, if Tom, an individual working on his own, created Web development tool software and then assigned the copyright in the software to Software Publisher. After the assignment, Software Publisher has the exclusive right to reproduce and publicly distribute the software. If Tom starts selling the software, he will be infringing the Software Publisher's rights as copyright owner.

⁴⁷ This can equally be referred to as a time limitation.

⁴⁸ This on its part can also be termed a geographical limitation.

⁴⁹ Article 26 of Annex III to the RBA

⁵⁰ *Ibid*, article 26(2).

⁵¹ Parker A. Howell (2012), "Whose Inventions is it anyway? Employee Invention-Assignment Agreements and their Limits", *Washington Journal of Law, Technology & Arts Volume 8*, Issue 2 falls 2012, p. 87.

⁵² The contract of assignment signed by the assignor, or any other proof of the change of ownership.

⁵³ That is, without any need for authentication, legalisation or other certification.

invention. Such permission is known as a licence. A licence is simply an authorisation that allows another person to perform a specific act⁵⁴. It is usually granted in return for payment⁵⁵. An IP licence is a contract between the IP owner (licensor) and the other party (licensee) that simply allows the latter to do certain things with the licensor's IP⁵⁶. The scope of the activity and the exact IP that is licensed should always be set out clearly in the agreement. There are several types of licenses; exclusive, non-exclusive, voluntary, non-voluntary etc.

Exclusive Licenses

This refers to a situation where the licensee is the only party given the right to use, manufacture, sell or distribute technology, products, content or other licensed assets in a particular territory⁵⁷. A term specifying whether the license grant is exclusive or non-exclusive must be included within the terms and conditions in a license agreement⁵⁸. If an IP owner grants an exclusive licence, the owner promises not to compete with the licensee and not to grant other licences in the same field. The licensee therefore has no competitors and must expect to pay for the privilege⁵⁹.

Non-exclusive License

The non-exclusive license, also referred to as the "Shop Right" doctrine⁶⁰, is a situation which gives an employer an implied right to use an employee's or contractor's invention. The concept arises from the common law⁶¹ and is considered to be an equitable arrangement whereby employers still benefit, to some degree, from employees' inventions that they subsidised⁶². Whilst this doctrine is flexible, it ordinarily allows employers to continue to use the employee's invention internally, but not to sell or assign that invention to third parties. The employer benefits from a non-exclusive license or a shop right as a fair recognition of the fact that the employee has used his time and equipment to create the said invention.

Specific Rules of Ownership of Intellectual Property Rights in Work Relations

There are different intellectual property rights regimes which should be considered in determining ownership of intellectual property in the employer/employee

⁵⁴ South-East Asia IPR SME Helpdesk (2016), "Using contracts to protect your intellectual property", available at <http://www.southeastasiaprhelpdesk.eu/en/helpdesk-guides>, visited July 2020.

⁵⁵ *Ibid.*

⁵⁶ *Ibid.*

⁵⁷ Lydia Steck (2009), "The Basics of Licensing, Licensing Executives Society (LES)", *U.S.A, Canada*, p. 19.

⁵⁸ To determine whether the licensor has kept the right to grant another license to other licensees, one must examine the terms and conditions in the license agreement to see whether the licensor grants an exclusive or a non-exclusive license to the licensee.

⁵⁹ Aynampudi S. (2019), *Licensing Intellectual Property*, VNR Vignana Jyothi institute of Engineering and technology, available at www.researchgate.net/publication/333208051, p. 14.

⁶⁰ An oft-quoted formulation of the shop right rule provides that "where a servant, during his hours of employment, working with his master's materials and appliances, conceives and perfects an invention for which he obtains a patent, he must accord his master a non-exclusive right to practice the invention.

⁶¹ That is created by courts, not legislatures.

⁶² Jeremy P. & Michael J. Hoolahan (1982), "Employee's Inventions in the United Kingdom: Law and Practice", Oxford, UK: ESC Publishing Limited, p. 13.

context⁶³. The debate surrounding issues of ownership of employee inventions/creations is comprehensive and controversial⁶⁴. However, this debate has been significant in moulding principles of ownership specific to all forms of intellectual property created by employees during their employment⁶⁵, notably patents, industrial designs, trademarks, trade secrets and copy rights.

Ownership of Patents

It is a common law rule that an invention that is created by an employee is owned by that employee, provided that the invention was a free invention, that is, it was created on their own time and with their own resources⁶⁶. For example the inventions made by professors, lecturers and higher institutions are considered free inventions. As such, they own intellectual property rights in their works.

However, an employer can gain ownership of an employee's invention and obtain patent rights through the hired to invent principle⁶⁷. Hired to invent can occur in two instances. Firstly, there is the case where the employee is hired specifically to invent and for a specific purpose⁶⁸. If an employee is hired to create a specific invention and the employer provides the means, including instructions, for the employee to bring it into effect, the employer will be the owner of the invention, or at least will have an implied agreement for the invention to be assigned to it, provided the invention is within the scope of the inventor's employment and relates to the employer's business⁶⁹.

Where the employee is hired for a general purpose and is assigned a specific inventive task⁷⁰. In a hired to invent scenario, though legal ownership of the invention is not transferred to the employer, the employer is protected from claims of patent infringement⁷¹. In this light, it is said, if one is employed to devise or perfect an instrument, or a means for accomplishing a prescribed result, he cannot, after successfully accomplishing the work for which he was employed, plead title thereto as against his employer⁷². That which he has been employed and paid to

⁶³ William R. Brees, et autres (2019), "The Intersection of Intellectual Property and Government Law", *Stetson Law Review*, Vol. 48, p. 599.

⁶⁴ Parker A. Howell (2012), "Whose Inventions is it anyway? Employee Invention-Assignment Agreements and their Limits", *op.cit*, p. 79.

⁶⁵ Kantchop T. Noël (2017), « Le titre dans l'accord de Bangui, contribution à la systématisation du droit de la propriété intellectuelle dans l'espace OAPI », Ph.D thesis, FSJP/UDs, p.231.

⁶⁶ Kantchop T. Noël (2017), « Le titre dans l'accord de Bangui, contribution à la systématisation du droit de la propriété intellectuelle dans l'espace OAPI », *op.cit*, p.225.

⁶⁷ William R. Brees, et autres (2019), *The Intersection of Intellectual Property and Government Law*, *op. cit.*, p. 610.

⁶⁸ Dubé M. (2010), « La titularité de la propriété intellectuelle », available at <http://archipel.uqam.ca/3460>, p. 11.

⁶⁹ Livingston L. (2016), "Ownership and Rights in Intellectual Property", *U.S. Registered Patent Attorneys*, Florida, p. 1.

⁷⁰ William R. Brees, et autres (2019), "The Intersection of Intellectual Property and Government Law", *op. cit.*, p. 612.

⁷¹ *Ibid.*

⁷² Christopher M. Mislow (2012), "Necessity May Be the Mother of Invention, But Who Gets Custody: The Ownership of Intellectual Property Created by an Employed Inventor", *1 Santa Clara High Tech. Law Journal*, p. 63, Available at: <http://digitalcommons.law.scu.edu/chtj/vol1/iss1/2>.

accomplish becomes, when accomplished, the property of his employer. Whatever rights as an individual he may have had in and to his inventive powers, and that which they are able to accomplish, he has sold in advance to his employer⁷³.

Furthermore, it is necessary to distinguish employed inventors from inventive employees. This distinction, however, entails more than simply looking for the people wearing white lab smocks. In some instances, identifying employed inventors is an easy task. But a virtually imperceptible line often separates those employees paid to be inventive from those merely encouraged to be creative.

In *Melin v. United States*⁷⁴, for example, the general manager of a lumber manufacturing company had been assigned the responsibility of supervising the construction of a new plant. Part of his assignment was specifically to incorporate in the new plant as much labour-saving equipment as possible. In an effort to meet this directive, the general manager conceived the idea for a semi-automatic lumber-handling device, called a “mechanical off-bear and slab-handling apparatus” which he later patented. Ruling that the general manager, and not his employer was entitled to ownership of the patent rights to that apparatus, the Court reasoned that, he was not employed to invent the mechanical off-bear and slab-handling apparatus, or any other equipment⁷⁵.

Also employees assigned to conduct research usually are deemed hired to invent, while employees assigned to work solely on development, on the other hand, usually are not⁷⁶. Thus, in *Barlow & Seelig Mfg. CO. v. Patch*⁷⁷, a mechanical engineer directed to examine ways to improve a washing machine invented a novel transmission mechanism which did, in fact, improve the performance of his employer's washing machine. In an ensuing dispute over the patent rights to the mechanism, the Wisconsin Supreme Court ruled in favour of the engineer, holding that he was employed not in the hope that he would invent a new machine or a new mechanical movement, but with the expectation that he would develop and improve the product which the company was then manufacturing.

Even when an employee is unquestionably hired to invent, that does not end the inquiry. The question still remains whether or not the invention which he has created is one which he was paid to create. The case of *United States v.*

⁷³ *Ibid.*

⁷⁴ 478 F.2d 1210 (1973).

⁷⁵ The general manager was directed by his employer to incorporate in the new plant as much labour-saving equipment as possible and not to invent.

⁷⁶ William R. Brees, et autres (2019), “The Intersection of Intellectual Property and Government Law”, *op. cit.*, p. 615.

⁷⁷ 232 Wis. 220, 286 N.W. 577 (1939).

*Dubilier Condenser Corp.*⁷⁸ illustrates this problem. In this case, Francis Dunmore and Percival Lowell were employed in the radio laboratory section of the United States Bureau of Standards, and had been assigned to work on certain specific research projects. A project involving radio reception devices had been assigned to other research scientists in the laboratory, and was not part of Dunmore and Lowell's task. Nevertheless, "impelled thereto solely by his own scientific curiosity", Dunmore began toying with the idea of improving radio reception sets by substituting alternating current in lieu of direct current. After some experimentation at the Bureau of Standards laboratory, he and Lowell then devised and patented an apparatus for operating radio reception sets by means of alternating current. Because this patented invention was not the fruition of work on research projects assigned to them, the Supreme Court ruled that Dunmore and Lowell were under no duty to assign their patent to the federal government.

Whether or not an employee was employed or hired to invent can also be determined by Courts based on the implied terms of their employment⁷⁹. The common law makes it clear that there is an implied term in every contract of employment that inventions made in the course of employment are owned by the employer⁸⁰. Though determinations based on implied terms, as opposed to express terms, are beneficial to employers, it is recommended for employers to expressly state in employment contracts that individuals have been employed for the sole purpose of inventing and that the employers retain all rights to the inventions created in the proper course of employment⁸¹. When looking at the implied terms of employment, courts can look at factors such as how the employer directed the employee, how he compensated the employee for their efforts; and whether the employer paid for the patent protection⁸².

Although courts may look at the implied terms of employment to determine whether ownership rights of an invention should be assigned to an employer, the burden is still on employer to prove beyond all reasonable doubt that they hired the employee for the purpose of creating the invention at issue or that the employee created it during the proper course of their employment⁸³. It is therefore in the best interest of employers to expressly include in their employment contracts that they claim all

⁷⁸ 289 U.S.178 (1933).

⁷⁹ Cuneo C. (2016), *Intellectual Property Issues In Employment & Labour Law*, ISB – Employment & Labour Law Section CLE, Parsons Behle & Latimer, p. 24.

⁸⁰ Irish V. (2005), *Intellectual Property Rights for Engineers*, 2nd ed., The Institution of Engineering and Technology, London, United Kingdom, p. 12.

⁸¹ Dubé M. (2010), « La titularité de la propriété intellectuelle », *op. cit.*, p. 5.

⁸² William R. Brees, et autres (2019), *The Intersection of Intellectual Property and Government Law*, *op. cit.*, p. 612.

⁸³ Sean M. O'Connor (2012), "Hired to Invent vs. Work Made For Hire: Resolving the Inconsistency Among Rights of Corporate Personhood, Authorship, and Inventorship", *Seattle University Law Review*, Vol. 35, p. 1231.

ownership and inventive rights to inventions created by their employees during the proper course of their employment or to consider an assignment agreement⁸⁴.

Whether in any particular case, an invention has been made in the course of employment will depend upon the terms of the contract of service and the relationship between the parties⁸⁵. If the employee is an inventor-engineer and the invention was made as part of the engineer's normal work, then the engineer's employer will own the rights⁸⁶. This is based on an implied duty of fidelity to the employer, and the term will be implied where the appropriation of the invention and patent rights in it by the employee would conflict with this duty. If the employee has applied for or had patents granted to him, they can be ordered to be transferred to the employer⁸⁷.

The Revised Bangui Agreement, being the applicable law in the OAPI member states as far as patent is concerned provides that, subject to the legal provisions governing contracts for performing a certain work and employment contracts, and in the absence of contractual provisions to the contrary, the right to a patent for an invention made under such a contract shall belong to the person who commissioned the work or to the employer⁸⁸. It further provides that the same provision shall apply where an employment contract does not require the employee to exercise any inventive activity, but where the employee has made the invention using data or means available to him on account of his employment⁸⁹.

Ownership of industrial designs

The general rule is that the creator of a design (the designer) is usually the first owner of the design, unless there is special agreement to the contrary⁹⁰. For example, in most countries, if an employee has developed a design in the course of employment under the terms of an employment contract, that is, during his working hours within the enterprise and as part of his regular duties within the enterprise, the design (and the related rights) will belong to the employer or may require to be transferred by a formal written assignment⁹¹.

⁸⁴ An agreement transferring the rights in the invention to the employer.

⁸⁵ If the duties of a particular staff member mean that it is their job to invent or they are in charge of activities for projects which clearly involve the likelihood of inventions being made, then inventions by that staff member will be within the course of their employment.

⁸⁶ Irish V. (2005), *Intellectual property rights for engineers*, *op. cit.*, p. 96.

⁸⁷ In *Edisonia Ltd v Forse*, the employee was additionally ordered to pay damages, and an inquiry as to account of profits was ordered against a company with which he was connected and had granted a license to.

⁸⁸ Article 11(1) of Annex I to the Bangui Agreement.

⁸⁹ *Ibid*, Article 11(2).

⁹⁰ Australian Vice-Chancellors Committee (2002), "Ownership of Intellectual Property in Universities", *op. cit.*, p. 15.

⁹¹ Looking Good: An Introduction to Industrial Designs for Small and Medium sized Enterprises, WIPO publication No.498.

If the design was developed by an external designer under contract, that is an independent contractor, the rights will generally belong to the company that commissioned the design⁹². In such cases, it is considered that the design was produced for the use of the person who commissioned the design, who is therefore the owner. As far as the ownership of industrial designs in work relations is concerned, the Bangui Agreement in its article 6(1) provides that, subject to the legal provisions governing contracts for performing a certain work and employment contracts, and in the absence of contractual provisions to the contrary, the right to the registration of an industrial design made under such a contract shall belong to the person who commissioned the work or to the employer⁹³. It further adds that this same provision shall apply when an employment contract does not require the employee to exercise any creative activity, but where the employee has created the industrial design using data or means available to him on account of his employment⁹⁴.

Ownership of Trademarks

Generally, an employer owns a trademark when that employer is the first to use the trademark to identify its products or services. Under common law agency principles, any use of a trademark by an employee or independent contractor is considered to be used on behalf of or for the benefit of their employer⁹⁵. Thus, unless an employee might claim that a particular trademark or service mark was his “idea,” disputes concerning the ownership of trademarks and service marks are unlikely to arise between an employer and employee. However, trademarks can be protected from misappropriation through a court action, or be subsequently registered.

Ownership of Trade Secrets

As is the case with regard to patents, most courts hold that a trade secret created by an employee who is hired to invent belongs to his employer, whether that employee is engaged in general research or has been assigned to a particular project. These courts apply the general principle of employee trade secret misappropriation that employees and independent contractors owe an implied duty to their employers not to use or disclose trade secrets learned on the job⁹⁶. In *Sperry Rand Corp. v. Rothlein*⁹⁷ for example, several Sperry Rand research engineers left Sperry Rand to form the National Semiconductor Corporation. They took with them Sperry Rand’s secret process for the commercial production of silicon alloy junction transistors. Even though these former employees were

⁹² *Ibid.*

⁹³ Article 6(1) of Annex IV to the Bangui Agreement.

⁹⁴ Article 6(2) *ibid.*

⁹⁵ William R. Brees, et autres (2019), *The Intersection of Intellectual Property and Government Law*, *op.cit.*, p. 609.

⁹⁶ Unlike the implied duty to assign patents, however, this implied duty arises out of quasi-contract, not contract-in-fact.

⁹⁷ 241 F. Supp. 549 (D. Conn. 1964).

entirely responsible for creating this process, the court held that they had misappropriated Sperry Rand's trade secret. The fact that it was the defendants who developed the process gives them no greater right to use it in competition with the plaintiff than that of any other employee⁹⁸.

However, the close balances of competing policy considerations⁹⁹ shifts when the employee himself has created the trade secret. Courts have refused to imply a duty of non-use and nondisclosure under these circumstances. Thus, in *Structural Dynamics Research Corp. v. Eng'g Corp. v. Eng'g Mechanics Research Corp.*¹⁰⁰ a case in which two employees hired to write a structural analysis software programme began using the programme on behalf of a new employer, the court distinguished the facts before it from the far more common situation in which an employee merely learns about a trade secret from his employer.

Therefore, if the subject matter of the trade secret is in existence and an employee learns about it in the course of his employment, the duty not to use or disclose trade secret knowledge adversely to his employer arises unlike when he/she is the creator¹⁰¹. In such a case, absent an express contractual obligation by the employee not to use or disclose such confidential information acquired during his employment adverse to his employer's interest, he is free to use or disclose it in subsequent employment activity¹⁰².

Ownership of Copyright

In a contract of employment, when the copyright material is created by the employee in the course of his or her contract of employment, the employer is the owner¹⁰³. That is, if an employee creates copyright material as part of his or her job, such copyright is owned by the employer¹⁰⁴. This position is based on the "work made for hire" doctrine. The "work made for hire" doctrine¹⁰⁵ is a major exception to the fundamental principle that copyright ownership vests in the person who

⁹⁸ Christopher M. Mislow (2012), "Necessity May Be the Mother of Invention, But Who Gets Custody: The Ownership of Intellectual Property Created by an Employed Inventor", *op. cit.*, p. 21.

⁹⁹ The inherent tension in accommodating the employer's interests, the employee's interests, and society's interests as a whole reflects the fact that while the disclosure of information is favored because it helps to disseminate knowledge, excessive disclosure however can be too much of a good thing and is disfavored because it reduces the economic incentives for innovation.

¹⁰⁰ 401 F. Supp. 1102 (E.D. Mich. 1975).

¹⁰¹ This is because the employee may then have an interest in the subject matter at least equal to that of his employer or in any event, such knowledge is a part of the employee's skill and experience.

¹⁰² Robert Lesperance (2015), "Who Owns the Intellectual Property: The Employee or the Employer?", *LESPERANCE MENDES Lawyers*, 410 – 900 Howe Street, Vancouver, B.C. V6Z 2M4.

¹⁰³ Uzialko A. (2020), Does my Company own my Intellectual property? Business News Daily, p. 1.

¹⁰⁴ William R. Brees & others (2019), The Intersection of Intellectual Property and Government Law, *op. cit.*, p. 610.

¹⁰⁵ A work made for hire is defined as:

(1) a work prepared by an employee within the scope of his or her employment; or
(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

created the work. The significance of this doctrine is that, as the copyright owner of the work, an employer will own all exclusive rights to the work and may freely commercialise the property to its fullest extent¹⁰⁶. The employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them who owns all of the rights comprised in the copyrights¹⁰⁷.

The policy of assuming that the commissioner¹⁰⁸ is the owner of the work is equally justified on the basis that copyright does not protect ideas in their incubated state, but in the expression of such ideas through or in a definite medium¹⁰⁹. Accordingly, ideas no matter how ingenious and lofty remain ideas unless and until they are expressed in definite medium of expression, from which they can be appreciated. Therefore, whoever finances or makes it possible for such ideas to be fixed and cognisable deserves some measure of protection under the law¹¹⁰.

On the other hand, if an employee creates material quite unconnected with his or her work, then the individual owns the copyright in it¹¹¹. The position is clear when work and hobbies are quite separate and the material in question undoubtedly falls in one area or the other. For example a production engineer who writes a children's book will own the copyright in it personally. Practical difficulties can arise, however, when work interests and hobbies overlap and there is a grey area.

Under the Cameroonian copyright law, it is provided that, in the case of a commissioned work, the first holder of the copyright shall be the author. However, except as agreed, the patrimonial rights in such work shall be considered as having been transferred to the person who places the commission, who shall exercise the rights within the agreed limits¹¹². In this regard, the author shall exercise his moral rights in the commissioned work without undermining the enjoyment of the transferred patrimonial rights¹¹³.

Employee's Rights to Compensation for IPRs Claimed by the Employer

Employee inventors, who typically work in research and development departments of companies, are often expected to contribute to the making of patentable

¹⁰⁶ Marilyn C. Maloney & Thomas J. McGoe II, IP Issues in Employment Law, Intellectual Property Deskbook for the Business Lawyer, p. 7.

¹⁰⁷ Francois G. (2011), "Who owns Copyright: Employee or Employer?", *Intellectual Property magazine*, available at www.intellectualpropertymagazine.com, visited 09/06/2020.

¹⁰⁸ A commissioner is the person who engages or commissions another called the commissionee to create a work.

¹⁰⁹ Odion J. (2017) Contending Issues Relating to Copyright Ownership in Commissioned Works in Nigeria: A Case of Robbing Peter to Pay, *Intel Prop Right., an open access journal*, Vol. 5, Issue 1, p. 2.

¹¹⁰ *Ibid.*

¹¹¹ *Ibid.*

¹¹² Article 12 of Law n°. 2000/011 of 19th December 2000 on Copyright and Neighbouring Rights in Cameroon.

¹¹³ *Ibid*, article 12 (2).

inventions¹¹⁴. In this same vein, there is an established principle according to which, in labour law employers should enjoy the fruits of labour of their employees¹¹⁵. As such, there is no reason for employers to offer compensation for inventions made in the course of employees' duties in addition to their salaries and benefits¹¹⁶. However, patent laws and other related laws in some countries require employers to pay additional compensation to their employees for such inventions.

The law relating to employee authors and/or inventors is at a junction of intellectual property law, employment law, and contract¹¹⁷. Compensation legislation aims to address the intersection of two different legal approaches: that of employment law which gives the employer the rights to things created by employees and requires a duty of fidelity owed by employees to their employers¹¹⁸; and that of intellectual property law which is based on the creator having the primary right to benefit from his or her creation by receiving protection and incentives for it¹¹⁹.

This is justified in that, the knowledge of an employee is considered as his chief means of earning a living. As a result, an employer cannot make such stringent restrictions on the employee as to prevent him supporting himself¹²⁰. Employees are entitled to compensations from their employers arising from the exploitation of intellectual property rights in two circumstances:

- 1) Where the employee is the inventor or author but the corresponding intellectual property rights belong to the employer¹²¹, and ,
- 2) Where the intellectual property rights belong to the employee but had been transferred to the employer and the benefits the employee has received is inadequate¹²².

Conclusion

General and specific rules exist to determine the ownership of intellectual property created during employment. Therefore, while doing business, be it small or big, the employer within the OAPI zone needs to understand his rights as to that of an employee in an IP. Employers cannot always be deemed owner of IP created by an

¹¹⁴ Taylor W. (2017), "Compensating Employee Inventors", Synapse Law for Life Sciences, p.3.

¹¹⁵ *Ibid.*

¹¹⁶ Kazuhide O. (2018), *The Right to Employee Inventions in Patent Law: Debunking the Myth of Incentive Theory*, HART, London, p. 1.

¹¹⁷ Yunjoo L. & Malcolm L. (2005), "Employees' Inventions: Statutory Compensation Schemes in Japan and the UK", *European Intellectual Property Review* 250, Vol.7. p. 253.

¹¹⁸ However, fiduciary duties cannot be implied from an employer-independent contractor employment agreement unless it is specifically stated in the contract that the independent contractor accepts that role. Thus, if employers wish to retain ownership rights over the work product created for them by hired independent contractors, it is important to expressly state in a written assignment agreement that the contractor has knowledge of and agrees to transfer ownership rights of the work product created.

¹¹⁹ Taylor W. (2017), "Compensating Employee Inventors", *op.cit.*, p. 2.

¹²⁰ Jessica M. (2007), *A Statutory Compensation Scheme for Employee Inventors*, A dissertation submitted in partial fulfilment of the degree of Bachelor of Laws, University of Otago, Dunedin, New Zealand, p. 13.

¹²¹ William R. Brees, et autres (2019), "The Intersection of Intellectual Property and Government Law", *op. cit.*, p. 19.

¹²² *Ibid.*

employee during the employment. But by executing proper IP contracts with the employee, the employer can secure IP rights on the same. In view of the growing number of IP disputes between the employer and employee within the OAPI zone, draft terms and conditions of ownership rights in IP created during the course of employment needs to be executed on paper with the help of a lawyer to dilute the prospective risk of tussle for ownership rights in IP created during the employment

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