Romania
Roumanie
Rumänien

Report Q194

in the name of the Romanian Group
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The Impact of Co-ownership of Intellectual Property Rights on their Exploitation

Discussion and Questions

I) Analysis of the current substantive law

1) The regulation of co-ownership may depend on the origin of co-ownership.

It may be considered that, in case the object of an intellectual right (esthetical, technical or commercial) is jointly created by two or more persons, the rules applicable to such a situation may be different from those applicable in the situation when the co-ownership results from the division of the same right among different persons as the consequence, for example, of heritage or a division of a company.

Also, there may be the situations where the co-ownership is imposed in fact by one party on the other in case of some technical creation (for example in case of the improvement or modification of the previous creations which not always may result in the independent right).

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 these definitions are.

The Romanian Law does not make any distinction in the applicable rules to the co-ownership of an IP Right and there is no legal definition of co-ownership.

2) A large debate, during the Singapore ExCo, took place with regard to the notion of the exploitation of an IP right.

More specifically, the groups were highly divided on the issue of outsourcing or subcontracting the exploitation of an IP right.

This question, 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.

The Romanian Rule no. 547 / 21.05.2008 for implementing the Law 64/1991 regarding inventions provides, art. 84 (1,)(2),(4) In case there is no written agreement of the co-owners concerning the exploitation of the patent Each of the co-owners may, to his own benefit, grant a non-exclusive exploitation license to a third party, on condition that an equitable indemnification should be paid to the other co-owners who do not exploit the invention personally or who have not granted an exploitation license.

This license could be granted to the subcontractor for manufacturing the product.

3) The working guidelines established for the Singapore ExCo contained also the question related to the possibility of the co-owner of an IP right to licence this right to third parties.

No distinction was, however, made in this context between a non-exclusive and an exclusive licence.

No differentiation was also made on the number of licences which could be given by one co-owner in case the non-exclusive licence would be permitted by the national law.

And if AIPPI adopted a resolution on the conditions of granting the licence, it also appeared during the discussion at the ExCo that some different or more precise solutions could have been obtained if the Working Committee had made a distinction between the nature of the licence.

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 licence by a co-owner of an IP Right.

Patents Law:
In Romania, for patents, according to the Rule no. 547/21.05.2008 for implementing the Law 64/1991 regarding inventions at art. 84 (5) "An exclusive exploitation license can be granted only with the agreement of all co-owners or according to a final and irrevocable decision of the law court."

Also at art. 84 (3) of the Rule no. 547 "if there is no written agreement concerning the way of the exploitation of the IP right each of the co-owners, to his own benefit, may exploits his right".

Designs and Models Law:
The same provision is for the designs and models according to the Rule no. 211 of 10.03.2008 for implementing the Law 129/1992 regarding the protection of designs and models to art. 44 (6)" An exclusive exploitation license may be granted only with the agreement of all co-owners or according to a final and irrevocable decision of the law court."

A non exclusive license for designs and models according to art 44(5) "Each of the co-owners may, to his own benefit, grant a non-exclusive exploitation license to a third party."

Trademark law
The Romanian trademark law 84/1998 has no provision regarding the co-owners. But such provision has to be settling because of the difficult situations met in practice.

Copyright law:
According to art. 5 (3) of the Law 8/1996 on Copyright and neighboring rights the co-authors cannot exploit the work otherwise than by common agreement, failing a convention to the contrary. Denial of consent on the part of anyone of the co-authors shall have to be thoroughly justified. Art. 39(3) provide that the author's patrimonial rights or those of the holder of the copyright may be transmitted by exclusive or nonexclusive transfer.

4) One of the most difficult questions which appeared during the discussion at the Singapore ExCo was the possibility to transfer or assign a co-owned share of an IP right.

And the problem seemed so complicated that finally the Working Committee decided to withdraw its proposal for a resolution on this point.

In fact, the discussion showed that the solutions concerning the right to transfer or assign may vary since there is a huge variety of situations related to the transfers of the co-owned share.

Notably, one could imagine that the transfer is operated on the whole share of the co-owned IP right, but it also could be simply an assignment of a part of the co-owned share, creating therefore an additional co-owner of an IP right.

And such transfer of a part of a share of an IP Right could be used to overcome the limitation which could exist on the granting of licences by the co-owners.

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).

Patents Law
According to art 45 (1) of the Law 64/1991 the right to the patent, the right to grant the patent and the rights granted by the patent may be assigned in whole or in part.

The art. 84 (6) of the Rule of implementing the Law 64/1991 regarding Patents provide that each co-owner may, at any time, to assign his own share of the property covered by the patent.

Designs and models law
According to art 44(7) of the Rule no. 211 of 10.03.2008 for implementing the Law 129/1992 regarding the protection of designs and models, each co-owner may, at any time, to assign its own share of the property right covered by the certificate.

Trademark law
The Romanian trademark law 84/1998 has no provision regarding the co-owners. But such provision has to be settling because of the difficult situations met in practice.

The Romanian group's position is to let the co-owner free to decide if he wishes to transfer only a part or the whole of his share of a co-owned IP rights.

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.

The Romanian laws did not treat such situations.

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.

This point was left for further study by the paragraph 9 of the resolution adopted in Singapore.

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?

The Groups of the EU Countries are in this context asked to indicate if they consider that Council Regulation of June 17, 2008 (No 593/2008), so called "Rome I" may be applicable to the Co-Ownership agreements.

In the absence of any contractual agreement between of the co-owners the Council Regulation so called "Rome I" is not applicable. The law applicable is the national law where the IP Right it was brought to the knowledge of the public for the first time or registered according to art. 60 and 61 of the Law 105/12.09.1992 on the settlement of the private international law relations.

The Romanian law for patents and designs and models have special provisions in this case.

Patents Law
Art. 84 (2) of the Rule for implementing the Law 64/1991 regarding inventions stipulates in default of a written agreement of the co-owners concerning the manner of exploitation of the invention, each of the co-owners may exploit the invention to his own benefit, with the obligation to pay equitable indemnification to the other co-owners who do not exploit the invention personally, or who have not granted exploitation licenses; in default of an agreement, the indemnification shall be established in the law court according to the civil law.

Designs and models Law
According to art. 44 (4) of the Rule no. 211 of 10.03.2008 for implementing the Law 129/1992 regarding the protection of designs and models in default of a written agreement of the co-owners concerning the manner of exploitation of the designs and models, each of the co-owner may exploit them to his own benefit.

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.

II) Proposal for the future harmonisation

The groups are invited to present any recommendation that can be followed in the view of the further harmonisation of national laws in the context of co-ownership, specifically on the points raised by the working guidelines above in relation to the current state of their national laws.

Since the Romanian trademark law does not provide special regulations regarding the use of the trademark rights by co-owners, several complex cases have arisen having as an object of dispute the above mentioned use. Therefore, a harmonization of the trademark law in the context of co-ownership is needed by amending it in a similar manner with the patent and industrial design laws as regards to the use of the IP rights by co-owners.

Summary

The Romanian Law does not make any distinction in the applicable rules to the co-ownership of an IP Right and there is no legal definition of co-ownership

Patents Law:
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Résumé

La loi roumaine ne fait aucune distinction entre les règlements applicables à la co-propriété d'un droit de PI et il n'y a pas de définition juridique de la co-propriété.

En Roumanie, au sujet des brevets d'invention, conformément au Règlement no. 547/21.05.2008 d'application de la loi 64/1991 sur les inventions à l'art. 84 (5) "Une licence d'exploitation exclusive peut être octroyée seulement avec l'accord de tous les co-propriétaires ou par une décision définitive et irrévocable de la cour".

De même, l'art. 84 (3) du Règlement no. 547 "au cas où il n'y a pas de contrat écrit sur la manière d'exploitation du droit de PI, chacun des co-propriétaires peut exploiter ce droit à son propre bénéfice".

La même disposition s'applique aux dessins et modèles conformément au Règlement no. 211 du 10.03.2008 d'application de la Loi 129/1992 sur la protection des dessins et modèles à l'art. 44 (6) "Une licence d'exploitation exclusive peut être accordée seulement avec l'accord de tous les co-propriétaires ou par une décision définitive et irrévocable de la cour".

Une licence non exclusive pour les dessins et modèles conformément à l'art. 44 (5) "chacun des co-propriétaires peut, à son propre bénéfice, octroyer une licence d'exploitation non exclusive à un tiers".

La loi roumaine des marques 84/1998 ne contient pas de disposition concernant les co-propriétaires. Pourtant, il faut introduire cette disposition à cause des situations difficiles rencontrées dans la pratique.

En vertu de l'art. 5 (3) de la Loi 8/1996 sur le Droit d'auteur et les droits sous-jacents, les co-auteurs ne peuvent pas exploiter leur œuvre qu'à base d'un accord, en cas d'absence d'une convention contraire. Le refus de tout co-auteur de donner son accord devra être bien justifié. L'art. 39 (3) prévoit que les droits patrimoniaux de l'auteur ou ceux du titulaire du droit d'auteur peuvent être transmis par transfert exclusif ou non exclusif.

Puisque la loi roumaine du droit de marque ne prévoit pas de réglementations spéciales concernant l'utilisation des droits de marque par les co-propriétaires, quelques causes complexes ont survenu ayant l'utilisation ci-dessus comme objet litigieux. Par conséquent, il est nécessaire de réaliser une harmonisation du droit de marque au sujet de la co-propriété, en lui apportant des modifications similaires à celles des lois sur les brevets d'invention et dessins industriels, concernant l'utilisation des droits de PI par les co-propriétaires.

Zusammenfassung

Rumänisches Recht hält für die Miteigentümerschaft anwendbare Regelungen eines gewerblichen Schutz- und Urheberrechts nicht gesondert fest und es fehlt eine Rechtsdefinition der Miteigentümerschaft.

Patentgesetz:

Für Patente kann in Rumänien gemäss Regel No. 547/21.05.2008 zur Anwendung des Gesetzes 64/1991 des Patentwesens, Art. 84 (5) „Ein ausschliessliches Nutzungsrecht nur auf Grund der Zustimmung aller Miteigentümer oder auf Grund einer endgültigen und unwiderruflichen Entscheidung des Gerichtes zuerkannt werden".

Des weiteren, in Art. 4 der Regel No. 547 „Besteht keine schriftliche Vereinbarung betreffend die Art und Weise der Nutzung des Urheberrechts, so darf jeder der Miteigentümer sein Recht zum eigenen Vorteil nutzen.

Gesetz betreffend gewerbliche Muster und Modelle:

Dieselbe Bestimmung gilt für gewerbliche Muster und Modelle gemäss Regel No. 211 vom 10.03.2008 zur Anwendung des Gesetzes 129/1992 betreffend gewerbliche Muster und Modelle gemäss Art. 44 (6) „Ein ausschliessliches Nutzungsrecht kann nur auf Grund der Zustimmung aller Miteigentümer oder auf Grund einer endgültigen und unwiderruflichen Entscheidung des Gerichts zuerkannt werden".

Ein nicht ausschliessliches Nutzungsrecht für gewerbliche Muster und Modelle gemäss Art. 44(5) "Ein jeder der Miteigentümer kann zu seinem Vorteil einem Dritten ein nicht ausschliessliches Nutzungsrecht zuerkennen."

Handelsmarkengesetz:

Das rumänische Handelsmarkengesetz 84/1998 enthält keine Bestimmung betreffend die Miteigentümer. Wegen der schwierigen in der Praxis anzutreffenden Sachlagen ist die Festlegung einer solchen Bestimmung aber erforderlich.

Gesetz des Urheberrechts:

Gemäss Art. 5 (3) des Gesetzes No. 8/1996 betreffend das Urheberrecht und verwandte Rechte, können die Mitautoren das Werk nur auf Grund einer schriftlichen Vereinbarung nutzen, wen keine gegenteilige Abmachung besteht. Die Verweigerung der Zustimmung seitens eines der Co-Autoren ist eingehend zu begründen. Art. 39(3) sieht vor, dass die Vermögensrechte des Autors oder jene des Urheberrechtsinhabers durch ausschliessliche oder nicht ausschliessliche Abtretung weitergegeben werden können.

Da das Rumänische Handelsmarkengesetz keine speziellen Regelungen betreffend die Nutzung der Markenrechte seitens der Miteigentümer vorsieht, ist es zu zahlreichen komplizierten Fällen gekommen, die die oben genannte Nutzung zum Streitobjekt haben. Aus diesem Grund ist eine Harmonisierung des Handelsmarkengesetzes betreffend die Miteigentümerschaft notwendig, durch dessen Änderung in Sachen der Nutzung der Gewerblichen Urheberrechte in der Art des Patentgesetzes und des Gesetzes für gewerbliche Muster.