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IMPACTS OF DECREE N° 2020-24 OF JANUARY 13, 2020 ON THE MANAGEMENT OF INTELLECTUAL PROPERTY RIGHTS: FOCUS ON PUBLIC-PRIVATE RESEARCH CONTRACTS AND THE SINGLE REPRESENTATIVE OF PUBLIC ENTITIES

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Impacts of Decree n° 2020-24 of January 13, 2020 on the management of intellectual property rights: focus on public-private research contracts and the single representative of public entities

Decree n° 2020-24, which replaces Decree No. 2014-1518, modifies the method of appointing single representative mentioned in Article L. 533-1 of the French Research Code (in charge of the management and valorisation of the results co-owned by public entities), broadens their missions, provides which are the public co-owners' obligations towards such single representative and provides for certain other rules for the management of public co-ownership. These provisions "amount to a co-ownership agreement [between the public co-owners] within the meaning of Article L. 613-32 of the Intellectual Property Code"[1], i.e. they derogate from the rules of Articles L. 613-29 to L. 613-31 of such code.

Single representative

Previously designated for each priority patent application filing, a single representative has now to be designated for each public research units ("unité de recherche"), and possibly "another single representative" for a given field of exploitation. When several public research units are involved, the single representative will be the one of the several public research unit "whose inventors have the most important contribution". For equal contributions, the single representative will be the one who first notified the single representatives of the other units of his decision to protect and enhances this resul[2]t. Private companies should try to have only one single representative appointed to represent all the public research units involved in a public-private contract from the time the contract is negotiated.

The time limits for appointing the single representative are reduced to one month. In the absence of designation, "any agent having contributed to the result, or any third party interested in knowing who is the single representative of a result" may appeal to the rector of the academic region[3].

The single representative may be a public entity involved in the research activity, a legal entity under private law, or a third public entity[4]; it may entrust all or part of its tasks to another public or private legal entity[5].

The assignments and obligations of the single representative

The scope of competence of the single representative now covers not only inventions but also all "technical knowledge, software, databases protectable by the intellectual property code or protected know-how"[6].

The single representative is now in charge "exclusively, in the name and on behalf of the public co-owners" of taking the decisions that shall be taken during the life of a patent: filing the application, extending it abroad, replying to official letters or oppositions, or maintaining the titles in force. This role goes as far as exploitation, including the negotiation and signing of licenses[7], or even assignments, which was previously expressly excluded from its competences[8].

Many obligations bear on the single representative in order to ensure that information circulates among public persons[9]. Some of these obligations can be expected to be included in the agreements between public and with private partners: for example, its obligation to inform public co-owners and public inventors before abandoning a right "at least four months before such abandonment".

The private companies, members of a consortium, which will volunteer to be the common representative of all the co-owners (including public entities) will have to be careful not to take on some of the obligations of the single representative of the public entities. In particular, the obligation to inform "the public co-owners and, where applicable, the inventors or authors, civil servants or public officials and employees of public entities having directly participated in obtaining the result" of all patent procedural acts (and not only!) could be difficult to fulfil.

Other co-ownership management rules

The decree also provides rules for the management of co-ownership. In particular, it provides for the principle of redistribution of the income resulting from the results' exploitation in equal shares between public co-owners in the absence of prior agreement providing differently[10].

It also provides that, in case one of the public co-owners wants to assign its share on a result, the other public co-owners of such result can pre-empt such share[11].

The decree is available here:

https://www.legifrance.gouv.fr/eli/decret/2020/1/13/ESRR1930539D/jo/texte.

It specifies Article L. 533-1 of the Research Code:

https://www.legifrance.gouv.fr/affichCodeArticle.do?idArticle=LEGIARTI000038588829&cidTexte=LEGITEXT000006071190&dateTexte=20190524

[1] Art L 533-1, V of the research Code

[2] Art. 2 of Decree n° 2020-24

[3] Art. 5 of Decree n° 2020-24

[4] Art. 4 of Decree n° 2020-24

[5] Art. 11 of Decree n° 2020-24

[6] Art L 533-1, V of the research Code

[7] Art. 8 of Decree n° 2020-24

[8] Art. 2 of decree No. 2014-1518

[9] Art. 9 of Decree n° 2020-24

[10] Art. 10 of Decree n° 2020-24

[11] Art. 10 of Decree n° 2020-24