



CAN-TECH Law Roundtable: Best Practices in Software IP Ownership

April 11, 2019 | 12:30-2:00 EST
Montreal, live and via webcast

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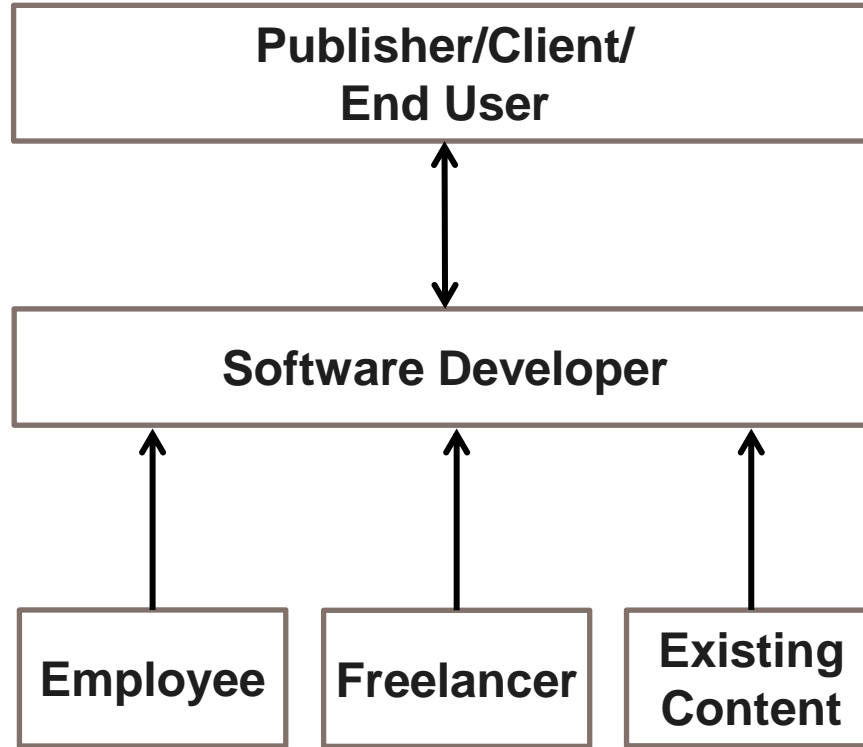
▼ Presentation outline and objectives

- Brief review of software-relevant IP types
- Structure of IP flows for typical software development transactions
- Practical steps to secure chain of title

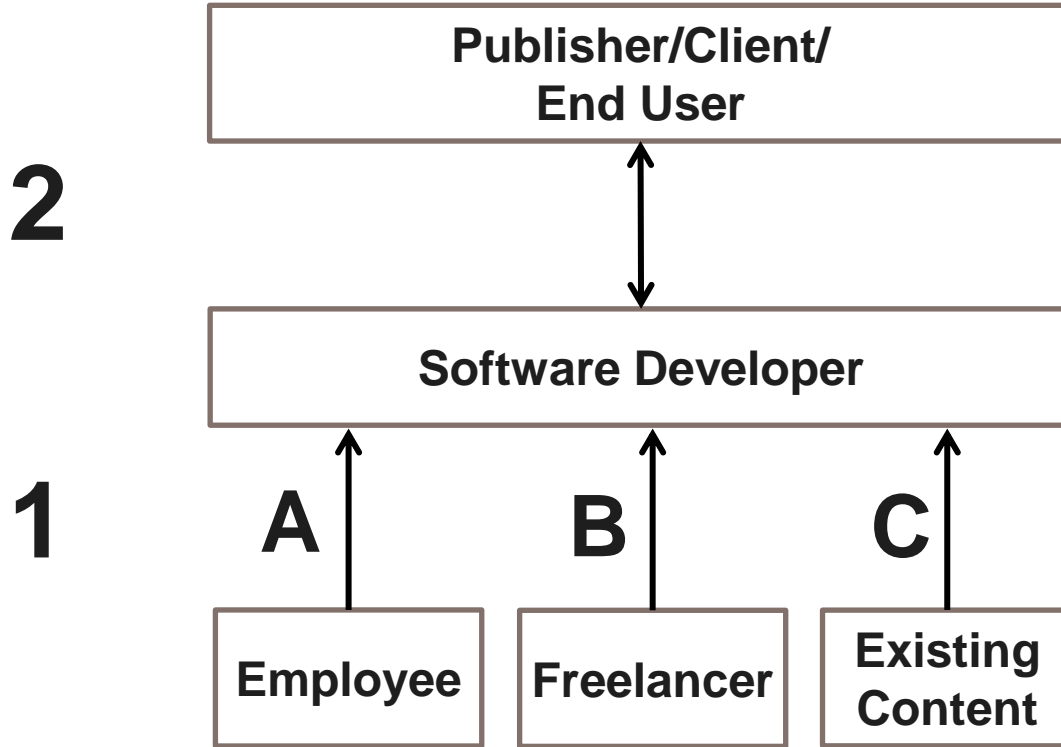
▼ Overview of software-relevant IP

- **Copyright**
 - Code, music, text, art assets, animations, etc.
- **Trademark**
 - Software name, logo, developer name, etc.
- **Patent**
 - Some software algorithms, game engines, etc.
- **Industrial Designs**
 - Some visual elements of UI/UX, etc.
- **Trade Secrets**
 - Source code, confidential know-how, etc.

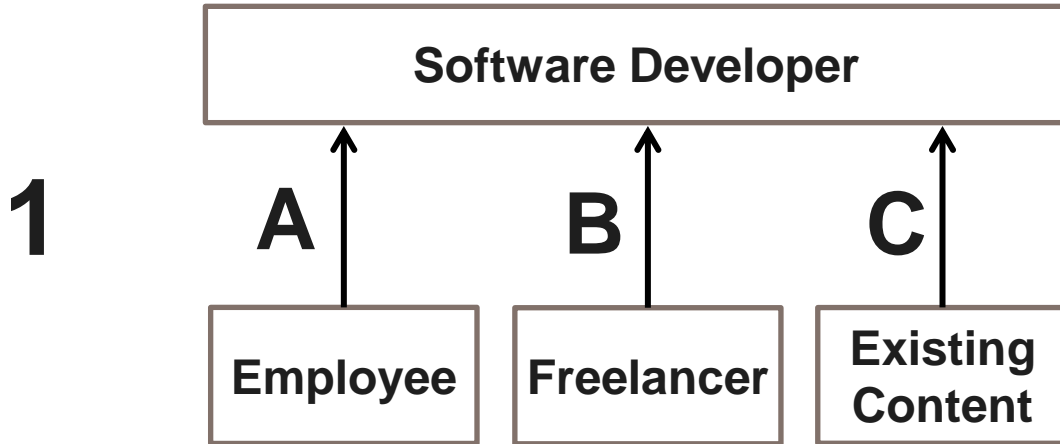
▼ Typical Software IP Flows



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▼ “Inwards” IP transfers to developers



▼ 1A: Employee-developer transfers

- Copyright
 - Employer ownership rights
 - Contractual ownership rights
 - Moral rights waivers/consent
- Patents
 - Contractual ownership rights; collaboration clauses
- Industrial Designs
 - Employer ownership rights
 - Contractual ownership rights
- Injunction waivers

▼ 1B: Freelancer-developer transfers

- Individuals vs. corporations
- Copyright
 - No employer ownership rights
 - Contractual ownership rights
 - Moral rights waivers/consent
 - US law: Work-for-hire clause
- Patents
 - Contractual ownership rights; collaboration clauses
- Industrial Designs
 - Client and contractual ownership rights

▼ 1C: Pre-existing content

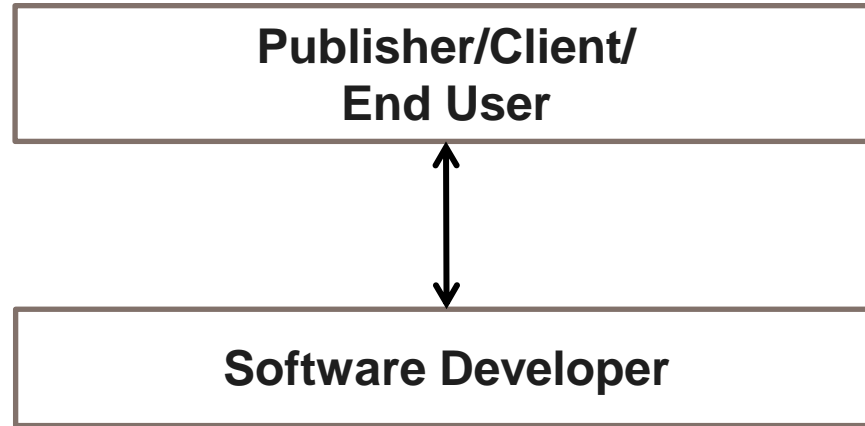
- Assignments vs. licences; revocability
- Representations and warranties
- Flow-through moral rights waivers/consent
- Special cases
 - Open source
 - Asset stores
 - Music (sound recording rights; collective societies)

▼ Example contract language

- A hereby assigns, sells, transfers and quitclaims to B all right, title and interest in and to the Films and the results of the work of all persons rendering services in connection with production of the Films
- Any development done for Client shall become the exclusive property thereof and may not therefore be marketed or reused by Freelancer or any other party

▼ Developer to Publisher/Client/User IP

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▼ Developer to Publisher/Client/User IP

- Foreground and background IP
 - Licences vs. assignment
 - Background IP licences can go both ways
 - Restrictions on use of background IP in other contexts
- Representations and warranties of title vs. supplementary assignments
- Ownership of improvements and derivative works
- Co-ownership of IP

▼ Developer to Publisher/Client/User IP

- Accessory rights
 - Right to claim damages (all); right of priority (EU patents); rights of opposition (trademarks)
- Ownership and access to source code

▼ Mistakes and “fixing” mistakes

- Retroactive assignments
- Confirmatory assignments
- Copyright registrations
- Unsigned documents



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