

WIPO Survey on the Antitrust Dimension of Intellectual Property Licensing Agreements in Support of Technology Transfer

Prepared by the Secretariat
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I. INTRODUCTION

1. In 2012-2013, the Secretariat of the World Intellectual Property Organization (WIPO) conducted a survey among a limited number of Member States which have acquired experience in addressing the competition/antitrust-related aspects of intellectual property (IP) licensing agreements, in particular as far as technology transfer is concerned.¹ The purpose of the survey was, in pursuance of Development Agenda Recommendation nr. 23, to identify experiences in regard of IP licensing agreements that could be shared with other Member States. The respective report contains the thoughtful and extensive answers provided by the responding Member States, namely Brazil, the People's Republic of China, the European Commission, Japan, Thailand and the United States.²

2. When that survey was prepared, the WIPO Secretariat considered the possibility of elaborating a comparative analysis of two central issues in the evaluation of intellectual property licensing agreements. Those two central issues are: (1) the use of preventive monitoring or *ex ante* review of IP licensing agreements; and (2) the use of the rule of reason approach in analyzing the effects of such agreements.

3. However, before the Secretariat moves further in its work, it would benefit from a better understanding of how WIPO Member States address several fundamental questions in this regard. Answers to these questions would help the WIPO Secretariat draw a map of the current situation and, thus, develop a more focused approach to addressing Development Agenda Recommendation nr. 23.

4. In pursuance of this goal, the WIPO Secretariat distributed in 2014 a second questionnaire, and received a number of responses that, even if they do not represent the majority of WIPO Member States, give nonetheless an accurate picture of the major trends that the WIPO Secretariat wanted to identify in connection with the two issues mentioned above.

II. RESPONSES TO THE QUESTIONNAIRE

5. In consultation with Member States, the WIPO Secretariat prepared a few objective questions that did not entail extensive analysis, but rather a focus on the issues mentioned above. This approach has made it possible to table the answers, at least as their essential aspects are concerned. Of course, reducing complex matters to tables is always a complicated matter, because certain nuances will necessarily be put aside. However, in order to permit a full understanding of the responses obtained, an annex to this note contains the full responses provided by Member States.

¹ The report of the survey is available on WIPO's website, at www.wipo.int/export/sites/www/ipcompetition/en/studies/tta_survey.pdf.

² Recommendation 23 reads:

"To consider how to better promote pro-competitive intellectual property licensing practices, particularly with a view to fostering creativity, innovation and the transfer and dissemination of technology to interested countries, in particular developing countries and LDCs."

Table I

	1. Under the laws/regulations/practice of your country, are IP licensors/licensees required to register/record licensing agreements					
	(a) Always	(b) In order to enforce the licensing agreements against third parties	(c) In order to enforce the licensing agreements against the licensors or licensees	(d) Only if the licensing agreements are exclusive	(e) None of the above	For information only
Algeria	X					
Azerbaijan	X	X	X			
Belarus	X ³					
Brazil (I and II) ⁴		X				
Burkina Faso						X ⁵
Belgium		X ⁶			X ⁷	
Bulgaria		X ⁸				
China, P.R.	X ⁹					
Czech Republic		X ¹⁰				
Denmark					X	
European Union (I)					X	
Germany					X ¹¹	
Greece					X ¹²	
Hungary		X				
Iceland					X ¹³	

³ License agreements of patents for inventions (including Eurasian Patents), utility models, industrial designs, plant varieties, topographies of integrated circuits, trademarks and service marks.

⁴ In these Tables, the references to I and II mean the responses that Member States have given, respectively, to the first and second surveys.

⁵ Answer given by the Copyright Office. Registration is not needed, but the Office requests a copy of licensing agreements in order to keep control of the use of works, in order to give legal assistance, if necessary, and provide mediation services.

⁶ For patents, supplementary protection certificates and plant varieties, registration is necessary, but failure to register leads to unenforceability against third parties only. Trademark licensing agreements are opposable to third parties only after being registered with the Benelux Office for Intellectual Property.

⁷ As far as other industrial property rights are concerned, registration of licensing agreements is not necessary.

⁸ This only applies to industrial property rights.

⁹ The answer is limited to patents.

¹⁰ The answer applies to patents, utility models, trademarks and industrial designs.

¹¹ Pursuant to Section 30(4) of the German Patent Act (*Patentgesetz*), the DPMA enters the grant of an exclusive license in the Register at the request of the patentee or licensee if proof of the consent of the other party is furnished to the DPMA. Registration has a purely declaratory nature.

¹² The answer is limited to copyrights.

Table I

Ireland		X ¹⁴	X ¹⁵		
Japan (I)				X	
Lithuania				X ¹⁶	
Luxembourg		X			
Madagascar		X			
Moldova		X			
Norway		X ¹⁷			
Philippines		X	X ¹⁸		
Poland				X	
Russian Federation	X ¹⁹			X ²⁰	
Slovak Republic		X			
Slovenia				X	
Spain		X			
Thailand (I)	X ²¹				
United States (I)		X ²²			
Uruguay		X		X	

¹³ Registrations is possible, but optional.

¹⁴ In the case of trademarks, the registration of licenses is not mandatory but registration or an application for registration of a license is necessary in order to enforce against infringing third parties (See S29 (3) and (4) of the Irish Trade Marks Act 1996).

¹⁵ As regards patents, Section 85 of the 1992 Patents Act imposes a statutory obligation to record an interest/license in a published patent. The penalty for non recordal is that in the event of a dispute, the Court may refuse to admit an unrecorded license as evidence.

¹⁶ The registration of licensing agreements of trademarks, designs, topographies and patents is optional. The registration of licensing agreements of intellectual property not obtained through registration (such as copyrights and trade secrets) is not required.

¹⁷ Registration provides for a higher level of legal security than unregistered contracts. A new legislative proposal aims at increasing the need for registration.

¹⁸ In the event a technology transfer agreement contains one or more clauses contrary to Section 87 and 88 of the Philippines Intellectual Property Code (prohibited and mandatory clauses), the agreement is unenforceable unless it has been approved and registered.

¹⁹ Registration is mandatory for the licensing of industrial property rights.

²⁰ Registration is not required for the licensing of intellectual property rights that are not obtained through registration (copyrights, the organization of databases and trade secrets).

²¹ This applies to patent licensing agreements.

²² [Note added by the Secretariat] See 35 U.S.C. §261: "An assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage." See also, Federal Trade Commission, Premerger Notification Rules (assignment of patent rights in the pharmaceutical industry) (2013).

Table II

	2. If you have chosen (a), (b), (c) or (d) in response to question 1, with what entity are license agreements registered?	4. If you have chosen (a), (b), (c) or (d) in response to question 1, (i) are IP licensing agreements analyzed <i>a priori</i> to determine their potential impact on competition? If so, (ii) which entity makes this determination, and (iii) when is the determination made?
Algeria	Institut National Algérien de la Propriété Industrielle	(i) No.
Azerbaijan	State Committee on Standardization, Metrology and Patent	(i) No.
Belarus	National Center of Intellectual Property (NCIP)	(i) No.
Brazil (I and II)	National Institute of Industrial Property (INPI)	(i) No. ²³
Burkina Faso	Bureau Burkinabé du Droit d'Auteur	
Belgium	Belgian Office Intellectual Property ²⁴ and Benelux Office for Intellectual Property ²⁵	(i) No.
Bulgaria	Bulgarian Patent Office	(i) No. ²⁶
China, P.R.	State Intellectual Property Office (SIPO)	(i) No.
Czech Republic	Industrial Property Office	(i) No. ²⁷ (ii) Office for the Protection of Competition.
Denmark	Not relevant.	Not relevant.
European Union (I)		(i) No.
Germany	German Patent and Trademark Office	(i) No. ²⁸
Greece		
Hungary	Hungarian Intellectual Property Office	(i) No. ²⁹
Iceland		(i) No.
Ireland	Patents Office	(i) No.
Japan (I)		(i) No. ³⁰

²³ A *posteriori* analysis may be carried out by the Competition Authority.

²⁴ Licenses concerning patents, supplementary protection certificates and plant variety rights.

²⁵ Licenses concerning trademarks.

²⁶ The procedure for registering a licensing agreement, which is carried by the Bulgarian Patent Office, is not bound to or depending on eventual procedures carried out by the Commission for Protection of Competition.

²⁷ A *posteriori* analysis may be carried out by the Office for the Protection of Competition.

²⁸ A *posteriori* analysis may be carried out by the Federal Cartel Office and competition authorities of the Länder.

²⁹ A *posteriori* analysis may be carried out by the Competition Authority.

³⁰ The Japan Fair Trade Commission (JFTC) establishes the prior consultation system, in which JFTC provides consultation for enterprises and trade associations about whether concrete actions they are going to take in the event they incur in problems under the laws that are under the JFTC's control ("The Antimonopoly Act" and "The Subcontract Act"), in order to enhance the transparency of the law management and to improve consultation system. Consultations about business combinations are out of the scope of this system.

Table II

Lithuania	State Patent Bureau	(i) No.
Luxembourg	Intellectual Property Office	(i) No.
Madagascar	Malagasy Office for Industrial Property	(i) No.
Moldova	State Agency on Intellectual Property (AGEPI)	(i) No. ³¹
Norway	Industrial Property Office	(i) No. ³²
Philippines	Documentation, Information and Technology Transfer Bureau, of the Intellectual Property Office	(i) Yes. (ii) Documentation, Information and Technology Transfer Bureau, of the Intellectual Property Office
Poland	Patent Office	(i) No.
Russian Federation	Federal Service for Intellectual Property (Rospatent)	(i) No.
Slovak Republic	Industrial Property Office	(i) No. ³³
Slovenia		(i) No.
Spain	Oficina Española de Patentes y Marcas (OEPM)	(i) No.
Thailand (I)	Department of Intellectual Property	(i) Yes. ³⁴ (ii) Department of Intellectual Property.
United States (I)		(i) No.
Uruguay	Dirección Nacional de Propiedad Industrial	(i) No.

³¹ A *posteriori* analysis may be carried out by the Competition Council.

³² A *posteriori* analysis may be carried out by the Competition Authority.

³³ A *posteriori* analysis may be carried out by the Antimonopoly Office.

³⁴ A *posteriori* analysis may be carried out by the Trade Competition Commission, usually with the assistance of the Department of Intellectual Property.

Table III

	3. If you have chosen (a), (b), (c) or (d) in response to question 1, when must registration occur?	5. If you have answered yes to question 4 are there clauses in IP licensing agreements that may be identified as "hardcore" restrictions of competition (per se antitrust violations) and would therefore be deemed unlawful and invalid without examination of any potential efficiencies produced?
Algeria	No deadline.	
Azerbaijan	No deadline.	
Belarus	No deadline.	
Brazil (I and II)	No deadline, but during the term of the contracts.	No. ³⁵
Burkina Faso		
Belgium	No deadline, after the contract is concluded.	
Bulgaria	No time limit, but for the sake of being enforceable against third parties, the registration should be made within the period of the license.	
China, P.R.	Within a period of three months from the date of entry into effect of the contract.	
Czech Republic	No deadline.	
Denmark	Not relevant.	
European Union (I)		Yes.
Germany	No deadline. ³⁶	Yes.
Greece		
Hungary	No deadline.	No. ³⁷
Iceland		
Ireland	No deadline.	
Japan (I)		Yes.
Lithuania	No deadline.	

³⁵ "Brazilian law does not recognize *per se* restrictive clauses. The analysis of contracts identifies those clauses that may be restrictive, and the Brazilian party is asked to submit clarifications aimed at evaluating those clauses under the "rule of reason" approach. Where the company declares that the clause in question has no negative effect the so-called economic abuse is not considered." (Reply to Survey I by Brazil).

³⁶ The request for entry in the Register is not admissible for the duration of a declaration of willingness to license (Section 23(1) Patent Act).

³⁷ There are no typical clauses in IP licensing agreements that may be identified as "hardcore" restrictions of competition. The restrictions that are regarded as hardcore restrictions of competition are set out in Article 11 (2) of Hungarian Competition Act.

Table III

Luxembourg	No deadline.	
Madagascar	No deadline.	
Moldova	No deadline. ³⁸	Yes.
Norway	No deadline. ³⁹	
Philippines		Yes.
Poland	No deadline.	
Russian Federation	No deadline.	
Slovak Republic	No deadline. ⁴⁰	Yes.
Slovenia		
Spain	No deadline. ⁴¹	
Thailand (I)		Yes.
United States (I)		Yes.
Uruguay	No deadline.	Yes.

³⁸ At any moment during the validity of the contract.

³⁹ There is no time limit for registration, but the effect of the registration (security against some third parties) only has effect from the time of registration.

⁴⁰ No time limits are laid down in the relevant Slovak statute for registration of a licensing agreement. It means that a request for registration can occur even after long time from the moment when a licensing agreement was signed.

⁴¹ But as soon as possible, so as to produce effects against third parties.

6. As said, the questions were designed to obtain information concerning two specific issues involving the possible antitrust impact of IP licensing agreements that imply technology transfer. Therefore, it is possible to summarize the general thrust of Member States' responses in a few sentences.
7. The first conclusion is that a large part of responding Member States requires the registration of IP licensing agreements with the single objective of giving public notice of their existence so that they produce effects against third parties. A significant number of those same responding Member States require such registration but only as far as rights whose acquisition depends on administrative procedures are concerned. Very few Member States make the validity of the agreements dependent on registration.
8. Registration, when required or when available, is carried out by intellectual property offices, and generally can be made at any time during the term of the contract.
9. The second conclusion is that in most of responding Member States, and as a consequence of registration not being necessary to ensure the validity of the agreements, there is no *ex ante* assessment of the potential anticompetitive or abusive impact of clauses. When the assessment is made, it is generally *a posteriori*, i.e., after the entry of the contracts into force and in the face of a conflict between the parties. Such an assessment is generally made by national competition authorities, with very few exceptions. Where national intellectual property agencies take charge of that analysis, they tend to do so in coordination with the national competition authorities.
10. The third conclusion is that a very significant majority of responding Member States combines a rule of reason approach to the analysis of the anticompetitive nature of certain clauses in IP licensing agreements with a limited list of *per se* or hardcore restrictions.
11. As an overall conclusion, it can be said that in general WIPO Member States are concerned with avoiding intrusive interference with the freedom of IP right owners to negotiate their assets, given the inherently procompetitive impact of licensing agreements, and the counterproductive impact of *a priori* controls. In that spirit, Member States are not keen to tie IP licensors down to rigid predetermined findings, and that is why they tend to give predominance to a rule of reason approach. However, for the sake of the protection of the market against breaches of rules and principles of free competition, a trend exists that puts more serious breaches under a *per se* list of prohibited practices.

III. QUESTIONNAIRE

1. Under the laws/regulations/practices of your country, are IP licensors/licensees required to register/record licensing agreements (select all that apply)

- (a) always
- (b) in order to enforce the licensing agreements against third parties
- (c) in order to enforce the licensing agreements against the licensors or licensees
- (d) only if the licensing agreements are exclusive
- (e) none of the above- registration of IP licensing agreements is not required

(Note 1: Please note that the term "licensing agreements" is not confined to the licensing of IP whose acquisition is subject to the right being granted or registered; that term also covers the licensing of other IP assets such as software and trade secrets, including know-how.)

2. If you have chosen (a), (b), (c) or (d) in response to question 1, with what entity are licensing agreements registered?

3. If you have chosen (a), (b), (c) or (d) in response to question 1, when must registration occur?

4. If you have chosen (a), (b), (c) or (d) in response to question 1, are IP licensing agreements analyzed to determine their potential impact on competition? If so, which organizational entity makes this determination, and when is the determination made?

5. If you have answered yes to question 4, are there clauses in IP licensing agreements that may be identified as "hardcore" restrictions of competition ("per se" antitrust violations) and would therefore be deemed unlawful and invalid without examination of any potential efficiencies produced?

[Annex follows]

ANNEX

Algeria

Question 1: Toujours.

Question 2: L'Institut National Algérien de la Propriété industrielle.

Question 3: Indéfini.

Question 4: Non, pas d'analyse des contrats seront effectués.

Question 5: Pas de réponse.

Azerbaijan

Question 1: (a), (b), (c).

Question 2: State Committee on Standardization, Metrology and Patent.

Question 3: As a result of the consideration of the application of a licensor or a licensee.

Question 4: No.

Belarus

Question 1: In accordance with the legislation of the Republic of Belarus license agreements on invention patents of the Republic of Belarus, the Eurasian inventions, utility models of the Republic of Belarus, industrial designs of the Republic of Belarus, plant varieties of the Republic of Belarus, certificates on topographies of integrated circuits of the Republic of Belarus, certificates on trademarks and service marks of the Republic of Belarus are registered by the National Center of Intellectual Property (hereinafter "NCIP"). With regard to license agreements for the above-mentioned industrial property objects the registration is always needed.

Question 2: Licensor / licensee under the license agreement to be registered at NCIP can act as a legal entity, individual entrepreneur or individual.

Question 3: The legislation of the Republic of Belarus does not determine the registration terms during of which a license agreement should be registered.

Question 4. NCIP or any other organization does not analyze the registered agreement on its potential impact on competition.

Brazil

Question 1: (b) In order to enforce the licensing agreements against third parties.

Question 2: In accordance to the Industrial Property Brazilian Law, INPI is responsible for the records of contracts that involve industrial property licensing rights and technology transfer.

Question 3: The register of contracts involving Industrial Property rights and technology transfer in Brazil occurs due to interest of the parts in regards to the effects of annotation. The proceedings of registry may occur at any time, during the term in force of the contracts. The legal effects of registry, however, exist up from the moment in which the parts present the application to INPI.

Question 4: The analysis of licensing contracts of industrial property rights and technology transfer does not involve the evaluation of potential impact in competition is responsible for the evaluation of competition impacts, The field of registry of contracts of INPI cooperates with the Brazilian Authority in defense of the competition by furnishing basic information of the contract registries achieved.

Question 5: INPI does not consider in its analysis the competition impact in the terms agreed between the parts.

Burkina Faso

Question 1: (e) Aucune des réponses, mais le Bureau Burkinabè du Droit d'auteur a besoin d'une copie ou d'un exemplaire de cette licence, seulement pour justifier dans un futur proche ou lointain, les droits dont les bénéficiaires de ces licences ont joui par son autorisation. Ces licences sont archivées dans les dossiers individuels de nos membres, non pas parce que c'est une formalité obligatoire, mais seulement parce que nous avons besoin d'avoir un control sur l'utilisation des œuvres de nos membres, faites en raison des licences accordées par ceux-ci. Cela nous permet aussi permet aussi de leur accorder une assistance juridique efficace et d'organiser des règlements amiables de conflits en cas de besoin.

Belgium

Question 1: (b) In order to enforce the licensing agreements against third parties: this is the case for licensing agreements concerning patents and supplementary protection certificates, trademarks and plant variety rights.

Patents, supplementary protection certificates and plant variety rights: In principle, there is always an obligation to register the licensing agreement; however, the only "sanction" for not registering is that the licensing agreement is not enforceable against third parties. In practice, licenses are thus only registered whenever there is a need to enforce them against a third party.

Trademarks: A licensing agreement concerning a trademark becomes opposable against third parties only after it has been registered by the Benelux Office for Intellectual Property, upon filing of an extract from the document establishing this or a corresponding declaration signed by the parties involved.

(e) None of the above – registration of IP licensing agreements is not required: this is the case for all other IP licensing agreements.

Question 2: For patents, supplementary protection certificates and plant variety rights: a certificate has to be sent to the Belgian Intellectual Property Office, including the name and address of the parties to the agreement, the number and date of the patent application or of the granted patent, the mention whether or not the license is exclusive, the starting date and duration of the license and the territorial scope of the license. Upon reception of all the necessary information, the Belgian Intellectual Property Office mentions the license agreement in the Belgian Patent Register.

For trademarks, an extract from the document establishing the license or a corresponding declaration signed by the parties involved should be sent to the Benelux Office for Intellectual Property, which will subsequently mention it in the register.

Question 3: For all IP rights mentioned above for which registration of a licensing agreement is necessary: this is not specified in the legislation, but it is understood that it occurs after the license agreement has been concluded. It can be done at any time and there is no deadline.

Question 4: No.

Bulgaria

Question 1: (b) in order to enforce the licensing agreements against third parties.

(Regarding Note 1: Please be aware that in Bulgaria could be recorded only licensing agreements concerning acquired rights in industrial property objects and know-how. There are not special registers for recording licensing of other IP assets such as software and trade secrets.)

Question 2: The information about the licensing agreements, which is recorded in the registers, includes the type of the license (exclusive or non-exclusive); scope of the registration concerned by the licensing agreement (complete or partial); scope of the territory; duration of the license and information about the licensee. The licensor should coincide with the proprietor of the registered IP object. In cases of licensing agreements dealing with know-how, the information about both of the parties is recorded.

Question 3: No time limits are set for recording a licensing agreement by Bulgarian legislation. It depends on the will of the licensor and licensee. Nevertheless the licensing agreement shall be enforceable against third parties after the date of its recordal.

Question 4: No, the potential impact on competition is not analyzed as an issue within the procedure for recording a licensing agreement. The Commission on Protection of Competition is the competent authority in this matter.

China, P.R.

Question 1: a. In China, a patent license agreement is subject to registration with relevant department at the national level.

Question 2: A patent license agreement is to be registered with the State Intellectual Property Office (SIPO) of P.R. China.

Question 3: A patent license agreement shall be registered within a period of three months from the date of entry into effect of the agreement in question.

Question 4: Upon the registration of a patent license agreement, the department concerned does not conduct any analysis of the agreement.

Czech Republic

Question 1: (a) Always. (b) In order to enforce the licensing agreements against third parties. Yes. See section 14 of the Act No. 527/1990 Coll. on Inventions and Rationalization Proposals as amended (Czech Patent Law):

Section 14

(1) The authorisation to exploit an invention protected by a patent (licence) shall be given by written contract (hereinafter referred to as "the licence contract").

(2) The licence contract shall have effect in respect of third parties as from its entry in the Patent Register (Section 69).

The same applies also to licence contract related to utility model under the Act No. 478/1992 Coll. on Utility Models (Czech Utility Models Law).

See Section 18 par. (3) of the Act No.441/2003 Coll. on Trademarks (Czech Trademark Law):

Section 18

(1) The right to use the trade mark may be licensed by means of a licence agreement concluded pursuant to a special legal regulation for all or some of the goods or services for which the trade mark is registered. The licence may be granted as exclusive or non-exclusive.

(2) The proprietor of the trade mark may invoke his rights conferred by his trade mark against a licensee who breaches any provision of the licence agreement with regard

to its duration, the form in which the trade mark may be used, the scope of goods and services for which the licence is granted, the territory in which the trade mark may be used, or the quality of goods manufactured or services provided by the licensee.

(3) The licence agreement becomes effective against third persons upon its entry in the register; any of the parties to the agreement may request the entry in the register. The requirements of the request for the entry of the licence agreement in the register concerning the parties to the proceeding and the respective trade mark shall be laid down in the implementing regulation.

See Section 32 of the Act No. 207/2000 of the Protection of Industrial Designs and the Amendment to Act No. 527/1990 Coll., as amended (Czech Industrial Design Law).

Section 32

(1) The consent (licence) to use of a registered industrial design shall be granted by a licence contract.

(2) The licence may be either exclusive, or non-exclusive.

(3) The licence contract shall come into force against third persons by the registration into the Register of industrial designs.

Question 2: See reply ad 1(b). With the Industrial Property Office of the Czech Republic (the IPO CZ).

Question 3: See reply ad 1 (b). The registration of licence within the IPO CZ is made upon the request for recording a licence in the Patent, Utility Model, Trademark or Industrial Design Register. There is no time limit.

Question 4: See reply ad 1 (b). Such analysis does not fall within the competence of the IPO CZ. The issues relating to the competition are governed by the Act No.143/2001 Coll. on the Protection of Economic Competition.

Denmark

Question 1: (e) None of the above: registration of IP licensing agreements is not required. Registration of licensing agreements in the register of the Danish Patent and Trademark Office is not a requirement. However, on request the licensing agreement will be registered. A registration of the licensing agreement has no substantive legal consequences. The registration is merely of informative character.

Question 2: Not relevant.

Question 3: Not relevant.

Question 4: Not relevant.

Question 5: Not relevant.

Germany

Question 1: (e) None of the above – registration of IP licensing agreements is not required. As a consequence, questions 2 to 5 do not need to be answered.

Under Section 1 of the German Act against Restraints of Competition (*Gesetz gegen Wettbewerbsbeschränkungen*), agreements between undertakings, decisions by associations of undertakings and concerted practices which have as their object or effect the prevention, restriction or distortion of competition are prohibited.

Section 1 of the Act against Restraints of Competition also applies to IP licensing agreements. Early on, the Court of Justice of the European Union made it clear that there are no exceptions from competition law for intellectual property rights. According to the Court's rulings, only the existence of a specific intellectual property right is protected whereas its exercise is subject to competition law.

IP licensing agreements containing anticompetitive clauses are thus, as a rule, prohibited and therefore void, unless they are exempted from the prohibition. Previously,

such an exemption was only possible by decision of the competition authorities (system of administrative exemption).

With effect from 1 May 2004, Council Regulation (EC) no. 1/2003 abolished the system of administrative exemption at the European level and introduced the directly applicable exception system. With the seventh revision of the Act against Restraints of Competition, which came into force on 1 July 2005, German legislation followed the European example and also adopted the directly applicable exception system. As a consequence, the exemption directly results from the Act against Restraints of Competition and is no longer dependent on a separate decision by the competition authorities (Federal Cartel Office or the competition authorities of the *Länder*).

Pursuant to Section 2(1) of the Act against Restraints of Competition, agreements between undertakings which, while allowing consumers a fair share of the resulting benefit, contribute to improving the production or distribution of goods or to promoting technical or economic progress, and which do not (1) impose on the undertakings concerned restrictions which are not indispensable to the attainment of these objectives, or (2) afford such undertakings the possibility of eliminating competition in respect of a substantial part of the products in question are exempted from Section 1 of the Act against Restraints of Competition.

Pursuant to Section 2(2) of the Act against Restraints of Competition, Regulations of the Council of the European Union or the European Commission on the application of Article 101(3) of the Treaty on the Functioning of the European Union to certain categories of agreements, decisions by associations of undertakings and concerted practices (block exemption regulations), shall apply *mutatis mutandis* to the application of Section 2(1) of the Act against Restraints of Competition.

For IP licensing agreements, the block exemption regulation for technology transfer agreements (Commission Regulation (EU) no. 316/2014) (TTBER) as well as the Guidelines on the application of Article 101 of the Treaty on the Functioning of the European Union to technology transfer agreements (Communication from the Commission 2014/C 89/03 – TTBER Guidelines) are particularly important.

Articles 4 and 5 of the TTBER contain a list of hardcore restrictions and other excluded restrictions. This is to make sure that exempted agreements do not reduce the incentive to innovate, do not delay the dissemination of technology and do not unduly restrict competition between licensor and licensee or between licensees. However, the list of hardcore restrictions and the list of excluded restrictions do not take into account all the possible impacts of licensing agreements. In particular, the block exemption does not take account of any cumulative effect of similar restrictions contained in networks of licensing agreements. Therefore, the exemption may also not be available for cases not listed in Articles 4 and 5 (cf. point 148 of the TTBER Guidelines).

Pursuant to Section 30(4) of the German Patent Act (*Patentgesetz*), the DPMA enters the grant of an exclusive license in the Register at the request of the patentee or licensee if proof of the consent of the other party is furnished to the DPMA. The request for entry in the Register is not admissible for the duration of a declaration of willingness to license (Sec. 23(1) Patent Act). The entry in the Register does not alter the law or give rise to any right; it is of a purely declaratory nature. The exclusive license applies, continues to apply and lapses subject to substantive law and not to the entry or non-entry in the Register. The entry in the Patent Register has no effect on the substantive legal situation and does not guarantee correctness of the content, since neither a positive nor a negative effect of publicity results from it. The entry is also not necessary to enforce the exclusive licensing agreement. The DPMA only examines whether the formal requirements for the entry are met. It does not examine whether the exclusive license is in accordance with the substantive legal situation. Possible effects on competition are not examined by the DPMA either.

In the DPMA's Patent Register, it is possible to search for exclusive licenses as well as for declarations of willingness to grant a license in accordance with Section 23 of the Patent Act, non-binding declarations of being interested in licensing and compulsory licenses.

Greece

The registration of copyright licensing agreements is not required under our national law.

Hungary

Question 1: Pursuant to the Hungarian industrial property laws, the Hungarian Intellectual Property Office shall keep registers on industrial property rights (both on applications and on granted rights) which shall contain – among other data – the licenses of use. The constitution of the right of use does not depend on the entry of the right into the above mentioned registers; therefore registration of the right of use is not required. However, pursuant to the said laws any right in relation to the industrial property protection may only be invoked against third party who acquired the right in good faith and for a consideration if it is recorded in the register. Therefore, it is recommended to the industrial property right holders to request for the registration of license agreements in connection with their industrial property rights. As regards copyright, know-how, trade secrets or trade names registration of the license agreements is not possible, because there are no registers of such rights in Hungary.

Question 2: Industrial property registers are kept by the Hungarian Intellectual Property Office.

Question 3: Since registration is not compulsory, it can occur at any time. However, please note that pursuant to the relevant provisions of industrial property laws, where requests are submitted to the same case in a way that their fulfilment would exclude each other, the requests shall be preceded in order of their date of receipt.

Question 4: It may happen that the undertakings have to prove that their agreement complies with the rules of competition law in a competition supervision proceeding before the Hungarian Competition Authority.

Question 5: There are no typical clauses in IP licensing agreements that may be identified as “hardcore” restrictions of competition. The restrictions that are regarded as hardcore restrictions of competition are set out in Article 11 (2) of Hungarian Competition Act. There prohibitions are in particular:

- The direct or indirect fixing of purchase or selling prices or other business terms and conditions;
- The limitation or control of production, distribution, technical development or investment;
- The allocation of sources of supply, or the restriction of their choice as well as the exclusion of a specified group of consumers or trading parties from purchasing certain goods;
- The allocation of markers, exclusion from sales, or restriction of the choice of marketing possibilities;
- The hindering of market entry;
- Cases, where given transaction of the same value or character, there is discrimination between trading parties, including the application of prices, periods of payment, discriminatory selling or purchase terms and conditions or met his placing certain trading parties at a competitive disadvantage;
- Making the conclusion of contract subject to the acceptance of obligations, which, by their nature or according to commercial usage do not belong to the subject of such contracts.

Iceland

Question 1: (e) No registration is required, either by law, regulations or practices. Such registration is possible, but optional.

Ireland

Question 1: In the case of TMs, the registration of licences is not mandatory but registration or an application for registration of a licence is necessary in order to enforce against infringing third parties (See S29 (3) and (4) of the Irish Trade Marks Act 1996. As regards patents, Section 85 of the 1992 Patents Act imposes a statutory obligation to record an interest/licence in a published patent. The penalty for non recordal is that in the event of a dispute, the Court may refuse to admit an unrecorded licence as evidence.

Question 2: IPO - Licence agreements are registered at the Patents Office when making the licence application.

Question 3: Registration takes place at the time of making the licence application. There are no time limits on making the licence application.

Question 4: No, licensing agreements are not analysed to determine their potential impact on competition.

Question 5: Not applicable.

Lithuania

Trade mark, design and topography licensing agreements. Registration of trade mark, design and topography licensing agreements is not necessary, but could be done if a party of the agreement wishes to do so. The licensing agreement data shall be recorded respectively in the Register of Trade Marks of the Republic of Lithuania or in the Register of Designs of the Republic of Lithuania, or in the Register of the Topographies of the Republic of Lithuania upon the request of at least one of the parties to the agreements; the Registers are administered by the SPB. The law does not specify any legal effect linked to a registration or non-registration of an agreement. The registration time limits are not specified. Licensing agreement is not analyzed to determine their potential impact on competition.

Patent licensing agreements. Registration of patent licensing agreements is not necessary, but could be done if a party often agreement wishes to do so. The licensing agreement data shall be recorded in the Registers of Patents of the Republic of Lithuania upon the request of at least one of the parties to their agreement. The registration time limits are not specified. Differently from trade mark, design and topography licensing agreements, patent licensing agreement shall have effect vis-à-vis third parties only after entry in the Register of Patents of the Republic of Lithuania; the register is administered by the SPB, Patent licensing agreements are not analyzed to determine their potential impact on competition.

Copyright, trade secrets, including know-how. Since there is no special register for copyright, trade secrets and know-how in Lithuania, registration of copyright, trade secrets and know-how licensing agreements is not required.

Luxembourg

Question 1: (b) In order to enforce the licensing agreements against third parties (without registration, the patent license is valid, but it is not opposable to third parties).

- Question 2:** The Intellectual Property Office, which is in charge of the patent register.
- Question 3:** It is up to the licensee to decide if and when he wishes to register the patent license.
- Question 4:** No.
- Question 5:** Not applicable.

Madagascar

- Question 1:** (b) In order to enforce the licensing agreements against third parties.
- Question 2:** License agreements are registered with the Malagasy Office for Industrial Property.
- Question 3:** The date of the registration is not specified by the national law.
- Question 4:** No, IP licensing agreements are not analyzed by the office in practice.

Moldova

- Question 1:** (b) In order to enforce the licensing agreements against third parties.
- Question 2:** The State Agency on Intellectual Property of the Republic of Moldova (AGEPI).
- Question 3:** At any moment during the validity of the contract
- Question 4:** Licensing contracts filed at AGEPI are verified within the provisions of the TRIPs Agreement, according to procedure approved by the Government. More specifically, the national legislation for the protection of trademarks, industrial designs and inventions contains provisions in compliance with the principles established in Art. 40 of the TRIPs Agreement by providing that no licensing practices considered to be an abuse of IPR and having an adverse effect on competition on related market will be admitted. Such practices can be considered, for example, exclusive grant back conditions, conditions preventing challenges to validity and coercive package licensing. Therefore, agreements that contain such provisions might be considered anti-competitive under Competition Law no. 183 of 11.07.2012 (hereinafter "Law no. 183/2012") which aims to protect competition, including preventing of anti-competitive practices and unfair competition.

According to Art.32 of Law no.1 83/2012, the Competition Council is the State authority which ensures the observance of the enforcement of the legislation regarding the competition.

Pursuant to the art.5(1) of Law no. 183/2012, all agreements between undertakings or associations of undertakings, decisions undertaken by the associations of undertakings and concerted practices (hereinafter agreements) which have as object or effect the prevention, restriction or distorting of competition on the market of the Republic of Moldova or part of it, are prohibited.

Stating the fact that an agreement has as its object prevention, restriction or distortion of competition is done upon initiation of examination procedure of the case of infringement of competition law at the request of affected person by that agreement or ex-officio by the Competition Council. Examination procedure of such cases is provided in Chapter VII of Law no.183/2012.

Moreover, Art.81 of Law no. 183/2012 provides a limitation period within which Competition Council can apply sanctions for the infringement of the competition law.

Question 5: According to Art.5(3) of Law no. 183/2012 are prohibited and shall be automatically void any agreements that are directed towards:

- a) direct or indirect purchase or selling prices or any other trading conditions;
- b) limiting or control production, commercialization, technical development, or investment;
- c) markets or sources of supply share;
- d) bid rigging or any other forms of competitive tendering;

e) limiting or preventing access to the market and the free exercise of competition between other undertakings, as well as agreements not to buy or sell to certain undertakings without reasonable justification.

f) applying dissimilar conditions to equivalent transactions with other trading parties, thereby placing them at a competitive disadvantage;

g) making the conclusion of contracts subject to acceptance by the other parties of supplementary obligations which, by their nature or according to commercial practice, have no connection with the subject of such contracts.

However, the above mentioned provisions of Art. 5 (1) and (2) shall not be applied to the anti-competitive agreements in case these meet the following cumulative requirements:

a) contributes to improving the production or distribution of goods or to promoting technical or economic progress;

b) allow consumers a fair share of the obtained benefit;

c) do not impose on the concerned undertakings, restrictions which are not indispensable to the attainment of the objectives referred to in a) and b);

d) do not afford such undertakings the possibility of eliminating competition in respect of a substantial part of the products under concern.

According to Art.5(5) of Law no. 183/2012, where it was established that an agreement has competition prevention, restriction or distortion as its object, the Competition Council shall not prove the existence of anti-competitive effects in order to establish any competition restriction in the meaning of present law.

Norway

Question 1: In Norway, the conclusion of a license agreement is sufficient for the transfer of rights to be effective *inter partes*. Accordingly, it is not required to register/record license agreements in order to enforce them between the parties to the agreement (the licensor/licensee).

The license is also effective and can be enforced against the licensor's/licensee's creditors based on the license agreement only, and hence no recording/registration is needed.

For those IPRs where registers exist (patents, trademarks, designs, plant varieties), it is possible to record the license in the respective register.

Registration of the license in the appropriate register does not have the effect that a licensee (whether or not in good faith) who had his right assigned to him from a registered proprietor not having the actual right to the IPR will prevail in a conflict with the real proprietor.

Other possible conflicts between the licensor/licensee and third parties are solved differently for the different types of IPR:

Patents:

According to the Patents Act section 44, first paragraph, license agreements may by request of the licensor or licensee be recorded in the patent register with the Norwegian Industrial Property Office.

The license agreement is effective against later voluntary security rights in the patent from the time of the conclusion of the license agreement. In the case of a conflict between a license, the recording of which has been requested, and a license, the recording of which has not been requested or has been requested subsequently, the former prevails, according to the Patent Act section 44, fifth paragraph, provided that the licensee was in good faith concerning the previously concluded license agreement (did not know about it and should not have known about it) at the time of the request for recording of the license. The provision concerns voluntary contractual transfers of rights only. Valid security rights may not be extinguished. Neither will such security right prevail over priority established voluntary rights.

Accordingly, the registration of a patent license is required to secure the licensed rights against the rights of some third parties.

According to a new legislative proposal (Prop. 101 L (2013-2014)), the provisions on the effect of recording licenses in the patent register will change, and registration will become increasingly important, as recording the license will be decisive for protection against all third parties, including bankruptcy estates, security right holders and other licensees, meaning that later acquired and recorded rights will prevail over earlier non-recorded licenses.

Plant varieties:

For registered plant varieties, the legal situation is the same as for patents.

Designs:

According to the Design Act section 53, third paragraph, a license in a design right can be registered in the Design Register with the Norwegian Industrial Property Office if one of the parties to the agreement so requests.

A later concluded license agreement, for which recording has been requested will prevail over an earlier concluded license agreement or transfer, for which recording has not been requested, provided that the licensee was in good faith at the time of the request for recording of the license. The provision only concerns voluntary transfers of rights. Valid security rights may not be extinguished. Neither will a security right prevail over earlier established rights or licenses.

Trademarks:

According to the Trademarks Act section 56, third paragraph, the Norwegian Industrial Property Office shall record a license in a registered trademark in the Trademark register h at the request of one of the parties to the license agreement.

No provision concerns the conflict between a grant of a license, the recording of which has been requested, and a grant of a license, the recording of which has not been requested or has been requested subsequently. It is to assume that the conflict will be solved based on general principle of law, whereby the earlier right prevails, without regard of any registration.

Question 2: In those cases where registration of licenses is required, the license is to be registered with the Norwegian Industrial Property Office.

Question 3: There is no time limit for registration, but the effect of the registration (security against some third parties) only has effect from the time of registration.

Question 4: The Norwegian Competition Authority is depending on information from involved businesses and/or media to start investigations. The Competition Authority does not automatically analyse registered licence agreements to determine potential impact on competition.

Question 5: N/A.

Philippines

Question 1: Sec. 85 of the IP Code provides for the policy statement, viz: "To encourage the transfer and dissemination of technology, prevent or control practices and conditions that may in particular cases constitute an abuse of intellectual property rights having an adverse effect on competition and trade, all technology transfer arrangements shall comply with the provisions of this Chapter." The Chapter referred to is Chapter IX on Voluntary Licensing and covers Sections 85-92 of the IP Code. The definition of technology transfer arrangements is contained in Sec. 4.2 which defines technology transfer arrangements (TTA) as "contracts or agreements involving the transfer of systematic knowledge for the manufacture of a product, the application of a process, or rendering of a service including management contracts; and the transfer, assignment or licensing of all forms of intellectual property rights, including licensing of computer software except computer software developed for mass market".

Question 2: Registration of TTAs with the IPOPHL is not mandatory. Sec. 92 of the IP Code states that "technology transfer arrangements that conform with the provisions of Sections 87 and 88 need not be registered; however, nonconformance with any of the

aforementioned provisions shall automatically render the technology transfer arrangements unenforceable unless said technology transfer arrangement is approved and registered with the Documentation, Information and Technology Transfer Bureau of the Intellectual Property Office of the Philippines under the provisions of Section 91 on exceptional cases."

Question 3: Sec. 87 of the IF Code enumerates the following provisions which are deemed prima facie to have an adverse effect on competition and trade:

87.1. Those which impose upon the licensee the obligation to acquire from a specific source capital goods, intermediate products, raw materials, and other technologies, or of permanently employing personnel indicated by the licensor;

87.2. Those pursuant to which the licensor reserves the right to fix the sale or resale prices of the products manufactured on the basis of the license;

87.3. Those that contain restrictions regarding the volume and structure of production;

87.4. Those that prohibit the use of competitive technologies In a non-exclusive technology transfer agreement;

87.5. Those that establish a full or partial purchase option in favour of the licensor;

87.6. Those that obligate the licensee to transfer for free to the licensor the inventions or improvements that may be obtained through the use of the licensed technology;

87.7. Those that require payment of royalties to the owners of patents for patents which are not used;

87.8. Those that prohibit the licensee to export the licensed product unless justified for the protection of the legitimate interest of the licensor such as exports to countries where exclusive licenses to manufacture and/or distribute the licensed product(s) have already been granted.

87.9. Those which restrict the use of the technology supplied after the expiration of the technology transfer arrangement, except in cases of early termination of the technology transfer arrangement due to reason(s) attributable to the licensee;

87.10. Those which require payments for patents and other industrial property rights after their expiration, termination arrangement;

87.11. Those which require that the technology recipient shall not contest the validity of any of the patents of the technology supplier;

87.12. Those which restrict the research and development activities of the licensee designed to absorb and adapt the transferred technology to local conditions or to initiate research and development programs in connection with new products, processes or equipment;

87.13. Those which prevent the licensee from adapting the imported technology to local conditions, or introducing innovation to it, as long as it does not impair the quality standards prescribed by the licensor;

87.14. Those which exempt the licensor for liability for nonfulfillment of his responsibilities under the technology transfer arrangement and/or liability arising from third party suits brought about by the use of the licensed product or the licensed technology; and

87.15. Other clauses with equivalent effects.

Question 4: Sec. 88 of the IP Code enumerates the following mandatory provisions which shall be included in voluntary license contracts:

88.1. That the laws of the Philippines shall govern the interpretation of the same and in the event of litigation, the venue shall be the proper court in the place where the licensee has its principal office;

88.2. Continued access to improvements in techniques and processes related to the technology shall be made available during the period of the technology transfer arrangement;

88.3. In the event the technology transfer arrangement shall provide for arbitration, the procedure of Arbitration of the Arbitration Law of the Philippines or the Arbitration

Rules of the United Nations Commission on International Trade Law (UNCITRAL) or the Rules of Conciliation and Arbitration of the International Chamber of Commerce (ICC) shall apply and the venue of arbitration shall be the Philippines or any neutral country; and

88.4. The Philippine taxes on all payments relating to the technology transfer arrangement shall be borne by the licensor.

Question 5: Sec. 91 of the IP Code provides for the instances wherein exemption may be allowed, viz: "In exceptional or meritorious cases where substantial benefits will accrue to the economy, such as high technology content, increase in foreign exchange earnings, employment generation, regional dispersal of industries and/or substitution with or use of local raw materials, or in the case of the Board of Investments, registered companies with pioneer status, exemption from any of the above requirements (*referring to Sees. 87 and 88*) may be allowed by the Documentation, Information and Technology Transfer Bureau after evaluation thereof on a case by case basis."

Poland

Question 1: Under the Polish Industrial property Code of 30 June 2000 (as subsequently amended) licensing agreements are recorded in the Patent Register only at the request of the interested party. The holder of an exclusive license recorded in the Register may, to the same extent as the patent holder, enforce his claims in the event of infringement, unless the license contract stipulates otherwise.

Question 2: Licensing agreements are recorded with the Patent Office of the Republic of Poland.

Question 3: No time limit fixed.

Question 4: No analyses of licensing agreements are made.

Russian Federation

Question 1: In the Russian Federation IP licensors/licensees are required to register licensing agreements: Always – for invention, utility models, industrial designs, trademarks, service marks topographies of integrated circuit – rights to the results of intellectual activity and means of individualization. (e) None of the above – for computer programs and databases, secrets of production (Know-How).

Question 2: The state registration of disposition of the exclusive right to the results of intellectual activity and means of individualization, indicated in the point 1(a), is carried by the Federal Service for Intellectual Property (Rospatent).

Question 3: The term during which the granting of the right to use the results of intellectual activity and means of individualization should be registered is not stated by the provisions of the Russian IP legislation.

Question 4: In the Russian Federation the licensing agreements are not analyzed to determine their potential impact on competition. It should be noted that according to the previous legislation (before October 1, 2014) licensing agreement for the registered results of intellectual activity and means of individualization was subject to the state registration. Failure to comply with the requirement shall render it invalid. However, in connection with the entry into force from October 1, 2014 of the provisions of the Federal Law no. 35 "About amendments to the first, second and fourth parts of the Civil Code of the Russian Federation", the procedure of the registration was changed. At present the disposition of the exclusive right to the registered results of intellectual activity and means of individualization under the licensing agreement are subject to the state registration but not the agreement itself.

Slovak Republic

Question 1: (b) In order to enforce the licensing agreements against third parties. Licensing agreements can be registered (at request of licensors or licensees) in respect of industrial property issues only (patents, utility models, trademarks, designs, topographies of semiconductor products). See also at www.upv.sk/?legislation-in-force, Act No. 506/2009 Coll. on Trade Marks (sec. 20); Act No. 146/2000 Coll. on Legal Protection of Topographies of Semiconductor Products (sec. 14); Act No. 435/2001 Coll. Patent Act (sec. 24); Act No. 444/2002 Coll. on Designs (sec. 24); Act No. 517/2007 Coll. on Utility Models (sec. 23): "The license agreement becomes effective vis-à-vis third parties upon its entry in the register".

Question 2: License agreements are registered with the Industrial Property Office of the Slovak Republic (IPO SR) for patents, utility models, trademarks, designs, topographies of semiconductor products. Rise, lapse and enforcement of right from a licence agreement shall be governed by provisions of the Commercial Code (Articles 508 to 515)

Question 3: Licence agreement shall have legal effects *vis-à-vis* third parties from the day of entry into the Register. This shall not apply *vis-à-vis* persons who knew about signing of licence agreement or should have known according to circumstances. The Office shall be obliged to enter the license for patents specifically into the Register no later than within six months from delivery of a license agreement to the Office or within this time limit to communicate a decision specifying reasons on basis of which it shall not be possible to enter the license into the Register. (Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended – Patent Act) No time limits are laid down in the relevant Slovak laws (listing above) for registration of a licensing agreement. It means that a request for registration can occur even after long time from the moment when a licensing agreement was signed.

Question 4: The Antimonopoly Office of the Slovak Republic (hereinafter as "AM Office") is not a body that registers licensing agreements; it has no jurisdiction to interfere with the registration process and does not assess the impact of such agreements on competition in connection with their registration. But in line with Article 22(1)(a) and (b) of the Act No. 136/2001 Coll. on Protection of Competition the AM Office has the right to conduct investigation of the licensing agreements in order to obtain information on state of competition in the sector and conduct investigation to establish whether there is a reason to initiate the proceedings pursuant to this Act. Investigation is conducted in case when the Antimonopoly Office receives information, that the licensing agreement could contain provisions that are in conflict with the provisions of the Act on Protection of Competition. In respect to *ex ante* inspection of the licensing agreements the entrepreneurs may ask the AM Office to issue an opinion on whether or not their draft agreement or draft decision by an association of entrepreneurs constitutes an agreement restricting competition. The AM Office shall not assess a draft agreement between entrepreneurs or a draft decision by an association of entrepreneurs pursuant to the Article 4 (2) and (5) nor pursuant to the Article 5.

Question 5: Application of the Article 4 of the Act on Protection of Competition is based on ECJ case law, on decision-making practice of the European Commission and on the guidelines issued by the European Commission in connection with the application of EU competition rules. In assessing whether a particular action constitutes an agreement restricting competition the AM Office evaluates mainly the following facts: 1. Whether in a particular case it is a business agreement (or harmonized practice); 2. Whether the aim or consequence of such agreement is to restrict competition. Competition Law of the Slovak Republic (based on EU law) recognizes the term "hardcore" restrictions of competition that are generally regarded as agreements restricting competition on the basis of the objective for which it is not necessary to assess their actual impact of agreement on the market and they are therefore normally prohibited under Article 4(1) of the Act. On the other hand, in terms of decision-making practice of the ECJ the rule "per-se" cannot be applied, i.e. rule on agreements, which are always prohibited (C-5/69 Volk v. Vervaecke). However, in practice

the agreement containing so called “hardcore” restrictions rule is generally classified as an agreement restricting competition on the basis of objective and it is not necessary to examine its the actual effects on the market. In connection with licensing agreements – the list of “hard-core” provisions that may appear in such contracts also contains the Commission Regulation. No. 316/2014 on application of Article 101(3) of the Treaty on the Functioning of the European Union regarding categories of technology transfer agreements.

Slovenia

Question 1: In Republic of Slovenia registration of IP licensing agreements is not required.

Spain

Question 1: (b)

Question 2: Oficina Española de Patentes y Marcas (OEPM).

Question 3: Tan pronto como sea posible, para producir efectos frente a terceras partes.

Question 4: No.

Question 5: No aplica.

Uruguay

Question 1: (b) Art.50 de la Ley N° 17.164 de 2/9/99.

Question 2: En la Dirección Nacional de la Propiedad Industrial. El artículo 50 de la Ley de Patentes N° 17.164 de 2/9/99, establece que los contratos de licencia tendrán efecto frente a terceros a partir de su inscripción. Dicha ley en el Capítulo II del Título VI, Registro de los Actos y los Contratos de Patentes establece:

Art. 110. La Dirección Nacional de la Propiedad Industrial (DNPI) llevará el registro de los actos y contratos relativos a la explotación comercial e industrial de las patentes y los de aquellos que modifiquen, afecten o limiten los derechos emergentes de las mismas.

En especial se llevarán registros de:

A) Licencias convencionales, ofertas de licencia, licencias obligatorias y otros usos sin autorización del titular de la patente y demás, previstos en el Capítulo V del Título II de la presente ley, así como sus modificaciones.

B) Embargos, prohibiciones de innovar y demás actos que afecten el uso o la disposición de los derechos de patente.

C) Prendas y demás derechos que limiten o se constituyan sobre los derechos de patente.

En el Título VII relativo a la Transferencia de Tecnología, se establece:

Artículo 111: Créase el registro de los contratos que tengan por objeto la transferencia de tecnología, investigación y desarrollo, contratos de franquicia y similares, los cuales producirán efectos ante terceros a partir de su inscripción.

Question 3: El Artículo 18 del Decreto Reglamentario N° 11/000 de 13/1/00 establece que “El interesado en registrar un contrato de licencia, deberá completar el formulario de solicitud correspondiente y adjuntar fotocopia certificada de contrato o extracto del mismo suscrito por ambas partes.” El registro se establece con la Resolución de la Dirección Nacional de la Propiedad Industrial (DNPI)

Question 4: No se produce ese análisis por la DNPI. No obstante, el Artículo 52 de la Ley 17.164 establece:

Prohíbese establecer en las licencias contractuales, cláusulas o condiciones que produzcan un efecto negativo en la competencia, constituyan una competencia desleal, hagan posible un abuso por el titular del derecho patentado o de su posición

dominante en el mercado. Entre dichas cláusulas o condiciones corresponde señalar las que produzcan:

- A) Efectos perjudiciales para el comercio.
- B) Condiciones exclusivas de retrocesión.
- C) Impedimentos a la impugnación de la validez de las patentes o licencias dependientes.
- D) Limitaciones al licenciataria en el plano comercial o industrial, cuando ello no se derive de los derechos conferidos por la patente.
- E) Limitaciones a la exportación del producto protegido por la patente hacia los países con los que existiera un acuerdo para establecer una zona de integración económica y comercial.

Por su parte, en la Subsección III de Licencias Obligatorias y otros usos sin autorización del titular por prácticas anticompetitivas, se establece:

Art. 60. La Dirección Nacional de la Propiedad Industrial, por resolución expresa, podrá conceder licencias obligatorias de una patente cuando la autoridad competente, mediante un procedimiento administrativo o judicial que confiera al titular el derecho de defensa y demás garantías, haya determinado que éste ha incurrido en prácticas anticompetitivas, abuso de los derechos conferidos por la patente o de la posición dominante en el mercado.

Art. 61. Entre las situaciones previstas en el artículo anterior corresponde señalar:

- A) La fijación de precios comparativamente excesivos respecto de la media del mercado internacional del producto patentado.
- B) La existencia de ofertas para abastecer el mercado a precios significativamente inferiores a los ofrecidos por el titular de la patente.
- C) La negativa de abastecer adecuada y regularmente al mercado local de las materias primas o del producto patentado, en condiciones comerciales razonables.
- D) El entorpecimiento o el perjuicio derivado a las actividades comerciales o productivas en el país.
- E) Aquellos actos que limiten de manera injustificable el comercio o redunden en detrimento de la transferencia de tecnología.

Estas disposiciones están reglamentadas en el Decreto Reglamentario N° 11/000 de 13/1/00 que establece:

Art. 23. Las licencias y otros usos sin autorización del titular en las circunstancias previstas en el Artículo 60 de la Ley N° 17.164, serán concedidas por la Dirección Nacional de la Propiedad Industrial previo pronunciamiento de la autoridad administrativa o judicial competente.

A solicitud de la autoridad competente la Dirección Nacional de la Propiedad Industrial colaborará proporcionando información y asesoramiento.

El solicitante de la licencia u otros usos deberá presentarse adjuntando testimonio del pronunciamiento referido y acreditando el cumplimiento de lo dispuesto por el Artículo 72 de la Ley N° 17.164 y las condiciones en que solicita la licencia. De la solicitud se dará traslado al titular de la patente por el término perentorio de 30 (treinta) días. El Poder Ejecutivo previo a resolver podrá acudir a instancias de conciliación o arbitraje.

[End of the Annex and of the document]