



# Contratos de Transferencia de Tecnología – Encuesta de la OMPI (2014/2015)

**Evento Internacional – Transferencia de  
Tecnología**

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1. En virtud de las leyes/reglamentos/prácticas de su país, ¿están los licenciantes/licenciatarios de PI obligados a registrar los contratos de licencias?

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 <sup>3</sup> |  |   |  |                       |                      |
| Brazil (I and II) <sup>4</sup>  |                | X  |   |  |                       |                      |
| Burkina Faso  |                |  |   |  |                       | X <sup>5</sup>       |
| Belgium   |                | X <sup>6</sup>   |   |  | X <sup>7</sup>        |                      |
| Bulgaria  |                | X <sup>8</sup>   |   |  |                       |                      |
| China, P.R.   | X <sup>9</sup> |  |   |  |                       |                      |
| Czech Republic  |                | X <sup>10</sup>  |   |  |                       |                      |
| Denmark   |                |  |   |  |                       |                      |
| European Union (I)  |                |  |   |  | X                     |                      |
| Germany   |                |  |   |  | X                     |                      |
| Greece  |                |  |   |  | X <sup>11</sup>       |                      |
| Hungary   |                | X  |   |  | X <sup>12</sup>       |                      |
| Iceland   |                |  |   |  | X <sup>13</sup>       |                      |

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

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

<sup>5</sup> 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.

<sup>6</sup> 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.

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

<sup>8</sup> This only applies to industrial property rights.

<sup>9</sup> The answer is limited to patents.

<sup>10</sup> The answer applies to patents, utility models, trademarks and industrial designs.

<sup>11</sup> 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.

<sup>12</sup> The answer is limited to copyrights.

Table I

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

<sup>13</sup> Registrations is possible, but optional.

<sup>14</sup> 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).

<sup>15</sup> 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.

<sup>16</sup> 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.

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

<sup>18</sup> 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.

<sup>19</sup> Registration is mandatory for the licensing of industrial property rights.

<sup>20</sup> 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).

<sup>21</sup> This applies to patent licensing agreements.

<sup>22</sup> [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).

2. Si ha elegido (a), (b), (c) o (d) en respuesta a la pregunta 1, ¿con cuál entidad deben los contratos ser registrados?

[3. Si ha elegido (a), (b), (c) o (d) en respuesta a la pregunta 1, ¿cuándo debe ocurrir el registro?]

4. Si ha elegido (a), (b), (c) o (d) en respuesta a la pregunta 1, ¿son los contratos de licencia de PI analizados para determinar su potencial impacto sobre la competencia? Si es así, ¿qué entidad hace esta determinación y cuándo?

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? |
|---------------------------|---|---|
| <b>Algeria</b>            | Institut National Algérien de la Propriété Industrielle   | (i) No.   |
| <b>Azerbaijan</b>         | State Committee on Standardization, Metrology and Patent  | (i) No.   |
| <b>Belarus</b>            | National Center of Intellectual Property (NCIP)   | (i) No.   |
| <b>Brazil (I and II)</b>  | National Institute of Industrial Property (INPI)  | (i) No. <sup>23</sup>   |
| <b>Burkina Faso</b>       | Bureau Burkinabé du Droit d'Auteur  |   |
| <b>Belgium</b>            | Benelux Office for Intellectual Property  | (i) No.   |
| <b>Bulgaria</b>           |   | (i) No. <sup>24</sup> (ii) Commission on Protection of Competition.   |
| <b>China, P.R.</b>        | State Intellectual Property Office (SIPO)   | (i) No.   |
| <b>Czech Republic</b>     | Industrial Property Office  | (i) No. <sup>25</sup> (ii) Office for the Protection of Competition.  |
| <b>Denmark</b>            | Not relevant.   | Not relevant.   |
| <b>European Union (I)</b> |   | (i) No.   |
| <b>Germany</b>            | German Patent and Trademark Office  | (i) No. <sup>26</sup>   |
| <b>Greece</b>             |   |   |
| <b>Hungary</b>            | Hungarian Intellectual Property Office  | (i) No. <sup>27</sup>   |
| <b>Iceland</b>            |   | (i) No.   |
| <b>Ireland</b>            | Patents Office  | (i) No.   |
| <b>Japan (I)</b>          |   | (i) No. <sup>28</sup>   |
| <b>Lithuania</b>          | State Patent Bureau   | (i) No.   |
| <b>Luxembourg</b>         | Intellectual Property Office  | (i) No.   |
| <b>Madagascar</b>         | Malagasy Office for Industrial Property   | (i) No.   |
| <b>Moldova</b>            | State Agency on Intellectual Property (AGEPI)   | (i) No. <sup>29</sup>   |

<sup>23</sup> A *posteriori* analysis may be carried out by the Competition Authority.

<sup>24</sup> A *posteriori* analysis may be carried out by the Competition on the Protection of Competition.

<sup>25</sup> A *posteriori* analysis may be carried out by the Office for the Protection of Competition.

<sup>26</sup> A *posteriori* analysis may be carried out by the Federal Cartel Office and competition authorities of the Länder.

<sup>27</sup> A *posteriori* analysis may be carried out by the Competition Authority.

<sup>28</sup> 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

|                           |  |  |
|---------------------------|--|--|
| <b>Norway</b>             | Industrial Property Office   | (i) No. <sup>30</sup>  |
| <b>Philippines</b>        | 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 |
| <b>Poland</b>             | Patent Office  | (i) No.  |
| <b>Russian Federation</b> | Federal Service for Intellectual Property (Rospatent)  | (i) No.  |
| <b>Slovak Republic</b>    | Industrial Property Office   | (i) No. <sup>31</sup>  |
| <b>Slovenia</b>           |  | (i) No.  |
| <b>Spain</b>              | Oficina Española de Patentes y Marcas (OEPM)   | (i) No.  |
| <b>Thailand (I)</b>       | Department of Intellectual Property  | (i) Yes. <sup>32</sup> (ii) Department of Intellectual Property.   |
| <b>United States (I)</b>  |  | (i) No.  |
| <b>Uruguay</b>            | Dirección Nacional de Propiedad Industrial   | (i) No.  |

<sup>29</sup> A *posteriori* analysis may be carried out by the Competition Council.

<sup>30</sup> A *posteriori* analysis may be carried out by the Competition Authority.

<sup>31</sup> A *posteriori* analysis may be carried out by the Antimonopoly Office.

<sup>32</sup> A *posteriori* analysis may be carried out by the Trade Competition Commission, usually with the assistance of the Department of Intellectual Property.

5. Si se responde afirmativamente a la pregunta 4, ¿hay cláusulas en los acuerdos de licencia de propiedad intelectual que pueden ser identificadas como restricciones “incondicionales” de la competencia (per se violaciones antimonopolio) y que, por tanto, se consideran ilegales e inválidas sin el examen de cualesquiera eficiencias potenciales producidas?



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. <sup>33</sup>  |
| Burkina Faso       |   |  |
| Belgium            | No deadline, after the contract is concluded.   |  |
| Bulgaria           | No deadline, but enforceability will be available only after the registration.                      |  |
| 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. <sup>34</sup>  | Yes.   |
| Greece             |   |  |
| Hungary            | No deadline.  | No. <sup>35</sup>  |
| Iceland            |   |  |
| Ireland            | No deadline.  |  |
| Japan (I)          |   | Yes.   |
| Lithuania          | No deadline.  |  |
| Luxembourg         | No deadline.  |  |

<sup>33</sup> "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).

<sup>34</sup> 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).

<sup>35</sup> 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

|                           |                            |      |
|---------------------------|----------------------------|------|
| <b>Madagascar</b>         | No deadline.               |      |
| <b>Moldova</b>            | No deadline. <sup>36</sup> | Yes. |
| <b>Norway</b>             | No deadline. <sup>37</sup> |      |
| <b>Philippines</b>        |                            | Yes. |
| <b>Poland</b>             | No deadline.               |      |
| <b>Russian Federation</b> | No deadline.               |      |
| <b>Slovak Republic</b>    | No deadline. <sup>38</sup> | Yes. |
| <b>Slovenia</b>           |                            |      |
| <b>Spain</b>              | No deadline. <sup>39</sup> |      |
| <b>Thailand (I)</b>       |                            | Yes. |
| <b>United States (I)</b>  |                            | Yes. |
| <b>Uruguay</b>            | No deadline.               | Yes. |

<sup>36</sup> At any moment during the validity of the contract.

<sup>37</sup> 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.

<sup>38</sup> 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.

<sup>39</sup> But as soon as possible, so as to produce effects against third parties.

- 1. Contratos de Transferencia de Tecnología (CTT) que impliquen la licencia/cesión de PI no están imunes a la aplicación del derecho de competencia/antimonopolio, apesar de los reconocidos efectos positivos.**
- 2. Sin embargo, el monitoreo *ex ante* de los CTT no es práctica común. El registro los CTT en general, si exigido, en general lo es sólo para efectos de información pública, y posibilitar efectos contra terceros.**

**3. El registro de CTT, cuando exigido, es realizado por las oficinas nacionales de PI.**

**4. La elección de cláusulas *per se* es una práctica común en las leyes nacionales, pero en general prevalece el análisis *a posteriori* por las autoridades de competencia (o los tribunales) en el marco de la regla de la razón.**

# Gracias!

**Los resultados de la labor de la OMPI sobre  
PI y Competencia están en**

**<http://www.wipo.int/ip-competition/en/>**

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