گفتار سوم:

کاربرد قاعده در قراردادهای مالکیت فکری محور

شاید چالشی ترین، پیچیده ترین و در عین حال کاربردی ترین بخش این قاعده امکان تعمیم و تطبیق ادله ناظر به معامله با مال غیر بر مال فکری و استخراج آثار قاعده فیمابین ثالث، متعاملین و دیگر اشخاص باشد. جستجوی و بررسیهای اولیه نویسنده حاکی از این واقعیت است که این پرسش تاکنون نه در فقه امامیه و نه فقه سنت و نه در قوانین مالکیت فکری ایران و نه دیگر کشورها مورد توجه شایسته قرار نگرفته است. نه تنها رویه قضایی در این کشورها فرصت اظهارنظر مناسب پیدا نکرده است بلکه دکترین نیز توجه کافی به آن نداشته انست. نظر به اهمیت نظری و کاربردی این مساله ذیلا جایگاه این پرسش در حقوق مالکیت فکری و فقه به اختصار تبیین و بررسی تفصیلی به فرصت دیگر موکول میشود.

1- جایگاه معاملات فضولی در تجارت اموال فکری

اگرچه مال فکری از تنوع گسترده نظیر اختراعات، طرحهای صنعتی، علایم تجاری، آثار علمی، ادبی-هنری و اسرار تجاری با با سرشت حقوقی و کارکرد اقتصادی و تجاری متفاوت برخوردار است، با این وجود بروز این چالش یعنی تحقق تجارت با مال فکری فی الواقع متعلق به غیر قابل تحقق می باشد. این امکان یک وقوع نظری صرف نیست. بلکه به سه جهت این وقوع حتمی است.

نخستین عامل سرشت حقوقی-اقتصادی این ارزش اقتصادی است؛ زیرا مال فکری عموما از جنس دانش و ایده خلاقانه می باشد. تولید ایده معمولا جمعی و با مشارکت موثر و متفاوت انجام و به همین جهت اختلاف در مالکیت معمولا لازمه چنین شیوه تولید ثروت است. این شیوه تولید در محیطهای دانشگاهی و مراکز تحقیقات و تحقیقات جمعی معمول و مبتلا به می باشد. حقوق مالکیت فکری علیرغم توسعه کمی و کیفی در طراحی نظام حمایت از تولید ایده های خلاقانه و ارتقای استاندارد های حمایتی، در خصوص ارائه معیارهای نوعی احراز مالکیت تاکنون توفیق چندانی نداشته است. به همین جهت، یکی از ابهامات در این رژیم حقوقی تعیین مالک در تولید مال فکری مخصوصا اختراعات و طرحها و آثار علیم، ادبی و هنری است.

دومین عامل، رویه و شیوه های ثبت اموال فکری ثبت محور است. ساختار و رویه های معمول در ادارات ثبت این نوع اموال فکری به گونه ای است که اختلاف در مالکیت را تشدید میکند.

درست به همین جهات است که قانونگذار ایرانی قانون فوق الذکر به ناچار در ماده 18 اختلاف در مالکیت را از موجبات ابطال گواهی اختراع اعلام داشته است. این حکم در ماده 29 عینا در خصوص طرحهای صنعتی تکرار و در ماده 41 در خصوص علایم تجاری نیز تکرار شده است. با این حال، به نظر میرسد این چالش منحصر به اموال فکری فوق الذکر نبوده و در رابطه با اموال فکری موضوع دیگر قوانین مالکیت فکری ایران نظیر قانون حمایت مولفان، مصنفان و هنرمندان سال و در رابطه با اموال فکری موضوع دیگر قوانین مالکیت فکری ایران نظیر قانون حمایت ارقام گیاهی سال 1382 و نظایر قانون حمایت از پدیدآورندگان نرم افزارهای رایانه ای سال 1379 و قانون ثبت ارقام گیاهی سال 1382 و نظایر آن قابل تحقق می باشد.

البته همانطوریکه مقررات فوق الذکر نشان میدهد، تنها مصداق ادعا از سوی ثالث ادعای مالکیت است. در حالیکه دو مصداق دیگر نیز قابل تحقق است یکی ادعای توثیق و دیگری ادعای مجوز بهره برداری یا لیسانس.

توجها، به جهات فوق امکان طرح ادعای مالکیت از سوی ثالث بسیار محتمل و توجه به وضعیت این نوع معاملات و حقوق و تکالیف اطراف این معاملات لازم می باشد.

-2 وضعيت معامله با مال فكرى موضوع حق ثالث

قوانین مالکیت فکری، نه در ایران و نه در دیگر کشورها، به این پرسش چالشی و با اهمیت توجه روشنی نداشته است. با این وجود، محتمل است بر این باور بود که دستکم در خصوص سه مال فکری یعنی اختراعات، طرحهای صنعتی و علایم تجاری قانونگذار ایرانی مداخله و وضعیت این معاملات را به اجمال مشخص نمود. وفق این احتمال، ماده 18 قانون سال 1386 این معاملات را محکوم به بطلان دانسته و به همین جهت اختراع از تاریخ ثبت اظهارنامه کان لم یکن تلقی شده

است. اطلاق این ماده شامل حقوق مالکانه، دعاوی مطروح نزد محاکم و معاملات مبتنی بر آن می باشد. این حکم در مواد 29 و 41 نیز به نحوی تکرار و با وحدت ملاک در خصوص دیگر اموال فکری نیز قابل تطبیق می باشد.

با این وجود، به نظر میرسد این اطلاق فاقد اعتبار بوده و منعکس کننده دیدگاه قانونگذار ایرانی در این خصوص نمی باشد. زیرا، اولا این حکم تنها ناظر به تحدید حقوق مالکانه ناشی از مواد 5 و 15 این قانون بوده و اساسا قانونگذار در این خصوص در مقام بیان نیست. ثانیا، معاملات اساسا از شمول این ماده خارج و در مواد 48 به بعد مورد توجه قرار گرفته است. ثالثا، اماره قطعیه بر عدم تحقق چنین اطلاقی است زیرا قانونگذار ایرانی در تمام اقسام معاملات فضولی قایل به صحت شده نه بطلان لذا انتساب نظریه بطلان به ایشان در این خصوص بسیار دشوار و امکان تحقق چنین اطلاقی در این خصوص نیست.

عميم و تطبيق ادله معامله با مال غير بر معامله با مال فكرى غير-3

نظر به سکوت قانونگذار در قوانین مالکیت فکری ظاهرا چاره ای جز توسل به عمومات قراردادی نیست. بر این اساس، نزدیکترین قاعده در این خصوص قاعده معامله با مال غیر است. حال این پرسش مطرح است آیا معامله با مال فکری متعلق حق ثالث آیا صحیح و غیر نافذ بوده و سرنوشت آن باید به ثالث مدعی سپرده شود یا حتی باطل و یا صحیح و نافذ ولی قابل فسخ توسط متعامل و سرمایه گذار و کارآفرین؟

همین پرسش در فقه نیز قابل طرح است. نظر به عدم اظهارنظر از سوی فقیهان پرسش به ظاهر چالشی و منشای تردید در وضعیت شرعی این نوع معاملات نیز می باشد.

در حقوق دیگر کشورها نیز وضعیت چندان بهتر نیست. ذیلا به اختصار موضع حقوقی برخی از کشورهای دیگر طرح میشود.

الف – حقوق کامن لا: در حقوق انگلیس تاکنون قانونگذار مداخله ای نداشته است. رویه قضایی هم فرصت اظهارنظر روشن پیدا نکرده است. ولی دکترین تا حدودی موفق به واکنش شده است. برای نمونه به متن زیر از سوی یکی از حقوقدانان این کشور توجه شود.

The position of this contractual duty of the licensor is not clear under English law. Describing this issue, Noel Byrne says: "The licensor should be required to warrant expressly that, being the proprietor or a person authorized by the proprietor, he can grant to the licensee specified in the licensing agreement. Care should be taken by the licensor to ensure that, when he warrants his title, he does not warrant a marketable title. The prospective licensee should check registers maintained by patent and trade mark offices and other documents to establish that the licensor's title or authorization is as warranted. An assignment, license or sublicense taken from a party with a registerable interest that has not been registered could be defeated by a subsequent transaction. The licensee might require more than just a warranty as to unencumbered title at the time the licensing agreement is signed or comes into effect. He may press for a covenant to the effect that, whilst the agreement is in force, the licensor will not act inconsistently with the licensee's enjoyment of the license, e.g., by encumbering the IP or by assigning it (particularly where the licensee is expecting to receive technical improvements from the licensor). It could be made a condition of the agreement that the licensor must notify the licensee of a contemplated encumbrance, assignment or transfer and obtain his prior written consent to it, such consent not to be withheld unreasonably."

ایشان سپس با استناد به ماده 76 قانون اموال سال 1925 اصلاحی 1994 انطباق این قاعده را بر یکی از عقود مالکیت فکری محور یعنی قرارداد واگذاری مورد تردید قرارداد داده و چنین می نویسد:

"if the proprietor of IP assigned the property for value 'as beneficial owner', arguably, s. 76 implied these covenants in the assignment":

Quite Enjoyment Requirement in English Law: A covenant for quite enjoyment is not implied ordinarily (although in one case the court found it as implied in a patent license contract); it must be negotiated and expressed in the licensing agreement. The covenant may be breached in various ways, for example by the licensor failing to pay renewal fees for patents or other registered rights, or perhaps failing to proceed against infringers. In Mills v. Carson, the licensor (Notley) granted by deed to Carson and Defries an exclusive license to make, use, exercise and vend, together with the power to sublicense, the patented invention (a safety lamp burner)

within the UK for the remainder of the term of years for which the patent had been granted, and to apply for and grant to them all colonial and foreign rights and privileges in his invention. The licensee covenanted to make certain payments to the licensor; and the licensor covenanted with the licensee that, if they honoured their obligations to him, they 'should at all times during the residue of the said term, peaceably and quietly hold, exercise and enjoy the license thereby granted, with power to sublet and authorize others to sue the said invention without any lawful interruption and disturbance by the said William Notley, his executors, administrators, or assigns, or any other person whatsoever'. The licensor undertook further that, if any infringement occurred or was threatened, at the request of the licensee and for their benefit he would, at his own cost, commence infringement proceedings. It was provided also that if the licensor did not take proceedings, or if the patent became void by reason of his not taking proceedings or of the invention not being novel or being an infringement of other patents, the royalties would come to an end. Notley assigned his interest in the licensed patents to Mills, to whom the licensees paid covenanted sums. At the end of four years the patent lapsed owing to non-payment of renewal fees. The licensees refused to make any further payment, on the ground that the obligation to do so ceased with the life of the patent. Mills sued for unpaid royalties. The licensees contended that the licensor was under an implied duty to pay the renewal fees, and that the plaintiff's failure to pay these fees amounted to a breach of the covenant for quite enjoyment. It was assumed on appeal, without deciding it, that the licensor was subject to such a duty and that non-payment of the renewal fees was a lawful interruption brought about by the plaintiff's default. In other words, the plaintiff was in breach of the covenant for quite enjoyment, and he was liable to the defendants for the breach. But did that breach relieve the licensees from paying the covenanted royalties? 'What is the rule with regard to that?

That we should have no power to say that one covenant in a deed, in terms independent, is a condition precedent to the obligation under another covenant in the same deed equally independent, unless they are coextensive, and unless, as it seems to be under all circumstances, they would be coextensive. If there can be a breach of one of them which is not coextensive with the other then they are not sufficiently coextensive to make the one a condition precedent to the other, although some other breach of the one may be coextensive. It must be coextensive to the full extent. It is obvious to me that there may be a breach of the covenant for quite enjoyment which is not coextensive with the rights of the defendants or with the extent of this grant. The breach of the covenant for quite enjoyment would be complete if by the act of the plaintiff there was interference for a much shorter time than the length of the continuance of this license. They are not coextensive, and therefore, on that ground, we cannot hold that the covenant for quite enjoyment here is coextensive with the grant to the defendants in respect of which they are to pay, and cannot be a condition precedent under their independent covenant to pay this money.'

In short, the covenant for quite enjoyment was not a condition precedent to the covenant to pay the royalties. (A covenant to require royalties to be paid after a patent has been allowed by the licensor to laps could be incompatible with art 81(1) EC (now Article 101. But in this respect, see the current European case law as discussed in Item No. 4)

Under French law, however, a warranty by the licensor against legal disturbance (e.g. failure to pay patent renewal fees, assigning the license to the licensee's detriment) may be implied from Art 1719(3) of the Civil Code. It appears that, unlike the warranty against latent defects, the implied warranty against legal disturbance cannot be excluded by the licensor as it is an ordre public obligation. Italian law, by analogy with a contract of lease, implies in a patent license contract a warranty for

peaceful enjoyment (that is, against legal disturbance). (*Noel Byrne*, *ibid.*, *pp. 204-205*).

3- Non-Infringement Requirement

A prospective licensee is likely to be concerned in two respects on the question of infringement: first, possible or alleged infringements by third parties of the IP being offered to him under license; second, possible or alleged infringements of third-party rights arising from use or exploitation of the technology being offered to him under license. If litigation is pending against a third party, the would-be licensee will want protection against the risk of the IP being invalidated. As to possible infringements by third parties of the IP, licensors are not omniscient and no licensor properly advised would warrant in absolute terms that no unauthorized appropriation is taking place. The licensor may be prepared to represent that he is not aware of any third party who may be infringing the IP or misappropriating his know-how at the time of the license, but beyond that he ought not to go. If infringement proceedings are pending against the licensor with respect to the technology being offered on license, the prospective licensee will usually require the licensor to settle such proceedings, and to give an appropriate indemnity against infringements of third party rights arising from use or exportation of the licensed technology in the manner intended in the licensing agreement. Again, the licensor should not warrant that the technology offered for exportation does not infringe third party rights, but at most only that the licensor has no reason to believe that it does. The licensor should know, e.g., whether exploitation in the manner contemplated will infringe an exclusive license granted to a third party in respect of the same technology. (Noel Byrne, ibid., pp. 205-206).

در حقوق آمریکا قوانین مالکیت فکری در این خصوص ساکت است. اما موسسه حقوق آمریکا (ALIS) سعی در قوق آمریکا (ALIS) سعی در قاعده سازی نموده است. ابتدا به بهانه عدم کفایت American UCC Article 2 برای پوشش حقوقی لیسانس مال فکری پیش نویس اولیه American UCC Article 2B for License را در دهه 1990 منتشر ولی به

دلیل مخالفت گسترده از آن صرف نظر و در نهایت تحت عنوان UCITA به ایالتها پیشنهاد ولی در عمل تنها دو ایالت با آن موافقت نمودند! ذیلا به این قاعده سازی آمریکایی توجه شود:

Section 401 Warranties and Obligations Concerning Noninterference and No-Infringement:

(a) Warranty of non-infringement: A licensor of information that is a merchant regularly dealing in information of the kind warrants that the information will be delivered free of the rightful claim of any third person by way of infringement or misappropriation, but a licensee that furnishes detailed specifications to the licensor and the method required for meeting the specifications holds the licensor harmless against any such claim that arises out of compliance with either the required specification or the required method except for a claim that results from the failure of the licensor to adopt, or notify the licensee of, a non-infringing alternative of which the licensor had reason to know.

(b) Warranty of noninterference and exclusivity

A licensor warrants: (1) for the duration of the license, that no person holds a rightful claim to, or interest in, the information which arose from an act or omission of the licensor, other than a claim by way of infringement or misappropriation, which will interfere with the licensee's enjoyment of its interest; and (2) as to rights granted exclusively to the licensee, that within the scope of the license: (A) to the knowledge of the licensor, any licensed patent rights are valid and exclusive to the extent exclusivity and validity are recognized by the law under which the patent rights were created; and (B) in all other cases, the licensed informational rights are valid and exclusive for the information as a whole to the extent exclusivity and validity are recognized by the law applicable to the licensed rights in a jurisdiction to which the license applies.

(c) Exceptions and limitations

The warranties in this section are subject to the following rules:

(1) Governmental mandates

If the licensed informational rights are subject to a right of privileged use, collective administration, or compulsory licensing, the warranty is not made with respect to those rights.

(2) Territorial assumptions

The obligations under subsections (a) and (b)(2) apply solely to informational rights arising under the laws of the United States or a State, unless the contract expressly provides that the warranty obligations extend to rights under the laws of other countries. Language is sufficient for this purpose if it states "The licensor warrants 'exclusivity', 'non-infringement', 'in specified countries', 'worldwide'", or words of similar import. In that case, the warranty extends to the specified country or, in the case of a reference to "worldwide" or the like, to all countries within the description, but only to the extent the rights are recognized under a treaty or international convention to which the country and the United States are signatories.

(3) Patent licenses

The warranties under subsections (a) and (b)(2) are not made by a license that merely permits use, or covenants not to claim infringement because of the use, of rights under a licensed patent.

(d) Disclaimer or Modification Permitted

Except as otherwise provided in subsection (e), a warranty under this section may be disclaimed or modified only by specific language or by circumstances that give the licensee reason to know that the licensor does not warrant that competing claims do not exist or that the licensor purports to grant only the rights it may have. An obligation to hold harmless under subsection (a) may be disclaimed or modified only by specific language or by circumstances giving the licensor reason to know that the licensee does not provide a hold-harmless obligation to the licensor. In an automated transaction, language is sufficient if it is conspicuous. Otherwise, language in a record is sufficient if it states:

(1) as to a licensor's obligation, "There is no warranty against interference with your enjoyment of the information or against infringement", or words of similar import; or

(2) as to a licensee's obligation, "There is no obligation to hold you harmless from any actions taken in compliance with the specifications or methods furnished by me under this contract", or words of similar import.

(e) Quitclaims

Between merchants, a grant of a "quitclaim", or a grant in similar terms, grants the information or informational rights without an implied warranty as to infringement or misappropriation or as to the rights actually possessed or transferred by the licensor.

"In civil law countries, the general law may imply, as in Germany, a warranty by the licensor against legal deficiencies; that the license right exists on the date of the agreement, that the licensor has an unrestricted power to grant licenses, and that there is no lien or mortgage encumbering the licensed right. If it should transpire that a third party has a statutory right (comparable to that given by s 64 of the UK Patent Act 1977 or to that given under Article 15(c)(4) of the Iranian Patent Act 1386, i.e. prior right) to use a patented invention, the German courts can amend the licensing contract under article 242 of the German Civil Code (i.e. Performance according to Good Faith). There is no implied warranty in respect of patent validity.

Under French law, a warranty against latent defects (vices caches) is impliedly by the French civil Code. Thus, under Article 1643 of the French Civil code, the licensor of a patent guarantees it against latent defects, whether legal or technical. If a license contract is assimilated to a contract of lease, the warranty can be implied on the basis of article 1721 of the Civil Code. The Patentee may limit the warranty to such defects as were or ought to have been known to him when he granted the license." *Noel Byrne*, *ibid.*, *pp. 201-202*).

ج - حقوق تجارت بین الملل در حقوق تجارت بین الملل تاکنون نه آنسیترال، نه یونیدوقوا و نه وایپو و نه ICC در این خصوص پیشنهادی ارائه ننمودند. تنها یک "حقوق قراردادهای نمونه برای اموال فکری" از سوی حقوقدانان در یک کنفرانس وایپو پیشنهاد شده است که مواد مربوطه ذیلا نقل میشود:

Model IP Contract Law

Article 17– (Implied Warranty of Title in Assignments):

"An assignor impliedly warrants to the assignee that the assignor owns or controls the ownership interest in the intellectual property within the scope of the assignment and has not previously transferred such interest to any other party."

Upon this proposal, the licensor does not impliedly covenant to such general warranty.

Article 18– Failure of Warranty: "In an intellectual property contract a warranting party agrees to hold the other contracting party harmless from any liability to a third party due to the failure of a warranty by the warranting party up to the value of the consideration received by warranting party in the contract."

Article 19 Disclaimer of Warranty: "Parties to an intellectual property contract may disclaim or limit the scope of any warranty or the remedies for the failure of any warranty provided the language so doing is unambiguous."

Andrea Tosato, Intellectual Property License Contracts: Reflections on a Prospective UNCITRAL Project, University of Cincinnati Law Review Volume 86 Issue 4 Article 4 December 2018

The position of the case is not also clear under Iranian Law. But see Art 18 of the 1386 Act.

ممكن است كسى قايل به اطلاق يا عموم اين ماده شده و بر بطلان عقد بر مثلا اختراع متعلق به غير نظر دهد. كمااينكه در باب فضولى برخى بر اين نظرند (رك به: شيخ انصارى، مكاسب، جلد 3، ص 345 و 346، و سيد بحرالعلوم، بلغه الفقيه، جلد 2، ص 202). به نظر ميرسد اطلاق ادعايى نادرست و ادعاى بطلان عقد مزبور فاقد وجاهت است.

به همین جهت، پا سخ به این پر سش بسته به امکان انطباق قاعده رایج در تجارت کالا محور بر تجارت مالکیت فکری محور است!

ذ- مقايسه تطبيقي

همانطوریکه به اختصار اشاره شد، حقوق کامن لا ادعای های ثالث را به ادعای حق عینی، حق تقدم و ادعای منجر به مزاحمت تقسیم میکند و برای هر ادعا نیز ضهانت اجرای متفاوت مقرر میدارد. در مواد 41 و 42 کنوانسیون وین نیز این ادعا ها به دو دسته کلی یعنی ادعای بر عین و ادعاهای مبتنی بر مالکیت فکری تقسیم میشود. البته در این سند ضمانت اجراها ظاهرا یکسان است.

در برابر، در فقه دامنه ادعاها بسيار توسعه داده شده است به حديكه حتى شامل حق ولى بر دختر باكره نيز شده است! (رك به: مكاسب، انتشارات مجمع الفكر الاسلامي، جلد 3، ص 346 و بلغه الفقيه، انتشارات مكتبه الصادق، جلد 2، ص 202).

Iranian Law:

As explained above, unlike common law, no differentiation made between these two implied covenant in Iranian and Shieh law. The position of this implied covenant seems not also clear. But see, however, the general language of Art 18 of the 1386 Act.

پر سش: به نظر شما ایا در حقوق ایران بین انواع ادعاها فرقی وجود ندارد؟ آیا ا سا سا، سیا ست اتخاذی فقیهان در دفاع حداکثری از ثالث مدعی و ارجاع منتقل الیه با حسن نیت به قاعده تسبیب و یا قاعده غروز قابل دفاع میباشد؟