

۳- تعهد فقدان ادعا از سوی ثالث

Does the Assignor/Licensor Legally Covenant to Having Full and Good Title over IPR

نخستین تعهد چالشی در عقود ناقله تعهد به انتقال حق مالکانه بلامنازع به منتقل الیه است. این تعهد ابتدا در حقوق معاملات کالا محور کامن لایی، اتحادیه اروپا، حقوق تجارت بین الملل و دیگر کشورها طرح و سپس جایگاه آن در حقوق ایران و فقه امامیه طرح و پس از مقایسه و ارزیابی در ادامه بر عقود مالکیت فکری محور نیز تطبیق داده شده و مورد ارزیابی قرار میگیرد.

Goods Based Transactions

الف - حقوق کامن لا

معامله با مال غیر یکمساله تاریخی و ریشه در حقوق روم دارد. رومیان این قاعده را با عبارت لاتین *a non-domino* توصیف می نمودند.

A non-domino is a **disposition of property granted by a party who has no title to it**. The words a non-domino mean 'from someone who is not the owner'.

همین قاعده رومی در حقوق موضوعه کشورهای متأثر از دو خانواده حقوقی کامن لایی و رومی ژرمنی مورد پذیرش قرار گرفته است. طبق این قاعده، نظریه بطلان معاملات فضولی در حقوق هر دو خانواده حقوقی به مثابه یک اصل کلی مورد پذیرش قرار گرفته است. با این وجود، در این دو خانواده حقوقی به تدریج نظریه بطلان مطلق به بطلان نسبی تنزل یافت. به بیان دیگر، بطلان در حقوق اینکشورها نسبی است. یعنی معامله توسط مالک قابل ابطال به حکم دادگاه است و قبل از رای دادگاه فیما بین طرفین قرارداد واجد آثار حقوقی همانند عقد صحیح می باشد. اضافه بر این، در هر دو خانواده یک رژیم استثنائاتی شکل گرفته است. اگرچه این استثنائات در کشورهای اروپای

قاره ایی با کامن لایی متفاوت است: در اروپای قاره ای استثنائات تحت قاعده ای مستقل یعنی حمایت از خریدار با حسن نیت توجیه در حالیکه کشورهای کامن لایی مسلک تابع رژیم استثنائات متفرقه می باشند. این قاعده در بند 1 ماده 21 قانون بیع سال 1979 انگلیس تحت عنوان "انتقال مالکیت" به شرح زیر منعکس شده است.

Section 21: Sale by Person not the Owner

(1)- Subject to this Act, where goods are sold by a person who is not their owner, and who does not sell them under the authority or with the consent of the owner, ***the buyer acquires no better title to the goods than the seller had,*** unless the owner of the goods is by his conduct precluded from denying the seller's authority to sell.

مبنای نظری بطلان

با این وجود، به نظر میرسد همانند فقه مهمترین مبنای نظری برای توجیه بطلان در حقوق موضوعه ممنوعیت تصرف ثالث در مال غیر باشد. در این خصوص رک به اظهارنظر زیر که به تفصیل سه دیدگاه بطلان محض، بطلان نسبی با رژیم استثنائات پراکنده و بطلان نسبی مشمول یک استثناء قاعده مند را در پرتو تحولات تاریخی طرح و توصیف می نماید. ذیلا نظریه بطلان محض نقل میشود:

I. The Original Owner Rule

At the first extreme the original owner's legal interests are being meticulously protected irrespective of the means in which he was deprived of his property. The owner is granted the right to claim back his property, wherever he finds it, even if it has passed in the hands of a good faith acquirer. The roots of the original owner rule can be traced back to Roman private law. In the early period (about 450 BC) private law was codified by Lex Duodecim Decorum (The Twelve Tables) and original acquisition of ownership was recognized by acquisitive prescription only – the so

called *usucapio*. This principle intended to protect the owner of the movable from being deprived of his property, on one hand, and the party in possession who could acquire the movable after a certain period of time. A means for the owner of the movable was 1 “*Nemo plus iuris ad alium transferre potest quam ipse habet*”- D.50, 17, 54. 2 “*Id, quod nostrum est, sine facto nostro ad alium transferri non potest* – D. 50, 17, 11. provided to claim back his property if the prescriptive period had not run. By the Classical period of Roman law, extending from 1 AD to the end of the third century AD the rules on acquisitive prescription evolved immensely. The major principle, applicable both to immovables and movables, was formulated by Ulpianus – “One cannot acquire ownership from a person who is not himself the owner” 1. Together with another tenet, formulated by Paulus “What belongs us cannot be transferred to another without our consent” 2, they formed a concept of the consistent protection of the original owner. During this period, the basic action available to an owner out of possession to recover his property, both movable and immovable was the *rei vindicatio*, or revandicatory action. Initially the period for this action was limited to one year. The possessor could repel the claim if proving the fact that his possession had lasted longer than one year, without having to prove anything else. This circumstance was seriously obstructing the interests of the original owner. That’s why at the end of the Republican era the prerequisites for the *usucapio* were set to five elements: *res habilis* (a movable or immovable thing that is not *extra commercium*), *possessio*, *iustus titulus* (a just title, capable of transferring ownership by nature), *bona fides* (good faith) and *tempus* (an elapsed period of time). Furthermore, at the time of Justinian and his *Corpus Iuris Civilis*, enacted in the middle of the 6th century, the prescriptive period was increased to three years. If the prerequisites were not met (for example, if the *iustus titulus* was not present because of the circumstance that the goods were lost or stolen, or the possessor was lacking good faith) the period of possession necessary to acquire the thing was set to thirty

years. In addition, the Justinian legislation strengthened the *rei vindicatio* so that the owner could pursue his property during the whole prescriptive period. As a conclusion, Roman law established and developed an approach that meticulously protected the dispossessed owner.

This approach has been enacted by a series of national legislations. English common law takes as a starting point the *nemo plus iuris* principle. As a consequence, if someone has disposed of a property not belonging to him, in the conflict between the original owner and a third acquirer the former has the stronger position. This is expressed in art. 21 (1) of the English Sale of Goods Act of 1979 (SGA)³.

The major difference between English and civil law in respect of good faith acquisition is that the first one lacks a general exception to the *nemo plus iuris* rule to benefit the good faith acquirer. Rather, the SGA of 1979 provides several statutory exceptions to this principle. The emergence of these exceptions is to an extent influenced by a statement by Lord Denning: "In the development of our law two principles have striven for mastery. The first is for the protection of property: nobody can give a better title than he himself possesses. The second one is for the protection of commercial transactions: the person who takes in good faith and for value without notice should get a good title."⁴ The first exception concerns apparent authority (also known as the doctrine of estoppel), which is actually provided in the second part of art. 21 (1) SGA'1979 "... unless the owner of the goods is by his conduct precluded from denying the seller's authority to sell". This doctrine means that if the owner has assured the buyer that the seller has an actual right to transfer the title of the goods, the buyer can acquire the title despite the fact the seller was not the owner⁵. The second statutory exception to the *nemo plus iuris* principle is referred to as sale under voidable title (art. 23 of the SGA) - "When the seller of goods has a voidable title to them, but this title has not been voided at the time of the sale, the buyer acquires a good title, provided he buys them in good faith and without notice of the

seller's defect of title". It offers protection to the buyer of a movable if he purchased it in good faith and did not know that his seller has a defect of title (cases of fraud, duress, misrepresentation etc.). The SGA contained the market overt rule as well, but the provision was abolished in 1995. Other statutory exceptions can be found in the Factors Act of 1889, concerning cases of mercantile agency⁷ and seller in possession after sale⁸.

The provisions of the English Sale of Goods Act have influenced a number of common law national legislations, like Scotland and Northern Ireland (as part of the United Kingdom), Cyprus⁹, India¹⁰, Canada¹¹ etc.

Among the countries whose national legislations belong to the Continental legal system Portugal is the only country whose Civil Code has fully adopted the *nemo plus iuris* principle. Portuguese civil law does not recognize good faith acquisition. There are no rules comparable to the "possession is equal to a title" principle, embodied in the French law, or even to the provisions of §929-932 BGB allowing the good faith purchase despite the enhanced protection of the original owner. This circumstance results in the legal construction that a sales contract, by which the seller is neither the owner, nor legally entitled to dispose of the goods, is considered void, as art. 892 of the Portuguese Civil Code explicitly provides. If, however, such a contract is concluded and the purchaser acting in good faith, paid a consideration, the Portuguese legislator provides a restitution claim for the price because of unjustified enrichment of the transferor (art. 894 of the Portuguese Civil Code). The dispossessed owner can always claim back his movable, no matter how much time has elapsed. (Dimitar STOYANOV, THE CONFLICT BETWEEN THE LEGAL INTERESTS OF THE ORIGINAL OWNER AND THE GOOD FAITH ACQUIRER OF MOVABLES – A COMPARATIVE OVERVIEW OF THE SOLUTIONS, LESIJ NO. XXII, VOL. 1/2015, pp. 94-6.)

همچنین، ادعای ثالث اشکال متفاوتی دارد. بسته به نوع ادعا وضعیت معامله و ضمانت اجرا متفاوت می باشد. در حقوق کامن لا این تفاوت به خوبی در قانون موضوعه و رویه قضایی و دکترین مورد توجه قرار گرفته است. به عنوان نمونه یکی از حقوق دانان انگلیسی به نام آقای Noel Byrne مستندا به ماده ۷۶ قانون اموال سال ۱۹۲۵ اصلاحی سال ۱۹۹۴ انگلیس اشکال این ادعا در عقود ناقله را چنین توصیف می نماید.

- (i) The assignor has full power to assign, ادعای مالکیت
- (ii) The assignee will have quite enjoyment of the property assigned (this is not implied by the 1994 Act), ادعای مزاحمت
- (iii) The assignment is made free from any encumbrances, and ادعای ممانعت
- (iv) The assignor will do what is reasonably required at the assignee's cost to further assure (or perfect) the assignee's title to the property. (Ibid., p. 201).

همچنین، آثار و ضمانت اجرای این نوع ادعا در حقوق بیع انگلیسی در ماده ۱۲ قانون بیع سال ۱۹۷۹ این کشور تطبیق داده شده است.

(1) In a contract of sale, other than one to which subsection (3) below applies, there is an implied on the part of the seller that in the case of a sale he has a right to sell the goods, and in the case of an agreement to sell he will have such a right at the time when the property is to pass.

(2) In a contract of sale, other than one to which subsection (3) below applies, there is also an implied that (a) the goods are free, and will remain free until the time when the property is to pass, from any charge or encumbrance not disclosed or known to the buyer before the contract is made, and (b) the buyer will enjoy quiet possession of the goods except so far as it may be disturbed by the owner or other person entitled to the benefit of any charge or encumbrance so disclosed or known. (3) This subsection applies to a contract of sale in the case of which there appears from the

contract or is to be inferred from its circumstances an intention that the seller should transfer only such title as he or a third person may have. (4) In a contract to which subsection (3) above applies there is an implied that all charges or encumbrances known to the seller and not known to the buyer have been disclosed to the buyer before the contract is made. (5) In a contract to which subsection (3) above applies there is also an implied that none of the following will disturb the buyer's quiet possession of the goods, namely (a) the seller; (b) in a case where the parties to the contract intend that the seller should transfer only such title as a third person may have, that person; (c) anyone claiming through or under the seller or that third person otherwise than under a charge or encumbrance disclosed or known to the buyer before the contract is made. As regards England and Wales and Northern Ireland, the term implied by subsection (1) above is a condition and the terms implied by subsections (2), (4) and (5) above are warranties.]. (6) Paragraph 3 of Schedule 1 below applies in relation to a contract made before 18 May 1973. This section does not apply to a contract to which Chapter 2 of Part 1 of the Consumer Rights Act 2015 applies (but see the provision made about such contracts in section 17 of that Act).]

همچنین در حقوق آمریکا رک:

UCC § 2-312. Warranty of Title and Against Infringement; Buyer's Obligation against Infringement (version 2001):

(1) Subject to subsection (2) there is in a contract for sale a warranty by the seller that (a) the title conveyed shall be good, and its transfer rightful; and (b) the goods shall be delivered free from any security interest or other lien or encumbrance of which the buyer at the time of contracting has no knowledge.

(2) A warranty under subsection (1) will be excluded or modified only by specific language or by circumstances which give the buyer reason to know that the person selling does not claim title in himself or that he is purporting to sell only such right or title as he or a third person may have. (3) Unless otherwise agreed a seller who is a merchant regularly dealing in goods of the kind warrants that the goods shall be delivered free of the rightful claim of any third person by way of infringement or the like but a buyer who furnishes specifications to the seller must hold the seller harmless against any such claim which arises out of compliance with the specifications.

ب- در حقوق اتحادیه اروپا رک به :

The Draft of European Private Law, Book VIII, Chapter 3, Good faith acquisition of ownership, sections 101-102.

VIII. 3:101: Good faith acquisition through a person without right or authority to transfer ownership

(1) Where the person purporting to transfer the ownership (the transferor) has no right or authority to transfer ownership of the goods, the transferee nevertheless acquires and the former owner loses ownership provided that:,

VIII. 3:102: Good faith acquisition of ownership free of limited proprietary rights

(1) Where the goods are encumbered with a limited proprietary right of a third person and the transferor has no right or authority to dispose of the goods free of the third person's right, the transferee nevertheless acquires ownership free of this right provided that:

همانند حقوق آمریکا، در حقوق اتحادیه اروپا نیز تنها به آثار و ضمانت اجراها اشاره و برخلاف حقوق انگلیس به

مبنای حقوقی این آثار و ضمانت اجراها یعنی تعهدات ضمنی اشاره نشده است!

CISG Articles 41 m& 42

Article 41: The seller must deliver goods which are free from any right or claim of a third party, unless the buyer agreed to take the goods subject to that right or claim. However, if such right or claim is based on industrial property or other intellectual property, the seller's obligation is governed by article 42.

Article 42 (1) The seller must deliver goods which are free from any right or claim of a third party based on industrial property or other intellectual property, of which at the time of the conclusion of the contract the seller knew or could not have been unaware, provided that the right or claim is based on industrial property or other intellectual property:

(a) under the law of the State where the goods will be resold or otherwise used, if it was contemplated by the parties at the time of the conclusion of the contract that the goods would be resold or otherwise used in that State; or (b) in any other case, under the law of the State where the buyer has his place of business. (2) The obligation of the seller under the preceding paragraph does not extend to cases where: (a) at the time of the conclusion of the contract the buyer knew or could not have been unaware of the right or claim; or (b) the right or claim results from the seller's compliance with technical drawings, designs, formulae or other such specifications furnished by the buyer.

د- حقوق ایران

در حقوق ایران، به تبعیت از فقه وضعیت معامله با مال غیر کاملاً متفاوت با حقوق کامن لا است. در این تفکر حقوقی معامله با مال غیر صحیح ولی غیر نافذ و فاقد اثر حقوقی برای منتقل الیه است (ماده 247 قانون مدنی). در این رویکرد، منتقل الیه هر چند جاهل و دارای حسن نیت کامل هیچ کنترلی بر معامله فضولی ندارد. بلکه

معامله در اختیار مدعی ثالث بوده تا به دلخواه یا به همان شرایط منعقدۀ تنفیذ و یا رد نماید. تنها حق منتقل الیه حق فسخ در صورت تاخیر ثالث در تنفیذ یا رد است (ماده 252 قانون مدنی). همچنین، با رد معامله توسط ثالث منتقل الیه تنها مستحق مطالبه ثمن پرداختی به فضول و مطالبه خسارت غیر قراردادی از ایشان بر مبنای غرور یا تسبیب می باشد (ماده 263 قانون مدنی). علاوه بر این، منتقل الیه در مدت تصرف در مورد معامله ضامن عین و منافع آن بوده و با رد معامله توسط ثالث باید اجرت منافع از دست رفته را مطابق به ثالث تادیه نماید. اضافه بر اینکه ایشان ضامن عیوب حادث حین تصرف نیز می باشد.

همانطوریکه ملاحظه میشود در این تفکر حقوقی کمترین حمایت از متعامل اصیل میشود. در برابر، از ثالث مدعی بیشترین حمایت شده است!

این رویکرد ریشه در تفکر فقهی فقیهان دارد. در فقه قرنهای نظر بر بطلان معامله با مال غیر بوده است. متعاقبا نظریه صحت غیرنافذ در فقه رایج و قانون مدنی از این نظر تبعیت نموده است. در این رویکرد، بر خلاف حقوق کامن لا، تفاوتی در نوع ادعا نیست، چه ادعای مالکیت بر عین، منافع، انتفاع و حتی حق وثیقه مشمول این قاعده است! جالب این است که در فقه فقیهان مدافع این نظریه، حتی حق غیر مالی چون حق پدر یا جد پدری را نیز مشمول این قاعده تلقی و بر این اساس نکاح دختر باکره را به دلیل فقدان اذن پدر یا جد پدری غیر نافذ دانسته و اعتبار آنرا منوط به تحقق اجازه لاحق ایشان میدانند!!!

توجهها به این دو رویکرد، جایگاه این قاعده در تجارت مالکیت فکری محور عموما و قرارداد لیسانس خصوصا در دو تفکر حقوقی کامن لا و حقوق ایران و فقه طرح و مقایسه میشود.

IP Based Transactions

در خصوص وضعیت معامله با مال فکری متعلق به غیر یا موضوع ادعای ثالث متون قانونی در حقوق مالکیت فکری ساکتند. رویه قضایی نیز در این خصوص به دلیل فقد سابقه روشن نیست. دکترین نیز در این خصوص فاقد تحلیل روشن است.

نظر به اهمیت موضوع و تفاوت مفروض فیما بین معاملات کالا محور و مالکیت فکری محور ذیلا جایگاه موضوع در حقوق موضوعه و اسناد بین المللی طرح میگردد.

الف- حقوق کامن لا: در حقوق انگلیس تاکنون قانونگذار مداخله ای نداشته است. رویه قضایی هم فرصت اظهار نظر 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 ۷۶ قانون اموال سال ۱۹۲۵ اصلاحی ۱۹۹۴ 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 quiet 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 quiet 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 quiet enjoyment which is not coextensive with the rights of the defendants or with the extent of this grant. The breach of the covenant for quiet 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 quiet 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 quiet 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 lapse 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 قاعده سازی نموده است. ابتدا به بهانه عدم کفایت 2 American UCC Article 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 Non-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.

ب- حقوق رومی ژرمنی

در کشورهای تابع حقوق رومی ژرمنی نیز وضعیت بهتر از این نیست. Noel Byrne موضع حقوقی این کشورها را به شرح زیر توصیف می نماید:

“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 یونیدوکوا 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."

در این خصوص رک به مقاله زیر:

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

د- حقوق ایران

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

ممکن است کسی قایل به اطلاق یا عموم این ماده شده و بر بطلان عقد بر مثلا اختراع متعلق به غیر نظر دهد.

کما اینکه در باب فضولی برخی بر این نظرند (رک به: شیخ انصاری، مکاسب، جلد ۳، ص ۳۴۵ و ۳۴۶، و سید

بحرالعلوم، بلغه الفقيه، جلد ۲، ص ۲۰۲). به نظر میرسد اطلاق ادعایی نادرست و ادعای بطلان عقد مزبور فاقد وجهت است.

به همین جهت، پاسخ به این پرسش بسته به امکان انطباق قاعده رایج در تجارت کالا محور بر تجارت مالکیت فکری محور است!

متأسفانه قانونگذار ایرانی موضوع ادعای مالکیت از سوی ثالث را به نحو بسیار مبهم و ناتمام و در جای نامناسب طرح نمود. مقتضای منطق اولاً تفکیک جهات ادعای ابطال از سوی ثالث است. ثانیاً، لازم است ضمانت اجرا و آثار حقوقی ادعای مالکیت از سوی ثالث نسبت به اظهارنامه یا گواهی ثبت به تفکیک مشخص شود. نظر به همین ضرورت است که کنوانسیون اختراعات اروپایی این دو موضوع را در دو جای متفاوت و تحت عنوان و مقررات مستقل طرح نمود.

ادعای ابطال به سبب مالکیت اختراع از سوی ثالث:

Article 61. European patent applications filed by non-entitled persons:

(1) If by a final decision it is adjudged that a person other than the applicant is entitled to the grant of the European patent, that person may, in accordance with the Implementing Regulations: (a) prosecute the European patent application as his own application in place of the applicant; (b) file a new European patent application in respect of the same invention; or, (c) request that the European patent application be refused.

(2) Article 76, paragraph 1, shall apply mutatis mutandis to a new European patent application filed under paragraph 1(b). **(Art. 76. European divisional applications:**

(1) A European divisional application shall be filed directly with the European Patent Office in accordance with the Implementing Regulations. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this requirement is complied with, the divisional

application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy any right of priority. (2) All the Contracting States designated in the earlier application at the time of filing of a European divisional application shall be deemed to be designated in the divisional application.

ادعای ابطال به سبب عدم رعایت شروط آمره:

Article 100. Grounds for opposition:

Opposition may only be filed on the grounds that: (a) the subject-matter of the European patent is not patentable under Articles 52 to 57, (b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; (c) the subject-matter of the European patent extends beyond the content of the application, as filed, or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed.

Article 138. Revocation of European patents: (1) Subject to Article 139, a European patent may be revoked with effect for a Contracting State only on the grounds that: (a) the subject-matter of the European patent is not patentable under Articles 52 to 57; (b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; (c) the subject-matter of the European patent extends beyond the content of the application as filed or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed; (d) the protection conferred by the European patent has been extended; or (e) the proprietor of the European patent is not entitled under Article 60, paragraph 1. (2) If the grounds for revocation affect the European patent only in part, the patent shall be limited by a corresponding amendment of the claims and revoked in part.

(3) In proceedings before the competent court or authority relating to the validity of the European patent, the proprietor of the patent shall have the right to limit the patent by amending the claims. The patent as thus limited shall form the basis for the proceedings.

ظاهراً ماده 18 قانون سال 1386 با اقتباس از ماده 56 کنوانسیون ناموفق اروپایی در رابطه با گواهی اختراع مشترک برای بازار اروپا تهیه شده است!!

European Community patents Convention 1975 enforced on 1985

Article 56: Grounds for revocation

1. An application for revocation of a Community Patent may be filed only on the grounds that:

(a) the subject-matter of the patent is not patentable within the terms of Articles 52 to 57 of the European Patent Convention; (b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; (c) the subject-matter of the patent extends beyond the content of the European patent application as filed, or, if the patent was granted on a European divisional application or on a new European application filed in accordance with Article 61 of the European Patent Convention, beyond the content of the earlier application as filed; (d) the protection conferred by the patent has been extended; (e) the proprietor of the patent is not, having regard to a decision which has to be recognized in all the Contracting States, entitled under Article 60 (1) of the European Patent Convention; (f) the subject-matter of the patent is not patentable within the terms of Article 36 (1).

2. If the grounds for revocation affect the patent only partially, revocation shall be pronounced in the form of a corresponding limitation of the patent.

The limitation may be effected in the form of an amendment to the claims, the description or the drawings.

3. In the case specified in paragraph 1 (f), revocation shall be pronounced only in respect of the Contracting State in which the national patent application or national patent has been made public.

ذ- مقایسه تطبیقی

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 ضمانت 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 بسیار توسعه داده شده است به حدیکه حتی شامل حق ولی بر دختر باکره نیز شده است! در این خصوص مرحوم شیخ انصاری مینویسد: "و کیف کان، فی شمل العقد الصادر من الباکره الر شیده بدون اذن الولی و من المالك اذا لم يملك التصرف لتعلق حق الغير بالمال، كما یومیء الیه استدلالهم لفساد الفضولی بما دل علی المنع من نکاح الباکره بغير اذن ولیها. و حینئذ، فی شمل بیع الراهن و السفیه و نحوهما و بیع البعد بدون اذن ال سید (مکا سب، انتشارات مجمع الفکر الا سلامی، جلد 3، ص 346. قریب همین عبارت و توضیح از مرحوم سید بحر العلوم نیز مشاهده میشود: بلغه الفقیه، انتشارات مکتبه الصادق، جلد 2، ص 202). علیرغم این توسعه در دامنه ادعاهای قابل حمایت از سوی ثالث، همانند کنوانسیون وین، هیچ تفکیکی بین این ادعاها نشده است. ظاهرا، در همه حال ثالث مدعی هر نوع حق و ادعا بر منتقل الیه قراردادی مقدم است!!

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.

پرسش: به نظر شما آیا در حقوق ایران بین انواع ادعاها فرقی وجود ندارد؟ آیا اساساً، سیاست اتخاذی فقیهان در دفاع حداکثری از ثالث مدعی و ارجاع منتقل الیه با حسن نیت به قاعده تسبیب و یا قاعده غرور قابل دفاع می باشد؟

Confer with the Assignment:

Noel Byrne relying on Law of Property (Miscellaneous Provisions) Act 1994 describes English Law as follows:

In the UK, assignments and other dispositions of IP are governed by the general law relating to personal property, in particular the Law of Property (Miscellaneous Provisions) Act 1994 which replaced Law of Property Act 1925, s. 76. If the proprietor of IP assigned the property for value 'as beneficial owner', arguably, s. 76 implied these covenants in the assignment:

- (v) The assignor has full power to assign,
- (vi) The assignee will have quite enjoyment of the property assigned (this is not implied by the 1994 Act),
- (vii) The assignment is made free from any encumbrances, and
- (viii) The assignor will do what is reasonably required at the assignee's cost to further assure (or perfect) the assignee's title to the property.

These implied covenants could be modified or excluded as appropriate. Under the 1994 Act, where there is a disposition of property either with full title guarantee or with limited title guarantee, covenants are implied that the person making the disposition has the right to dispose of the property and will do all he reasonably can to give the title he purports to give at his own cost. A full title guarantee also includes a further implied covenants that the property is being disposed of free from all

charges and encumbrances (whether monetary or not) and from all other rights exercisable by third parties (including those under any enactment), other than any charges, encumbrances and third-party rights which the person making the disposition does not and could not reasonably be expected to know about. Where a limited title guarantee is given, the person making the disposition impliedly covenants that he had not since the last disposition for value charged or encumbered the property or allowed the same to happen and that he is not aware that anyone else has done so since the last disposition for value. These implied covenants are annexed to the property disposed of and thus they may be enforced by every person in which the property vests from time to time in the future. They may be limited or extended by express agreement between the parties to a disposition. (*Noel Byrne, Licensing Technology, Jordans, Pub. Ltd., 3rd ed., 2005, p. 201.*)

Comparing both assignment and license to Sale of Goods contract:

In Sale of Goods Contract see:

1- **British SOGA 1979** which provides: 12. -(1) In a contract of sale, other than one to which subsection (3) below applies, there is an implied condition on the part of the seller that in the case of a sale he has a right to sell the goods, and in the case of an agreement to sell he will have such a right at the time when the property is to pass. (2) In a contract of sale, other than one to which subsection (3) below applies, there is also an implied warranty that- (a) the goods are free, and will remain free until the time when the property is to pass, from any charge or encumbrance not disclosed or known to the buyer before the contract is made, and (b) the buyer will enjoy quiet possession of the goods except PART II so far as it may be disturbed by the owner or other person entitled to the benefit of any charge or encumbrance so disclosed or known.

2- Vienna Convention on Contracts for Int. Sale of Goods (CISG) 1980, Article 41 & 42 which obliges the Seller to deliver the goods free from and third party's rights and claims.

4- Effects of Defective Title

ضمانات اجرای عدم رعایت قواعد مربوط به تضمین بلامنازع بودن حق مالکیت موضوع انتقال در دو رویکرد کامن لایی و فقهی بسیار متفاوت است. در نگاه حقوق کامن لا قرارداد مربوطه صحیح و نافذ و منتقل الیه حسب مورد یا حق فسخ و مطالبه خسارت دارد و یا تنها حق مطالبه خسارت. اما در نگاه فقیهان معامله صحیح و غیر نافذ و سرنوشت آن به دست ثالث مدعی حق عینی است: یعنی تنفیذ و یا ابطال تنها در اختیار ایشان بوده و منتقل الیه در رابطه با آن معامله اختیاری ندارد بلکه تنها بر مبنای قاعده غرور و یا قاعده تسبیب حق مطالبه خسارت غیر قراردادی از فروشنده و ناقل فضول دارد!