

3-3- تعهد به اعتبار و استمرار اعتبار مال فکری

یکی از مهمترین چالشهای در قراردادهای مالکیت فکری محور تعهد ناقل نسبت به اعتبار و استمرار اعتبار مال فکری موضوع قرارداد است. این چالش در چند فرض قابل توجه است:

نخست، اعتبار قانونی مال فکری به هنگام انعقاد قرارداد است. در این فرض ناقل تضمین میکند موضوع لیسانس یک اختراع یا اثر کپی رایتی معتبر بوده و تاکنون ابطال نشده است.

موضوع دوم استمرار اعتبار قانونی در طول مدت قرارداد است. در این فرض انتظار این است که ناقل تضمین دهد که موضوع لیسانس در طول مدت لیسانس معتبر باقی بماند. این بی اعتباری به چند سبب است. نخست حکم دادگاه بر بی اعتباری مال فکری موضوع لیسانس با اعتراض ثالث است. دوم بی اعتباری مال فکری ثبت محور به دلیل عدم تمدید در موعد مقرر است. سوم عدم به سبب اعراض یا مالک است.

به نظر میرسد انتساب یک تعهد ضمنی مبنی بر اعتبار مال فکری موضوع لیسانس به صادرکننده لیسانس قابل توجیه باشد. اما انتساب تعهد ضمنی مبنی بر استمرار اعتبار ولو در فرض اعتراض ثالث بسیار دور از ذهن بوده و انتساب چنین تعهد به صادر کننده لیسانس نه مقتضای قرارداد است و نه عرف و نه حکم قانونگذار! ضمناً، این پرسش در فرض بی اعتباری گواهی اختراع پیچیده تر میشود زیرا به موجب ماده 18 قانون ثبت اختراع و ... سال 86 این بی اعتباری گاهی در خصوص گواهینامه اختراع است و گاهی ناظر به برخی از ادعاها! ذیلاً این چالش در فروض مذکور به اختصار طرح میگردد.

3-3-1- Concept and Ground of Covenant to Being Valid

English Law

Noel Byrne reports English law as follows:

“A warranty as to title tries to ensure that the licensee is dealing with, and takes his license from, the right person. While a warranty as to the validity is concerned with the substance, rather than the shadow, of the property licensed. It is unusual for the licensor to warrant the validity of a patent, except perhaps where the claims have been validated by the courts. If the claims of a patent go beyond what can be encompassed legitimately, they can be invalidated. The licensor may be prepared to warrant the validity of a copyright or a trade mark registration, although not as a matter of course. Breach of warranty as to validity or scope may give the licensee, or in the case of a sale the purchaser, a right to repudiate the contract and sue the licensor, or the vendor, for damages. In *Nadel v Martin*, Nadel, the owner of certain patents, agreed to sell them for a price to be paid partly in cash and partly in shares of a company to be formed by the purchasers before the date fixed for completion. The vendor agreed to “guarantee” the validity of the patents. The purchasers gave certain promissory notes for the part of the purchase money payable in cash. The patents were found to be invalid by the purchasers. In an action by the vendor on the promissory notes, the purchasers *alleged that the guarantee of validity was in the nature of a condition the breach of which entitled them to repudiate the contract*. The trial judge, after construing the contract, decided that the guarantee was not a condition but a mere warranty (in the sense of minor term). The appeal court ruled otherwise, deciding that the validity of the patents was the basis on which the contract was entered into. Accordingly, the defendants were not bound to pay the sum of money that would have been due had the contract been carried out, *and they were entitled to recover from the plaintiff the sums they had paid already*. The plaintiff’s further appeal to the House of Lords was dismissed.

A different conclusion was reached in *Beecham v. Wren*, where the owner of a patent for automatic drain valves for use in steam engines agreed to sell it, as part of an agreement for the sale of a business. The vendor guaranteed the patent to be valid and in full force. The patent was found to be invalid. The court ruled that, although he could not set aside the contract, the defendant was entitled to damages for breach of the warranty as to validity. The contract could have given the purchaser an express right to set it aside for invalidity, but it did not. An obligation to pay royalties may be conditional, as in *Henderson v Shiels*, on the licensor securing for the licensee the monopoly granted by the contract. The plaintiff in the *Henderson* agreed to grant the defendant an exclusive license (although no formal license was ever granted) and the defendant undertook to pay monthly in advance royalties calculated on a certain guarantee minimum of machines. Further, he agreed to guarantee and uphold the validity of the patent and to protect the licensee from infringement. The defendant manufactured machines under the license and made three monthly payments of royalties, but discontinued payments on the ground that the patent was invalid. The plaintiff sued for the royalties. The question before the court was whether the admitted invalidity of the patent was, or was not, the whole basis of the agreement; whether its validity was a condition or a matter of mere warranty. The court decided that the validity of the patent was the basis of the agreement:

‘What the defendant is bargaining for is a sole license which will secure him a monopoly in the patented machines, and his chance of patent must largely depend on such monopoly. The plaintiff admits that no such monopoly can be secured to him, everybody being, because of the invalidity of the patent, entitled to manufacture and sell the machines ... I think, therefore, that, on the

principle of *Nadel v Martin* (23 RPC 41), the defendant can rely on the invalidity of the patent as a defense to the plaintiff's action for royalties, or, in other words, treat the contract as rescinded.'

Despite the presumed validity of IP obtained by registration, a licensor should not warrant in an absolute sense the validity of a patent offered for license. But a licensee could insist, quite properly, on certain undertakings touching on the question of validity, such as warranty that the licensor has done nothing, or that to the best of his knowledge the licensor knows of nothing, which would result in the property being invalidated (e.g. for want of novelty at the date of filing of the application on which the patent was granted). A warranty in that vein must not, however, be regarded as a substitute for careful enquiry by the licensee into the validity of the property to be licensed, whenever significant capital and other resources will need to be sunk in the license venture. In the case of trade secret, which is not property in a strict sense, the licensor could be required to warrant, inter alia, that disclosure to the licensee will not be in breach of a confidence owed to a third party, that so far as he knows the know-how is not in the public domain, and that the know-how has been found by the licensor to be advantageous in manufacturing the licensed product." *Noel Byrne, ibid., pp. 202-204*).

Note: It seems, however, that these cases (*Nadel v Martin* (1906) 23 RPC 41 (House of Lords) and *Beecham v Wren* (1904) 21 RPC 683 (High Court).) were concerned with express term to guarantee that the patent was valid but it was found that it was invalid. It seems no legal precedent exists in respect of implied condition. Therefore, as Noel Byrne suggests, no unconditional implied term could be inferred from a license and assignment contract.

Iranian Law

Under Iranian law, it seems difficult to say that, the licensor is, subject to his/her knowledge and experience, under an implied duty to guarantee that the subject licensed has legally obtained and during the process of obtaining patent, design or trade mark document no illegal conduct made or legal rules are violated.

3-2-2- Effects of non-validity

آثار بی اعتباری مورد معامله در حقوق قراردادهای کالا محور روشن است. با احراز بی اعتباری معامله باطل و فاسد و عوضین باید به مالکان اولیه مسترد گردد. اما وضعیت در قراردادهای مالکیت فکری محور روشن نیست و اعمال این قاعده بر این قراردادها پیامدهای ناعادلانه ای در پی خواهد داشت. ذیلا هر یک از این آثار به اختصار طرح میگردد.

3-2-2-1-Legal Position of the Contract

در خصوص وضعیت قرارداد های مبتنی بر مال فکری فی الواقع بی اعتبار قوانین مالکیت فکری برخی کشورها مداخله نموده است. ذیلا به موضع حقوقی برخی کشورها اشاره میشود.

Article 47 (6) of the UK Trade Mark Act 1994

Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions, past and closed.

Article 131 of the Turkish Patent Act

A (Court) Decision ruling that the patent is invalid, shall have retroactive effect. Thus, within the context of invalidation, the legal protection secured for an application for patent or for a patent under this present Decree-Law shall be deemed not to have been borne at all. The retroactive effects of invalidity.... shall not extend to/affect the following situations: ... b) Contracts concluded and executed prior to the decision of invalidity.

Articles 73 & 74 of the New Zealand Trade Mark:

73 Invalidity of registration of trade mark: (1) The Commissioner or the court may, on the application of an aggrieved person (which includes a person who is culturally aggrieved), declare that the registration of a trade mark is invalid to the extent that the trade mark was not registerable under Part 2 at the deemed date of its registration.

74 Effect of declaration of invalidity

- (1) If the registration of a trade mark is declared invalid to any extent,
 - (a) the trade mark is, to that extent, to be treated as if it had not been registered; and
 - (b) the Commissioner may alter the register accordingly.
- (2) The validity of any transaction that occurred in respect of a registered trade mark before the registration of the trade mark was declared invalid is not affected.

3-2-2-2 Duty to Pay Royalty Payment

In US law the rule accepted in *Brulotte v Thys Co.* is applied when the legal protection is invalidated. See Melvin Jager, *ibid.*, p 227 which states: “A similar rule exists for patent licenses in which the underlying patent is later declared invalidated. This doctrine was created in *Lear v Adkins*, where the old rule that a licensee was stopped from challenging the validity of licensed patents was overruled. The Supreme Court found that there was a strong federal interest in allowing licensees to challenge validity, since they are often the only parties with a sufficient financial interest to do so. This result promotes the strong federal policy that only truly qualified inventions receive and retain patent protection.”

3-2-2-3 Can the Licensee return back the license fees paid when the Patent is invalidated?

فوقا به اجمال نشان داده شده که با اعلام بی اعتباری مال فکری موضوع لیسانس دستکم قرارداد لیسانس از بی اعتباری مصون و به حیات حقوقی خود ادامه خواهد داد. حال پرسش این است که آیا در این فرض بهره بردار مستحق استرداد وجوه پرداختی به صادرکننده لیسانس می باشد.

حق استرداد از سوی بهره بردار ممکن است ممکن است در فرض اعلام بی اعتباری یا کشف بی اعتباری از ابتدای تولید اثر باشد یا بدلیل انقضای اعتبار قانونی. انقضای اعتبار نیز ممکن است بدلیل اتمام مدت اعتبار باشد یا عدم حفظ شروط اعتبار مثل زوال شرط تمایز بخشی در علامت، یا شرط محرمانگی در اسرار تجاری و یا تمدید مدت اعتبار در علایم و طرحها و اختراعات و ارقام گیاهی. مهمترین پرسش در این خصوص آن است آیا در همه فروض به صرف وجود توافق فیما بین صاحب دارایی فکری و بهره بردار تعهد به پرداخت معتبر بوده و بهره بردار متعهد به ادامه پرداخت می باشد یا خیر؟ همه صور فوق در فرض لیسانس ساده و مرکب قابل بحث می باشد. ذیلا این پرسش در حقوق خارجی توصیف و سپس موضوع حقوق ایران طرح و مقایسه و ارزیابی میشود.

الف - حقوق خارجی

حقوق آمریکا

The general rules in pure patent licensing are well established. While the patent is in force, the licensor has great latitude (آزادی عمل و اختیار داشتن) to exact royalties or other forms of payments for the inventions. (به زور مطالبه کردن)

However, all royalty obligations become potentially unenforceable when the underlying patent expires or when the patent is declared invalid. (Melvin Jager, *ibid.*, p 228.)

See also 22 - [Jorge L. Contreras](#), Estoppel and No-Challenge Clauses, **from Part IV - Advanced Licensing Topics**, Published online by Cambridge University Press, **21 June 2022**:

“What happens when an intellectual property (IP) license is granted, but the underlying IP is later found to be invalid? Is the license still in effect? More importantly, is the licensee still required to pay for it? The answer to these questions is generally “no.” Invalid IP is a legal nullity that cannot be licensed. Moreover, as we will see in Section 24.3, an IP holder commits misuse if it tries to charge royalties after a patent or copyright expires.”

حقوق چین

ماده 47 قانون اختراعات این کشور در این خصوص چنین مقرر میدارد:

“Any patent right that has been declared invalid shall be deemed to be non-existent from the beginning. The decision on declaring a patent right invalid shall have no retroactive effect on any written judgment or written mediation on patent infringement that has been made and enforced by the people's court, or on any decision concerning the handling of a dispute over the patent infringement that has been performed or compulsively executed, or on any contract for permitted exploitation of the patent or for transfer of patent rights that has been performed--prior to the invalidation declaration of the patent right. However, compensation shall be made for the losses caused to another person mala fides by the patentee. Where the patent infringement compensation, royalties, and patent right transfer fees are not refunded pursuant to the provisions of the preceding paragraph, which constitutes a blatant violation of the principle of fairness, refund shall be made fully or partly.

حقوق فرانسه: اگر چه در حقوق فرانسه بطلان یا فسخ قرارداد، اثر قهقرایی دارد، و علی الاصول لیسانس گیرنده می تواند حق امتیازهای پرداخت شده را مطالبه نماید، اما در آرای دادگاه ها در پاره ایی از موارد، انحصار واقعی به عنوان جهتی برای پرداخت حق امتیاز ذکر شده است که بر مبنای آن امکان مطالبه حق امتیاز های پرداختی را به لیسانس گیرنده نمی دهد. هر چند که رویکرد کلی حقوق فرانسه، این گونه است که با ابطال گواهی اختراع حق بهره برداری گویی از ابتدا موجود نبوده است.¹

حقوق ایران

با عنایت به ماده 18 در قانون ثبت اختراعات، طرح های صنعتی و علائم تجاری 1386 ابطال گواهی اختراع اثر قهقرایی دارد و گواهی را از زمان ثبت اختراع باطل می کند. در این ماده اشاره ایی به حکم معاملات صورت گرفته بر روی گواهی اختراع ننموده است. و هم چنین ذیل ماده 50 قانون مورد اشاره هم که پیرامون اجازه بهره برداری است تکلیفی بر عهده لیسانس گیرنده در باب اطمینان از صحت گواهی اختراع نگذاشته است. از سوی دیگر از نقش دولت و مأمورین اداره ثبت اختراعات نباید غافل شد چرا که، ایشان با داوری نهایی راجع به دانش فنی ادعایی تصمیم به صدور گواهی اختراع می نمایند و غیر از موارد تقلب در تنظیم در خواست ثبت گواهی اختراع، علی الاصول ایشان مسوول ایراد به وجود آمده هستند. این امر در حالی اتفاق می افتد که تحمل خسارت با مخترع است.

در هنگام تحلیل اثر ابطال بر وضعیت قرارداد لیسانس باید توجه داشت که اگر قرارداد باطل دانسته شود بر اساس ماده 365 ق.م اثری در تملک ندارد. و بر مبنای ضمان مقبوض به عقد فاسد باید آن را به صاحبش رد نماید. اگر قائل به فسخ قرارداد باشیم به دلیل این که لیسانس یک قرارداد مستمر است با توجه به منشا ایجاد حق فسخ وضعیت قرارداد متفاوت خواهد بود.

¹ . اثر ابطال گواهی اختراع بر قرارداد های انتقال فناوری . عباس تبار فیروز بخت ، مجید . ص. 47

در ماده 361 ق.م بیان شده است (اگر در بیع عین معین معلوم شود که مبیع وجود نداشته است بیع باطل است.) تشخیص غرری نبودن معامله با عرف است و در عمل ممکن است، عرف جاری در این زمینه با دید تسامح نگاه کند.² حتی بیم تلف در آینده نیز از نظرگاه عرف نمی تواند خللی در این موضوع ایجاد کند.³ موجود نبودن معامله عین معین رادر دو وضعیت می توان تصور کرد اول این که پیش از عقد، موجود باشد و در زمان عقد از بین رفته باشد. دیگر این که در زمان عقد هنوز به وجود نیامده باشد.⁴ ابطال گواهی اختراع با توجه به اثر قهقهه‌رایی آن موجب شده است که این تلقی پدید آید که اختراع از هنگام ثبت موجود نبوده است. این موضوع همانند صورت دوم مفروض در موجود نبودن مورد معامله است که در مورد عین معین به کار می رود یعنی این که در زمان عقد هنوز به وجود نیامده باشد. در این جا نیز مورد معامله با توجه به شرایط قانونی، هنوز به وجود نیامده است.

به نظر می رسد که در مورد قراردادهای لیسانس بنا بر نظر قانونگذار ایران که در مواد 50 و 60 نیز تجلی یافته است. مراد قانونگذار از لیسانس، در عمل همان اباحه تصرف است. پرواضح است که تا پیش از اخذ مجوز بهره برداری از اختراع، لیسانس گیرنده نمی توانست وارد بازار انحصاری شود، که مخترع با توجه به اخذ گواهی اختراع برای خود به وجود آورده بود. با انعقاد لیسانس، بهره بردار اجازه ورود به این بازار انحصاری را پیدا می کند، و می تواند با خاطری آسوده، به دور از دسترس رقبیان به تولید محصول و فروش آن در بازار بپردازد.

از منظر تحلیل اقتصادی، در بازار اقتصاد سرمایه داری، رقابت واقعی میان بنگاه های کوچکی که تولید کننده کالاهای یکسانی هستند در نمی گیرد، بلکه میان بنگاه های نوآور و مبدع و سایر بنگاه ها در می گیرد. بنگاه نوآور بنگاهی است که در آن مدیر، بنگاه را درگیر فعالیت های کارآفرینانه و پیش کسوتانه می کند. بنابراین رقابت بین محصولات جدید و محصولات قدیمی ویا روش های تولید جدید و قدیم رخ

² . حقوق مدنی . اعمال حقوقی . قرارداد ایقاع . کاتوزیان ، دکتر ناصر . صفحه 130

³ . همان . صفحه 131

⁴ . تشکیل قراردادها و تعهدات . شهیدی ، دکتر مهدی . انتشارات مجد . چاپ هفتم 1388 . صفحه 309

می دهد. این برداشت از رقابت، موجب دگرگونی مفهوم انحصار می شود. زمانی که ابداع و نوآوری به میان می آید، به همراه خود، نوعی مزیت می آورد. ابداع پیش از آن که پخش شود سودی به همراه می آورد که پاداش خدمات کارفرمایانه مدیر است این سود به واسطه استفاده انحصاری بنگاه ابداع گر از کالا یا روش تولید جدید است. این انحصار یک انحصار موقت و گذراست.⁵ بنابراین، کسب گواهی اختراع برای مخترع عملاً متضمن سود است که انحصار این سود نهفته در آن را از قوه به فعل تبدیل می کند، بنابراین لیسانس گیرنده با انعقاد قرارداد لیسانس در حقیقت اجازه استفاده از ابزار تحقق سود را پیدا می کند. موقعیتی که سایر رقبا از آن بی بهره اند. از همین جا می توان دریافت که پرداخت های صورت گرفته توسط لیسانس گیرنده بیهوده نبوده است و در برابر آن چیزی دریافت شده است و آن انحصار است.

در مقابل گفته شده است که با امکان به چالش کشیدن اعتبار گواهی اختراع پیش از انعقاد قرارداد لیسانس، توسط لیسانس گیرنده او این امکان را داشته است که از مزایای دانش فنی موضوع گواهی اختراع بدون هزینه بهره مند گردد. اما با دریافت لیسانس و پرداخت حق امتیاز به لیسانس دهنده عملاً سود نهایی او کاهش یافته است. در پاسخ به این سوال باید گفت در منطق بازار رفتار بنگاه ها بر مبنای کسب سود حد اکثری است، و زمانی که بنگاهی اقدام به دریافت لیسانس می کند، به طور قطع سود خود را در این وضعیت بیشتر دیده است. احتمال دارد لیسانس گیرنده، شانس زیادی برای ابطال گواهی اختراع نداشته، و یا صرف هزینه و وقت زیاد بابت دادرسی ناظر به بطلان گواهی اختراع او را از اهداف اقتصادی خود دور می کرده است.⁶ بنابراین با این استدلال، ادعای بدون عوض بودن لیسانس صحیح نیست. در مقابل گفته شده است که سود و بهره مکتسبه ناچیز و غیر مرتبط است. در پاسخ باید گفت، همان طور که ذکر شد اساس بازار بر کسب سود حد اکثری است و با توجه به گزینه هایی که وجود دارد

⁵ . بازار یا نابازار، بررسی موانع نهادی کارایی نظام اقتصادی بازار در اقتصاد ایران . رنایی، دکتر محسن . انتشارات سازمان برنامه و بودجه . چاپ اول 1376 . صفحه 376

⁶ . تاثیر ابطال گواهی اختراع بر قراردادهای انتقال فناوری . عباس تبار فیروز جاه مجید . صفحه 72

نظیر اقامه دعوی بی اعتباری گواهی اختراع، لیسانس گیرنده حتما در برآورد خود امکان تحصیل سودی، فراتر از وضعیت عدم اخذ لیسانس را سنجیده است و سپس اقدام به انعقاد قرارداد کرده است. از طرف دیگر اگرچه می توان پذیرفت، که در نبود لیسانس هزینه های سرمایه گذاری پایین می آمد، و لیسانس گیرنده آن چه را، تحت عنوان حق امتیاز پرداخت می کرده را، در اندوخته خود نگه می داشت. اما در عین حال مزایای استفاده از بازار انحصاری را نیز از دست می داد. در وضعیت انحصار با بالا رفتن قیمت کالا هزینه های لیسانس توسط لیسانس گیرنده مستهلک می شود.⁷ این وضعیت تنها اختصاص به لیسانس انحصاری ندارد و در نوع غیر انحصاری آن هم وضعیت به همین شکل است. چرا که رقابت در بازاری که پنج تولید کننده دارد متضمن سود بیشتری است، تا بازاری که هرکس بدون نیاز به لیسانس در آن بتواند اقدام به تولید کند.

بازپس گیری حق امتیاز های مخترع با استدلال موجود نبودن مورد معامله در دراز مدت همان گونه که ذکر شد خطر ثبت دانش فنی را افزایش می دهد و موجب می شود، تا مخترعین به سمت استفاده از نظام اسرار تجاری سوق داده شوند.

در نتیجه و بر مبنای آن چه که ذکر شد، نمی توان گفت که پرداخت حق امتیاز بی عوض بوده است، چرا که ابطال گواهی اختراع زیانی به لیسانس گیرندگان نمی رساند و آنان با دستیابی به یک فرصت تجاری سود کلانی را به دست آورده اند و دستیابی به این سود کلان در نتیجه تلاش مخترع به دست آمده است، و با بازگرداندن پرداخت های انجام شده به لیسانس گیرنده گونه ایی از دارا شدن ناروا رخ می دهد که بی عوض خواهد ماند.⁸

مباح بودن بهره برداری از اختراع ریشه در این موضوع دارد که آیا انحصار پدید آمده ناشی از گواهی اختراعی که ابطال شده است مشروع است یا خیر؟ چرا که اثر قهقراپی بطلان بر اساس ماده 18 قانون

⁷ . همان . صفحه 73

⁸ . اثر ابطال گواهی اختراع بر قرارداد های انتقال فناوری . عباس تبار فیروز جاہ . صفحه 74

ثبت اختراعات طرح های صنعتی و علائم تجاری موجب می گردد که دانش فنی موضوع گواهی اختراع در زمره مباحات قرار گیرد. مباحات بنا بر تعریف ماده 27 ق.م (اموالی هستند که ملک اشخاص نمی باشند و افراد می توانند آن ها را مطابق مقررات مندرجه در قانون مدنی و قوانین مخصوصه مربوط به هریک از اقسام مختلف آن ها را تملک کرده و یا از آن ها استفاده نمایند مثل زمین های موات یعنی زمین هایی که معطل افتاده و آبادی و کشت و زرع در آن ها نباشد.) حکم مباحات شامل اموالی که قبلاً مالک داشته ولی مالک از آن ها اعراض نموده است می شود.⁹ شهید ثانی، معامله مباحات را، با توجه به این که با حیازت تملک می شوند و پیش از حیازت وضعیت خریدار و فروشنده مال مباح یکسان است را باطل می داند.¹⁰ در تعریف حیازت ماده 146 ق.م بیان می کند: (مقصود از حیازت تصرف و وضع ید است، یا مهیا کردن وسایل تصرف و استیلاء) حیازت مباحات به تناسب انواع آن متفاوت است. همانند حیازت زمین موات با درختکاری، ایجاد بنا و یا زراعت. حیازت آب رودخانه ها و ماهی ها به تصرف مادی این اشیا است و یا حیوانات وحشی، با شکار کردن موجب تحقق معنای حیازت می شوند. ملاک حیازت تشخیص عرف است و باید ملازم با اقداماتی باشد که عرف آن ها را تصرف و یا مهیا کردن وسایل تصرف بداند.¹¹ در مورد دانش فنی موضوع گواهی اختراع که با ابطال گواهی وارد قلمرو عام شده است، نمی توان به راحتی مفهوم مباحات را بر آن منطبق ساخت. با دقت در مفهوم مباحات در می یابیم، ویژگی غالب آن ها، این است که اموالی بوده اند بدون مالک، و بر اثر کار و تلاش اشخاص حیازت پیدا می کنند و به تملک اشخاص در می آیند. در دانش فنی نیز مخترع با کار و تلاش بر روی علوم موجود موفق می شود، دانش نوینی را تولید کند. این امر در زمانی که مخترع موفق به کسب گواهی اختراع می شود، و بعد از چند سال گواهی صادر شده باطل می شود اهمیت بیشتری می یابد. در بسیاری از مواقع دانش

⁹ . حقوق مدنی . جلد اول . امامی ، دکتر میر سید حسن . انتشارات اسلامیة . چاپ 25 . 1384 صفحه 44
¹⁰ . الروضة البهیه فی شرح اللعہ الدمشقیة . شهید ثانی . ترجمه مباحث حقوقی شرح لمعه . لطفی ، دکتر اسدالله . انتشارات مجد . چاپ 5 . 1387 . صفحه 77 .

¹¹ . حقوق مدنی اموال و مالکیت . کاتوزیان دکتر ناصر . صفحه 71

فنی گواهی باطل شده به لیسانس گیرندگان قدرت اقتصادی اعطا نموده است، و موجب گردیده، تا آن ها از رقبای خود پیشی گیرند. حال اگر بعد از ابطال گواهی اختراع؛ باید دانش فنی موضوع آن را به مثابه مباحات در نظر گرفت، به نظر می رسد، با واقعیت بازار منطبق نباشد و لیسانس گیرنده به دلیل سابقه استفاده انحصاری از آن، هم چنان دست بالاتر را در بازار دارد. از سوی دیگر در هنگام معامله بر روی گواهی اختراعی که در آینده باطل می شود، دو طرف قرارداد در موقعیت یکسانی قرار ندارند و مخترع به لحاظ ارزش کار و زحمتی که بر روی دانش موجود انجام داده، مالی را تولید کرده، که بالقوه منشاء قدرت در بازار است. به نظر می رسد آن چه که شهید ثانی در مورد یکسان بودن موقعیت طرفین در معامله مال مباح بیان کرده است ناظر به یکسانی توانایی آن ها در تصرف مال است و این همانندی در زمانی که یکی از ایشان با کار خویش زمینه تصرف را فراهم نموده، موضوعیت ندارد. اما اگر مخترع را مالک اختراع و انحصار پدید آمده را مبنای قرارداد در نظر نگیریم، این برداشت با ماده 18 همراه تر است اما به نظر می رسد که با قاعده (لاضرر) و (لا تاكلوا اموالکم بالباطل) تعارض داشته باشد.^{۱۲} با توجه به نظر شیخ انصاری می توان گفت که تفسیر ماده 18 به بطلان قرارداد موجب حکمی ضرری می شود، و مخترعی را که دانش فنی تولیدی خود را ثبت و افشا نموده است مکلف می نماید که حق امتیاز های گرفته شده را عودت دهد. باید توجه داشت که، مخترع می توانست همین دانش را در قالب اسرار تجاری حفظ نماید و باید توجه داشت که با توجه به وابستگی دانش تولیدی در کشور به اختراعات پیشین این امر چه ضرری را می تواند بر مصالح کشور وارد نماید. حتب بنا به تفسیر مرحوم فاضل تونی در باب قاعده لاضرر به این اعتبار که ضرر جبران شده به طور کلی ضرر به شمار نمی آید.^{۱۳} با توجه به این نظر ضرر مخترع از بابت افشای اختراع در قالب نظام ثبت اختراعات و چشم پوشی از منافع اقتصادی استفاده از نظام اسرار تجاری، با بطلان گواهی اختراع جبران نشده باقی می ماند و مخترع مکلف به بازپرداخت حق امتیازهای دریافتی

¹² . اثر ابطال گواهی اختراع بر قراردادهای انتقال فناوری . عباس تبار فیروز جاه مجید . صفحه 77

¹³ . همان . صفحه 71

می شود. لیسانس گیرنده علی الاصول از این وضعیت متضرر نمی شود چرا که الزامی به رد سود دریافتی از بابت قرارداد، ندارد. علی الخصوص که متقاضی بطلان گواهی اختراع خود او باشد. بنابر تفسیر امام خمینی در خصوص قاعده لاضرر که یک حکم اصولی و حاکم بر همه احکام یا حتی یک حکم فرعی و در عرض احکام دیگر نمی باشد، بلکه یک حکم سلطانی و حکومتی می بوده که فقط در مقام حکومت، و در صورت تراحم بین حقوق قابل اجراست.^{۱۴} دست قاضی برای تشخیص ضرر در مورد ماده 18 باز بوده تا با توجه به ضرر مخترع و جامعه از بابت عودت حق امتیازهای دریافتی، حکم به عدم بازپس گیری سود دریافتی دهد.

ممکن است گفته شود که ماده 18 در بطن خود یک مقصود دارد و آن جلوگیری از ضرر جامعه می باشد اما باید توجه کرد که این امر صحیح نیست. چرا که هرگاه دو ضرر بر یک نفر عارض شود، ضرر کم را پیشواز می روند.^{۱۵} در موضوع ماده 18 نیز باید گفت که چنان چه قرارداد را بدون عوض تصور کرده یا طرح انحصار برآمده از گواهی اختراع را مشروع ندانیم و در نتیجه قایل به بازپرداخت حق امتیازهای دریافتی توسط مخترع باشیم عملاً با بالا بردن خطر ثبت اختراع ضرر هنگفتی را به جامعه، تحمیل نموده ایم. در حالی پذیرش دیدگاه مقابل و عدم رد حق امتیازهای دریافتی به مراتب ضرر کمتری را به جامعه به مثابه یک فرد، وارد می کند.

a- The Right to Stop Royalty Payments When the Legal Protection Expires

Whether a contract clause may permit a patent, design, trade mark, trade secret owner to continuously collect royalty payments from a licensee after the expiration of its patent, design, trade mark or trades secrete rights is a highly controversial issue in practice. Some believe that because patent rights, e.g., are a kind of monopoly granted by the government, it shall not be extended

¹⁴ . همان . صفحه 76

¹⁵ . قواعد فقه . محمدی ، ابوالحسن . انتشارات میزان . چاپ 12 . پاییز 1390 . صفحه 162

after expiration; otherwise, it shall be regarded as patent misuse and/or unfair competition as the case may be. Nonetheless, others believe that this kind of clause is actually beneficial to a licensee because the licensee is allowed to make royalty payments throughout the whole patent term and even after expiration, which is helpful in terms of innovation. The issue will be discussed under civil law jurisdictions, common law jurisdictions and Iranian law.

- Civil Law Jurisdictions

The question whether the licensee is obliged to continue license fee payments is examined in *Genentech, Inc. v Hoechst GmbH / SanofiAventis GmbH*, Case C-567/14 (Opinion of Advocate General Wathelet: 17 March 2016), and the Court of Appeal of Paris has even found that it is compatible with Art.101 TFEU.

1. The Facts

1.1 The Patent License

In 1992 a predecessor of Hoechst/Sanofi-Aventis granted a worldwide non-exclusive license under German law to Genentech for the use of a human cytomegalovirus (HCMV) enhancer. The technology was the subject of two U.S. patents and one European Patent. A running royalty was payable by Genentech on sales of finished product using the patent. The EP was revoked by the EPO in 1999.

1.2 The Dispute

Genentech failed to pay any running royalty provided for in the License and, when Hoechst/Sanofi-Aventis queried this, gave notice to terminate the License. Hoechst/Sanofi-Aventis asserted that Genentech used the enhancer in the synthesis of recombinant proteins in order to manufacture the

monoclonal antibody sold as RITUXAN in the US and as MabThera in the EU. In October 2008, just before the License terminated, Hoechst/Sanofi brought an arbitration for payment of the royalties and also sued for infringement of the two U.S. patents in the District Court for the Eastern District of Texas. Genentech sued for revocation of the two patents in the District Court for the Northern District of California. The two US actions were consolidated and tried before the court in California. In 2011 the court upheld validity of the patents but found them not infringed. Validity was upheld by the CAFC in 2012.

1.3 The Arbitration and Award

The Arbitration also proceeded and in the Third Partial Award the Sole Arbitrator held that, originally, Genentech had wanted to use the enhancer without being regarded as an infringer, hence the License. It followed, according to the arbitrator, that “the commercial purpose” of the License was to avoid litigation relating to the validity of the EP and the two U.S. Patents during the life of the License. The Arbitrator held that the existence of the patents was a relevant consideration in order to establish “a commercial purpose” for entering into the License Agreement. Genentech wanted, the Arbitrator said, freedom from suit under the patents. Consequently, the Arbitrator held that, notwithstanding the subsequent revocation of the EP and the finding of non-infringement of the two U.S. patents, any payments made under the Agreement (i.e. the one off front end payment made for the License and the fixed annual research fee) could not be reclaimed by Genentech. Furthermore, the running royalty payments due under the Agreement remained due even though the patents were revoked or not infringed. Subsequently the Arbitrator gave a final Award for damages of Euros 108

million plus simple interest representing unpaid royalties over the period of the License Agreement, namely from December 1998 when the U.S. patents issued to October 2008 when the License Agreement was terminated. He rejected Genentech's arguments that this breach European anti-trust rules.

1.4 Genentech's anti-trust case to set aside/annul the Arbitral Award

Genentech challenged the Third Partial Award and the Final Award before the Paris Cour d'Appel. In relation to the Third Partial Award, the court referred to the CJEU a question whether, by holding that during the period of the License Agreement Genentech was obligated to pay royalties even though revocation of the EP had retroactive effect, such an Agreement contravened the provisions of Art.101 TFEU. Genentech contended that such an obligation placed it at a "competitive disadvantage" as against third parties who could use the technology without payment. The question was: "Must the provision of Art.101 TFEU be interpreted as precluding effect being given, where patents are revoked, to a license agreement which requires the licensee to pay royalties for the sole use of the rights attached to the licensed patent?" Hoechst/Sanofi-Aventis-Aventis' case was that the question of the possible incompatibility of the License Agreement with Art.101 TFEU had been raised and debated before the Arbitrator, and was rejected by him.

2. The AG's Opinion

2.1 Review of arbitral awards to ensure compatibility with Arts. 101 and 102 TFEU

First, it is open to the Court to review the compatibility of international arbitral awards with EU law to ensure that they do not infringe public policy. Arbitral awards, whether international or domestic, must be compatible with EU law.

The task of arbitrators in international commercial arbitration is to interpret and apply the contract binding the parties correctly. In performance of that task, arbitrators may find it necessary to apply EU law, if it forms part of the law applicable to the contract (*lex contractus*) or the law applicable to the arbitration (*lex arbitri*). Second, if there is an infringement of public policy, it makes no difference whether the infringement was flagrant, or not. Third, although – as contended for by Hoechst/Sanofi-Aventis – compatibility of the License with EU law had been raised and considered by the arbitrator, the Courts of EU Member States are not bound to comply with the findings of EU law made by the arbitrator. Consequently, parties cannot put agreements beyond the reach of review under Arts.101 and 102 TFEU by resorting to arbitration.

2.2 Analysis of the Award

First, the Arbitrator held that Genentech's liability to pay running royalties under the License Agreement was not dependent on the licensed technology being or remaining patented. It is not for the Court to review that finding made by the Arbitrator applying German law, the governing law of the License Agreement.

Second, the AG did not accept Genentech's contention that the Arbitrator's Award would place it at a competitive disadvantage, since it would be required to pay royalties whereas a competitor could take advantage of the technology freely and without charge. The AG cited the judgement in Ottung (Case 320/87, EU:C:2989:295) for the proposition that the obligation to pay a royalty may be unconnected with a patent. Here, the "commercial purpose" of the License

Agreement was to enable Genentech to use for the duration of that Agreement the enhancer without risk of patent litigation.

The AG distinguished over the judgment in *Windsurfing International v Commission* (193/83, EU:C:1986:75) on the basis that in that case the Agreement provided that the licensee had obligations which had no connection with the subject matter of the Agreement. Such was not, however, the case in the license to Genentech.

Third, the Block Exemption on the application of Art.101(3) TFEU to certain categories of technology transfer agreements (Regulation (E) No.240/96) was not applicable in this case. In any event, the Court did not have sufficient information to undertake the analysis required under that Regulation.

2.3 The AG's Conclusion

“Art.101 TFEU does not require, in the event of revocation or non-infringement of patents protecting a technology, the annulment of an international arbitration award giving effect to a license agreement which obliges the licensee to pay royalties for the sole use of the rights attached to the licensed patents where the commercial purpose of the agreement is to enable the licensee to use the technology at issue while averting patent litigation, provided that the licensee is able to terminate the license agreement by giving reasonable notice, is able to challenge the validity or infringement of the patents, and retains his freedom of action after such termination.”

2.4 Discussion

The AG's Opinion is persuasive but non-binding, and the Court's judgment can be expected later this year. For the AG, the issue turned on the terms of

the License Agreement between Hoechst/Sanofi-Aventis and Genentech, and there was nothing in

that Agreement which gave rise to infringement of Art.101 TFEU. Nevertheless, if the Opinion is followed by the Court, it is clear that – as a matter of general effect – there is power for a National Court of an EU Member State dealing with a request to set aside or refuse enforcement of an arbitral award to examine whether the Agreement and the effect of the arbitral award infringe Arts.101 and/or 102 TFEU and are, consequently, contrary to public policy.

As discussed above, the Court of Justice of the European Union confirmed that its function is not to review findings of an Arbitrator or his interpretation of a Patent License Agreement: *Genentech, Inc. v Hoechst GmbH/ Sanofi Aventis GmbH*, Case C-567/14 (Judgment of the Court: 7 July,2016).

1. The Facts

The terms of the 1992 Patent License to Genentech for use of a human cytomegalovirus (HCMV) enhancer, the dispute, the Arbitrator's Award and Genentech's anti-trust case to set aside/annul the Award are summarised in the post discussing the Opinion of Advocate General Wathelet. The HCMV enhancer facilitates the DNA sequence necessary to produce a biological medicinal product containing the active ingredient rituximab. That product, which is used to treat non-Hodgkin lymphoma (NHL) and chronic lymphocytic leukaemia (CLL), is sold in the European Union under the trade name, MabThera.

In its judgment of 7 July 2016, the Court has followed the AG's Opinion in all respects.

2. The Question for determination.

Does Art.101(1) TFEU preclude the imposition on the licensee of an obligation to pay a royalty for the use of patented technology for the entire period during which the license agreement was in effect, notwithstanding the revocation or non-infringement of the licensed patents?

3. The function of the Court is not to review the Arbitrator's interpretation of the License Agreement and his findings.

The Arbitrator found that under German law, the governing law of the Agreement, the licensee (Genentech) was required to continue to pay the running royalty notwithstanding the revocation or non-infringement of the licensed patents. Agreeing with the Advocate General, the Court confirmed that its function was not to review that finding. The Court was restricted to ruling on whether such finding infringed Art.101(1) TFEU.

4. The reasoning of the Court.

The Court applied its judgment of May 1989 in Ottung (320/87,EU:C:1989:195), which had been cited and relied on by AG Wathelet. That case involved an exclusive patent license agreement where under the obligation to continue paying royalties after expiry of the licensed patent was held not to infringe Art.85(1) of the Treaty. The justification for the decision in Ottung was that the agreement in that case reflected a “commercial assessment of the value to be attributed to the possibilities of exploitation granted by the license agreement.” The agreement also, crucially, contained a provision that the licensee was free to terminate the contract on notice.

The Court summarized the ratio in Ottung as follows. The royalty is the price to be paid for commercial exploitation of the licensed technology with the guarantee that the licensor will not exercise its industrial property rights. As long as the license agreement at issue is still valid and can be terminated by the licensee, the royalty payment is due even if the industrial property rights derived from the patents which are granted exclusively cannot be used against the licensee due to the fact that the period of their validity has expired.

5. The Judgment of the Court.

The Court then held that the reasoning in Ottung applied a fortiori to the facts of the HMCV License. “42. The fact that the courts of the State issuing the patents at issue....have held, following termination of the license agreement, that Genentech’s use of the licensed technology did not infringe the rights derived from those patents has, according to the information provided by the referring court on the German law applicable to that agreement, no effect on the enforceability of the royalty for the period prior to that termination. As a result, since Genentech was free to terminate the agreement at any time, the obligation to pay the royalty during the period when that agreement was in effect, during which the rights derived from the licensed patents which had been granted were in force, does not constitute a restriction of competition within the meaning of Art.101(1) TFEU.”

6. Comment.

For arbitral tribunals, the position remains that international arbitral awards must be compatible with EU law and, consequently, it may be necessary to apply EU law when interpreting and applying the contract in issue.

On the facts of the Genentech case, Art.101(1) TFEU does not preclude imposing on a licensee an obligation to continue paying royalties for the use of patented technology for the entire period in which the agreement is in effect, notwithstanding the revocation or non-infringement of a licensed patent. As noted, this is subject to the proviso that the licensee is freely able to terminate the agreement by giving reasonable notice.

For patent lawyers, the case provides guidance in two respects. First, that Ottung remains good law and that, consequently, to ensure enforceability of royalty obligations post termination or revocation of the licensed patents, the Patent License must entitle the licensee to terminate it on reasonable notice. Second, that – at least under German law – when interpreting patent license agreements, one must avoid a literal interpretation which is contrary to the “commercial objectives” of the parties. Under English law, interpretation of contracts is governed by the House of Lords (now, Supreme Court) judgments in the West Bromwich Building Society and Chartbrook cases, respectively (1998 1 WLR 896) and (2009 UKHL 38). The above EU cases and case comments are available in Internet.

- Common Law Jurisdictions:

US Law

In US law, it seems necessary to distinguish pure license from hybrid license in one hand, and patent license and trade secret license on the other hand.

Pure Patent License

Regarding such debate in patent license, the Supreme Court of the United States adopts the view of the former (as described in the preliminary remarks), strongly opposing the collection of royalties after a patent's expiration.

Recently in Kimble v. Marvel, the Supreme Court reviewed this issue all over again. The Supreme Court reasoned that, although its former judgment might have certain flaws, there are no special justifiable reasons to correct such former judgment, and according to the doctrine of stare decisis, a court must abide by its former judgment in order to maintain the reliability of judicial decisions. The Supreme Court leaves such issues to the hand of Congress, waiting for future amendments to the law. Hence, this issue has not yet been settled and needs further clarification by the judicial and legislative branches of the United States. The author believes that such clauses might be simultaneously good and bad for innovation and economic efficiency depending upon the circumstances and, therefore, the correct approach is to examine such clauses based on the “rule of reason” principle. The author offers suggestions regarding this issue after comparing different views and approaches adopted by the relevant authorities of the United States and Taiwan. (*Wei-Lin Wang, A Study on the Legality of Royalty Collection Clauses after Expiration of Patent Rights, 15 J. MARSHALL REV. INTELL. PROP. L. 2015 (2016).*)

Pure Trade Secret License

It is universally accepted rule, followed virtually since the first US trade secret case, that a contract controlling the use and disclosure of a trade secret is not an illegal restraint of trade per se under either the common law or the federal antitrust laws. Unless a pure trade secret license violates the antitrust laws for reasons other than its control over the use and disclosure of trade secrets, the interpretation of the license is governed by state law.

In Us law, trade secret licenses can be drafted and have been interpreted by the courts, to govern the conduct of the parties well beyond the life of any

licensed trade secret. The general principle followed in these decisions is that state contract law allows great latitude to the contracting parties, as long as federal policies such as the patent or antitrust laws or established state public policies are not violated. The famous case in this respect is Warner-Lambert v John Reynolds decided in 1959. ... (Jager, *ibid.*, pp 213-220.)

Pure Patent License

In US law there is substantial body of jurisprudence discussing the unique nature of patent license. ...

The US patent holder has some freedom to structure the license to meet a particular situation. For example, he may legally negotiate different royalty rates among licensees.

However, the federal antitrust laws and the law of patent misuse combine to impose significant restrictions on the rights of the parties to determine the terms of a patent license. One of the primary restrictions is a prohibition on the extension of the royalty payments beyond the expiration of the licensed patents. Under US law, the quid pro quo for the grant of the limited right of exclusion afforded by the patent is the right of the public to freely practice the invention after the term of the patent. The US Supreme Court in the famous case of *Brulotte v Thys* firmly established the rule that it is a per se misuse of the patent to use the bargaining leverage of the patent to extend its effectiveness beyond the patent term.

The economic rationale underlying *Brulotte* has been questioned by some jurists. Nevertheless, the *Brulotte* per se rule adopted by the Supreme Court continues in force in the US as in *Kimble v Marvel* case decided in 2015. (Jager, *ibid.*, pp 224-228)

See some part of the court's arguments: 1- *KIMBLE ET AL. v. MARVEL Case*

CALLAHAN, Circuit Judge and Court of Appeal Judges argue as follows:

This appeal calls on us to again construe the Supreme Court's frequently-criticized decision in [*Brulotte v. Thys Co.*, 379 U.S. 29, 85 S.Ct. 176, 13 L.Ed.2d 99 \(1964\)](#). In *Brulotte*, the Court held that a patent licensing agreement requiring a licensee to make royalty payments beyond the expiration date of the underlying patent was unenforceable because it represented an improper attempt to extend the patent monopoly. *Id.* at 30-33, 85 S.Ct. 176. We have previously noted that *Brulotte* has been read to require that any contract requiring royalty payments for an invention either after a patent expires or when it fails to issue cannot be upheld unless the contract provides a discount from the alternative, patent-protected rate. [*Zila, Inc. v. Tinnell*, 502 F.3d 1014, 1021 \(9th Cir.2007\)](#). We acknowledged that the *Brulotte* rule is counterintuitive and its rationale is arguably unconvincing. *Id.* at 1019-20 & n. 4. Nonetheless, recognizing that we are bound by Supreme Court authority and the strong interest in maintaining national uniformity on patent law issues, we have reluctantly applied the rule. *Id.* at 1020, 1022. We are compelled to do so again. Accordingly, we join our sister circuits in holding that a so-called "hybrid" licensing agreement encompassing inseparable patent and non-patent rights is unenforceable beyond the expiration date of the underlying patent, unless the agreement provides a discounted rate for the non-patent rights or some other clear indication that the royalty at issue was in no way subject to patent leverage.

SUPREME COURT OF THE UNITED STATES argues as follows:

Respondent Marvel Entertainment's corporate predecessor agreed to purchase petitioner Stephen Kimble's patent for a Spider-Man toy in exchange for a

lump sum plus a 3% royalty on future sales. The agreement set no end date for royalties. As the patent neared the end of its statutory 20-year term, Marvel discovered *Brulotte v. Thys Co.*, 379 U. S. 29, in which this Court held that a patentee cannot continue to receive royalties for sales made after his patent expires. Marvel then sought a declaratory judgment in federal district court confirming that it could stop paying Kimble royalties. The district court granted relief, and the Ninth Circuit affirmed. Kimble now asks this Court to overrule *Brulotte*.

Held: *Stare decisis* requires this Court to adhere to *Brulotte*. Pp. 3–18.

(a) A patent typically expires 20 years from its application date. 35

U. S. C. §154(a)(2). At that point, the unrestricted right to make or use the article passes to the public. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225, 230. This Court has carefully guarded the significance of that expiration date, declining to enforce laws and contracts that restrict free public access to formerly patented, as well as unpatentable, inventions. See, e.g., *id.*, at 230–233; *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U. S. 249, 255–256.

Brulotte applied that principle to a patent licensing agreement that provided for the payment of royalties accruing after the patent’s expiration. 379 U. S., at 30. The Court held that the post-patent royalty provision was “unlawful *per se*,” *id.*, at 30, 32, because it continued “the patent monopoly beyond the [patent] period,” *id.*, at 33, and, in so doing, conflicted with patent law’s policy of establishing a “postexpiration . . . public domain,” *ibid.*

The *Brulotte* rule may prevent some parties from entering into deals they desire, but parties can often find ways to achieve similar outcomes. For example, *Brulotte* leaves parties free to defer payments for pre-expiration use of a patent, tie royalties to non-patent rights, or make non-royalty-based business arrangements. Contending that such alternatives are not enough,

Kimble asks this Court to abandon *Brulotte*'s bright-line rule in favor of a case-by-case approach based on antitrust law's "rule of reason." Pp. 3–7.

(b) The doctrine of *stare decisis* provides that today's Court should stand by yesterday's decisions. Application of that doctrine, though "not an inexorable command," is the "preferred course." *Payne v. Tennessee*, 501 U. S. 808, 828, 827. Overruling a case always requires "special justification"—over and above the belief "that the precedent was wrongly decided." *Halliburton Co. v. Erica P. John Fund, Inc.*, 573 U. S. ___, ___. Where, as here, the precedent interprets a statute, *stare decisis* carries enhanced force, since critics are free to take their objections to Congress. See *e.g.*, *Patterson v. McLean Credit Union*, 491 U. S. 164, 172–173. Congress, moreover, has spurned multiple opportunities to reverse *Brulotte*, see *Watson v. United States*, 552 U. S. 74, 82–83, and has even rebuffed bills that would have replaced *Brulotte*'s *per se* rule with the standard Kimble urges. In addition, *Brulotte* implicates property and contract law, two contexts in which considerations favoring *stare decisis* are "at their acme," *Payne*, 501 U. S., at 828, because parties are especially likely to rely on such precedents when ordering their affairs.

Given those good reasons for adhering to *stare decisis* in this case, this Court would need a very strong justification for overruling *Brulotte*. But traditional justifications for abandoning *stare decisis* do not help Kimble here. First, *Brulotte*'s doctrinal underpinnings have not eroded over time. The patent statute at issue in *Brulotte* is essentially unchanged. And the precedent on which the *Brulotte* Court primarily relied, like other decisions enforcing a patent's cutoff date, remains good law. Indeed, *Brulotte*'s close relation to a whole web of precedents means that overruling it could threaten others. Second, nothing about *Brulotte* has proved unworkable. See *Patterson*, 491 U. S., at 173. To the contrary, the decision itself is simple to apply—

particularly as compared to Kimble’s proposed alternative, which can produce high litigation costs and unpredictable results. Pp. 7–12.

(c) Neither of the justifications Kimble offers gives cause to overrule *Brulotte*. Pp. 12–18.

(1) Kimble first argues the *Brulotte* hinged on an economic error—*i.e.*, an assumption that post-expiration royalties are always anticompetitive. This Court sees no error in Kimble’s economic analysis. But even assuming Kimble is right that *Brulotte* relied on an economic misjudgment, Congress is the right entity to fix it. The patent laws are not like the Sherman Act, which gives courts exceptional authority to shape the law and reconsider precedent based on better economic analysis. Moreover, Kimble’s argument is based not on evolving economic theory but rather on a claim that the *Brulotte* Court simply made the wrong call. That claim fails to clear *stare decisis*’s high bar. In any event, *Brulotte* did not even turn on the notion that post-patent royalties harm competition. Instead, the *Brulotte* Court simply applied the categorical principle that all patent-related benefits must end when the patent term expires. Kimble’s real complaint may go to the merits of that principle as a policy matter. But Congress, not this Court, gets to make patent policy. Pp. 12–16.

(2) Kimble also argues that *Brulotte* suppresses technological innovation and harms the national economy by preventing parties from reaching agreements to commercialize patents. This Court cannot tell whether that is true. *Brulotte* leaves parties free to enter alternative arrangements that may suffice to accomplish parties’ payment deferral and risk-spreading goals. And neither Kimble nor his *amici* offer any empirical evidence connecting *Brulotte* to decreased innovation. In any event, claims about a statutory precedent’s

consequences for innovation are “more appropriately addressed to Congress.”
Halliburton, 573 U. S., at _____. Pp. 16–18.

727 F. 3d 856, affirmed.

KAGAN, J., delivered the opinion of the Court, in which SCALIA, KENNEDY, GINSBURG, BREYER, and SOTOMAYOR, JJ., joined. ALITO, J., filed a dissenting opinion, in which ROBERTS, C. J., and THOMAS, J., joined.

....

See also the dissenting opinion delivered by JUSTICE ALITO, with whom THE CHIEF JUSTICE and JUSTICE THOMAS join, as follows:

The Court employs *stare decisis*, normally a tool of restraint, to reaffirm a clear case of judicial overreach. Our decision in *Brulotte v. Thys Co.*, 379 U. S. 29 (1964), held that parties cannot enter into a patent licensing agreement that provides for royalty payments to continue after the term of the patent expires. That decision was not based on anything that can plausibly be regarded as an interpretation of the terms of the Patent Act. It was based instead on an economic theory—and one that has been debunked. The decision interferes with the ability of parties to negotiate licensing agreements that reflect the true value of a patent, and it disrupts contractual expectations. *Stare decisis* does not require us to retain this baseless and damaging precedent.

I A

The Patent Act provides that a patent grants certain exclusive rights to the patentee and “his heirs or assigns” for a term of 20 years. 35 U. S. C. §§154(a)(1) and (2). The Act says nothing whatsoever about post-expiration royalties. In *Brulotte*, however, the Court held that such royalties are *per se* unlawful. The Court made little pretense of finding support for this holding in

the language of the Act. Instead, the Court reasoned that allowing post-expiration royalties would subject “the free market visualized for the post-expiration period . . . to monopoly influences that have no proper place there.” 379 U. S., at 32–33. Invoking antitrust concepts, the decision suggested that such arrangements are “an effort to enlarge the monopoly of the patent by t[y]ing the sale or use of the patented article to the purchase or use of unpatented ones.” *Id.*, at 33.

Whatever the merits of this economic argument, it does not represent a serious attempt to interpret the Patent Act. A licensing agreement that provides for the payment of royalties after a patent’s term expires does not enlarge the patentee’s monopoly or extend the term of the patent. It simply gives the licensor a contractual right. Thus, nothing in the text of the Act even arguably forbids licensing agreements that provide for post-expiration royalties.

Brulotte was thus a bald act of policymaking. It was not simply a case of incorrect statutory interpretation. It was not really statutory interpretation at all.

Not only was *Brulotte* based on policymaking, it was based on a policy that is difficult to defend. Indeed, in the intervening 50 years, its reasoning has been soundly refuted. See, e.g., 10 P. Areeda & H. Hovenkamp, *Antitrust Law: An Analysis of Antitrust Principles and Their Application* ¶1782c.3, pp. 554–556 (3d ed. 2011); See & Caprio, *The Trouble with Brulotte: The Patent Royalty Term and Patent Monopoly Extension*, 1990 Utah L. Rev. 813, 846–851; *Scheiber v. Dolby Labs., Inc.*, 293 F. 3d 1014, 1017 (CA7 2002); Brief for Petitioners 23–25, and n. 11 (collecting sources); *ante*, at 3, n. 3.

Brulotte misperceived the purpose and effect of post-expiration royalties. The decision rested on the view that post-expiration royalties extend the patent term by means of an anti-competitive tying arrangement. As the Court

understood such an arrangement, the patent holder leverages its monopoly power during the patent term to require payments after the term ends, when the invention would otherwise be available for free public use. But agreements to pay licensing fees after a patent expires do not “enlarge the monopoly of the patent.” 379 U. S., at 33. Instead, “[once the patent term expires, the power to exclude is gone,” and all that is left “is a problem about optimal contract design.” Easterbrook, *Contract and Copyright*, 42 Hous. L. Rev. 953, 955 (2005).

The economics are simple: Extending a royalty term allows the parties to spread the licensing fees over a longer period of time, which naturally has the effect of reducing the fees during the patent term. See *ante*, at 5. Restricting royalty payments to the patent term, as *Brulotte* requires, compresses payment into a shorter period of higher fees. The Patent Act does not prefer one approach over the other.

There are, however, good reasons why parties sometimes prefer post-expiration royalties over upfront fees, and why such arrangements have pro-competitive effects. Patent holders and licensees are often unsure whether a patented idea will yield significant economic value, and it often takes years to monetize an innovation. In those circumstances, deferred royalty agreements are economically efficient. They encourage innovators, like universities, hospitals, and other institutions, to invest in research that might not yield marketable products until decades down the line. See Brief for Memorial Sloan Kettering Cancer Center et al. as *Amici Curiae* 8–12. And they allow producers to hedge their bets and develop more products by spreading licensing fees over longer periods. See *ibid.* By prohibiting these arrangements, *Brulotte* erects an obstacle to efficient patent use. In patent law and other areas, we have abandoned *per se* rules with similarly disruptive

effects. See, e.g., *Illinois Tool Works Inc. v. Independent Ink, Inc.*, 547 U. S. 28 (2006); *Leegin Creative Leather Products, Inc. v. PSKS, Inc.*, 551 U. S. 877 (2007).

The majority downplays this harm by insisting that “parties can often find ways around *Brulotte*.” *Ante*, at 6. But the need to avoid *Brulotte* is an economic inefficiency in itself. Parties are not always aware of the prohibition—as this case amply demonstrates. And the suggested alternatives do not provide the same benefits as post-expiration royalty agreements. For instance, although an agreement to amortize payments for sales during the patent term would “bring down early outlays,” the Court admits that such an agreement might not reflect the parties’ risk preferences. *Ante*, at 6. Moreover, such an arrangement would not necessarily yield the same amount of total royalties, particularly for an invention or a medical breakthrough that takes decades to develop into a marketable product. The sort of agreements that *Brulotte* prohibits would allow licensees to spread their costs, while *also* allowing patent holders to capitalize on slow-developing inventions.

C On top of that, *Brulotte* most often functions to upset the parties’ expectations. This case illustrates the point. No one disputes that, when “negotiating the settlement, neither side was aware of *Brulotte*.” *Ante*, at 2. Without knowledge of our *per se* rule, the parties agreed that Marvel would pay 3% in royalties on all of its future sales involving the Web Blaster and similar products. If the parties had been aware of *Brulotte*, they might have agreed to higher payments during the patent term. Instead, both sides expected the royalty payments to continue until Marvel stopped selling toys that fit the terms of the agreement. But that is not what happened. When Marvel discovered *Brulotte*, it used that decision to nullify a key part of the

agreement. The parties' contractual expectations were shattered, and petitioners' rights were extinguished.

The Court's suggestion that some parties have come to rely on *Brulotte* is fanciful. The Court believes that there is a "reasonable possibility that parties have structured their business transactions in light of *Brulotte*." *Ante*, at

10. Its only support for this conclusion is Marvel's self-serving and unsupported assertion that some contracts might not specify an end date for royalties because the parties expect *Brulotte* to supply the default rule. To its credit, the Court stops short of endorsing this unlikely prediction, saying only that "uncertainty on this score cuts in Marvel's direction." *Ante*, at 10.

But there is no real uncertainty. "[W]e do not know" if Marvel's assertion is correct because Marvel has provided no evidence to support it. *Ibid*. And there are reasons to believe that, if parties actually relied on *Brulotte* to supply a default rule, courts would enforce the contracts as the parties expected. See, e.g., 27 R. Lord, Williston on Contracts §70:124 (4th ed. 2003). What we know for sure, however, is that *Brulotte* has upended the parties' expectations here and in many other cases. See, e.g., *Scheiber*, 293 F. 3d, at 1016; *Boggild v. Kenner Products*, 853 F. 2d 465, 466–467 (CA6 1988); *Pitney Bowes, Inc. v. Mestre*, 701

F. 2d 1365, 1367, 1373 (CA11 1983). These confirmed problems with retaining *Brulotte* clearly outweigh Marvel's hypothetical fears.

II In the end, *Brulotte*'s only virtue is that we decided it. But that does not render it invincible. *Stare decisis* is important to the rule of law, but so are correct judicial decisions. Adherence to prior decisions "promotes the evenhanded, predictable, and consistent development of legal principles, fosters reliance on judicial decisions, and contributes to the actual and perceived integrity of the judicial process." *Pearson v. Callahan*, 555 U. S.

223, 233 (2009) (quoting *Payne v. Tennessee*, 501 U. S. 808, 827 (1991)). But *stare decisis* is not an “inexorable command.” *Payne*, *supra*, at 828; *Washington v. W. C. Dawson & Co.*, 264 U. S. 219, 238 (1924) (Brandeis, J., dissenting). “Revisiting precedent is particularly appropriate where, as here, a departure would not upset expectations, the precedent consists of a judge-made rule . . . , and experience has pointed up the precedent’s shortcomings.” *Pearson*, *supra*, at 233.

Our traditional approach to *stare decisis* does not require us to retain *Brulotte*’s *per se* rule. *Brulotte*’s holding had no basis in the law. Its reasoning has been thoroughly disproved. It poses economic barriers that stifle innovation. And it unsettles contractual expectations.

It is not decisive that Congress could have altered *Brulotte*’s rule. In general, we are especially reluctant to overturn decisions interpreting statutes because those decisions can be undone by Congress. See, *e.g.*, *John R. Sand & Gravel Co. v. United States*, 552 U. S. 130, 139 (2008); *Patterson v. McLean Credit Union*, 491 U. S. 164, 172–173 (1989). The Court calls this a “superpowered form of *stare decisis*” that renders statutory interpretation decisions nearly impervious to challenge. *Ante*, at 10. I think this goes a bit too far.

As an initial matter, we do not give super-duper protection to decisions that do not actually interpret a statute. When a precedent is based on a judge-made rule and is not grounded in anything that Congress has enacted, we cannot “properly place on the shoulders of Congress” the entire burden of correcting “the Court’s own error.” *Girouard v. United States*, 328 U. S. 61, 69–70 (1946). On the contrary, we have recognized that it is appropriate for us to correct rules of this sort. See, *e.g.*, *Leegin*, 551 U. S., at 899–900; *State Oil Co. v. Khan*, 522 U. S. 3, 20–21 (1997).

The Court says that it might agree if *Brulotte* were an antitrust precedent because *stare decisis* has “less-than-usual force in cases involving the Sherman Act.” *Ante*, at

14. But this distinction is unwarranted. We have been more willing to reexamine antitrust precedents because they have attributes of common-law decisions. I see no reason why the same approach should not apply where the precedent at issue, while purporting to apply a statute, is actually based on policy concerns. Indeed, we should be even more willing to reconsider such a precedent because the role implicitly assigned to the federal courts under the Sherman Act has no parallel in Patent Act cases.

Even taking the Court on its own terms, *Brulotte* was an antitrust decision masquerading as a patent case. The Court was principally concerned with patentees improperly leveraging their monopoly power. See 379 U. S., at 32–33. And it expressly characterized post-expiration royalties as anti-competitive tying arrangements. See *id.*, at

33. It makes no sense to afford greater *stare decisis* protection to *Brulotte*’s thinly veiled antitrust reasoning than to our Sherman Act decisions.

The Court also places too much weight on Congress’ failure to overturn *Brulotte*. We have long cautioned that “[i]t is at best treacherous to find in congressional silence alone the adoption of a controlling rule of law.” *Girouard, supra*, at 69. Even where Congress has considered, but not adopted, legislation that would abrogate a judicial ruling, it cannot be inferred that Congress’ failure to act shows that it approves the ruling. See *Central Bank of Denver, N. A. v. First Interstate Bank of Denver, N. A.*, 511

U. S. 164, 187 (1994). “[S]everal equally tenable inferences may be drawn from such inaction.” *Ibid.* (quoting *Pension Benefit Guaranty Corporation v. LTV Corp.*, 496 U. S. 633, 650 (1990)).

Passing legislation is no easy task. A federal statute must withstand the “finely wrought” procedure of bicameralism and presentment. *INS v. Chadha*, 462 U. S. 919, 951 (1983); *Clinton v. City of New York*, 524 U. S. 417, 440 (1998); see U. S. Const., Art. I, §7. Within that onerous process, there are additional practical hurdles. A law must be taken up for discussion and not passed over in favor of more pressing matters, and Senate rules require 60 votes to end debate on most legislation. And even if the House and Senate agree on a general policy, the details of the measure usually must be hammered out in a conference committee and repassed by both Houses.

* * * A proper understanding of our doctrine of *stare decisis* does not prevent us from reexamining *Brulotte*. Even the Court does not defend the decision on the merits. I would reconsider and overrule our obvious mistake. For these reasons, I respectfully dissent.

2- *Brulotte v. Thys Co.* 1964

MR. JUSTICE DOUGLAS delivered the opinion of the Court.

Respondent, owner of various patents for hop-picking, sold a machine to each of the petitioners for a flat sum^[1] and issued a license for its use. Under that license there is payable a minimum royalty of \$500 for each hop-picking season or \$3.33 1/3 per 200 pounds of dried hops harvested by the machine, whichever is greater. The licenses by their terms may not be assigned nor may the machines be removed from Yakima County. 30*30 The licenses issued to petitioners listed 12 patents relating to hop-picking machines;^[2] but only seven were incorporated into the machines sold to and licensed for use by petitioners. Of those seven all expired on or before 1957. But the licenses issued by respondent to them^[3] continued for terms beyond that date.

Petitioners refused to make royalty payments accruing both before and after the expiration of the patents. This suit followed. One defense was misuse of the patents through extension of the license agreements beyond the expiration date of the patents. The trial court rendered judgment for respondent and the Supreme Court of Washington affirmed. 62 Wash. 2d 284, 382 P. 2d 271. The case is here on a writ of certiorari. 376 U. S. 905.

We conclude that the judgment below must be reversed insofar as it allows royalties to be collected which accrued after the last of the patents incorporated into the machines had expired.

The Constitution by Art. I, § 8 authorizes Congress to secure "for limited times" to inventors "the exclusive right" to their discoveries. Congress exercised that power by 35 U. S. C. § 154 which provides in part as follows:

"Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. . . ."

31*31 The right to make, the right to sell, and the right to use "may be granted or conferred separately by the patentee." [*Adams v. Burke*, 17 Wall. 453, 456.](#) But these rights become public property once the 17-year period expires. See [*Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 185](#); [*Kellogg Co. v. National Biscuit Co.*, 305 U. S. 111, 118.](#) As stated by Chief Justice Stone, speaking for the Court in [*Scott Paper Co. v. Marcalus Co.*, 326 U. S. 249, 256](#):

". . . any attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, whatever

the legal device employed, runs counter to the policy and purpose of the patent laws."

The Supreme Court of Washington held that in the present case the period during which royalties were required was only "a reasonable amount of time over which to spread the payments for the use of the patent." 62 Wash. 2d, at 291, 382 P. 2d, at 275. But there is intrinsic evidence that the agreements were not designed with that limited view. As we have seen,^[4] the purchase price in each case was a flat sum, the annual payments not being part of the purchase price but royalties for use of the machine during that year. The royalty payments due for the post-expiration period are by their terms for use during that period, and are not deferred payments for use during the pre-expiration period. Nor is the case like the hypothetical ones put to us where non-patented articles are marketed at prices based on use. The machines in issue here were patented articles and the royalties exacted were the same for the post-expiration period as they were for the period of the patent. That is peculiarly significant in this case in view of other provisions 32*32 of the license agreements. The license agreements prevent assignment of the machines or their removal from Yakima County *after*, as well as before, the expiration of the patents.

Those restrictions are apt and pertinent to protection of the patent monopoly; and their applicability to the post-expiration period is a telltale sign that the licensor was using the licenses to project its monopoly beyond the patent period. They forcefully negate the suggestion that we have here a bare arrangement for a sale or a lease at an undetermined price, based on use. The sale or lease of *unpatented* machines on long-term payments based on a deferred purchase price or on use would present wholly different

considerations. Those arrangements seldom rise to the level of a federal question. But patents are in the federal domain; and "whatever the legal device employed" (*Scott Paper Co. v. Marcalus Co., supra, at 256*) a projection of the patent monopoly after the patent expires is not enforceable. The present licenses draw no line between the term of the patent and the post-expiration period. The same provisions as respects both use and royalties are applicable to each. The contracts are, therefore, on their face a bald attempt to exact the same terms and conditions for the period after the patents have expired as they do for the monopoly period. We are, therefore, unable to conjecture what the bargaining position of the parties might have been and what resultant arrangement might have emerged had the provision for post-expiration royalties been divorced from the patent and nowise subject to its leverage.

In light of those considerations, we conclude that a patentee's use of a royalty agreement that projects beyond the expiration date of the patent is unlawful *per se*. If that device were available to patentees, the free market visualized for the post-expiration period 33*33 would be subject to monopoly influences that have no proper place there.

Hybrid License

1- پرونده (سنت رجیس علیه صنایع رویال) (*St. Regis Paper Co. v Royal Industries*)

رویال در سال 1963 قرارداد لیسانسی را با سنت رجیس منعقد می کند، که بر مبنای آن همزمان اجازه بهره برداری از اختراع و نو هاو^{۱۶} را به سنت رجیس می دهد و در ازای آن 10 درصد از فروش ویژه محصولات زیر پوشش گواهی و هزینه انتقال دانش چگونگی را به دست می آورد. در پی بروز اختلاف، با ادعای بی اعتباری گواهی اختراع سنت رجیس از پرداخت رویالتی امتناع نمود و دادخواست ابطال گواهی

¹⁶ . know - how

اختراع را به دادگاه تقدیم کرد. دادگاه با بررسی دلایل رای به ابطال گواهی اختراع داد. هم چنین به دلیل پیوستگی نوهاو با اختراع موضوع گواهی عنوان کرد که برای نوهاو نیز با ابطال گواهی اختراع امکان دریافت رویالتی وجود ندارد هرچند که این دانش برای سنت رجیس دارای مزیت نسبی بوده و فرصت اقتصادی مناسبی جهت تسخیر بازار در اختیار رجیس قرار داده است. در نهایت دادگاه پژوهش با بررسی ادله عنوان کرد که اولاً امکان عودت حق امتیاز پرداخت شده تا پیش از مقطع طرح دعوا به سنت رجیس وجود ندارد، و ثانیاً نوهاو خود دارای ارزش مستقلی بوده است که تا پیش از طرح دعوا توسط سنت رجیس پرداخت شده است و برای بعد از ابطال گواهی اختراع امکان دریافت رویالتی بابت دانش اعطایی وجود ندارد.^{۱۷}

2- کرومالی علیه فیشمان

کرومالی به عنوان خواهان در سال 1968 یک لیسانس براساس یک حق اختراع از فیشمان دریافت کرده بود. در سال 1976 بعد از فسخ قرارداد، کرومالی دادخواستی مبنی بر بی اعتباری گواهی اختراع و سوء استفاده از آن تقدیم دادگاه کرد که در صورت پذیرفته شدن آن قرارداد غیر نافذ اعلام می شد. در مقابل فیشمان هم به عنوان لیسانس دهنده دادخواستی به خواسته پرداخت حق امتیاز ها ارائه داد. دادگاه بخش رای به بی اعتباری گواهی اختراع داد و فیشمان هم در مقابل مستحق دریافت 25800 دلار به عنوان خسارت گردید. کرومالی از رای ذکر شده پژوهش خواهی کرد. دادگاه در ابتدا به این موضوع پرداخت که مبنای خسارتی که فیشمان مستحق دریافت آن شده بود چیست؟ دادگاه دریافت که قرارداد منعقد شده در سال 1968 از نظر ماهیت، در حقیقت فروش یک تجارت بوده است. دادگاه با در نظر گرفتن رای سنت رجیس دریافت که لیسانس دهنده مستحق دریافت خسارت برای کالاهای خارج از

¹⁷ St. Regist Paper Company, Plaintiff-appellee, v. Royal industries, and Plas –ties Subsidiary , Defendants-appellants. St. Regis Paper Company , Plaintiff-appellant, v. Royal Industries, and plas-ties subsidiary, Defendant-appellees, 552F.2d 309 (9thcir . 1977) . www.law. Justia.com . تاریخ رجوع 1394/12/1

گواهی است. و از طرف دیگر بر مبنای پرونده لیر تعهد به پرداخت حق امتیاز از هنگام تلاش برای به قضاوت گذاشته شدن اعتبار گواهی اختراع به پایان می پذیرد. در نتیجه دادگاه با در نظر گرفتن دیدگاه هر دو پرونده، رای داد فیشمان به عنوان لیسانس دهنده، شایستگی دریافت حق امتیاز برای بعد از سال 1976 را ندارد. اما مستحق دریافت خسارت برای بهره برداری از دارایی های خارج از گواهی به موجب قرارداد فروش می باشد.^{۱۸}

Further US Case Law

For pure trade secret license, you need to see *Warner-Lambert v John Reynold* case decided by Federal court in 1959 and followed by *Aronson v Quick Point Pencil* in 1979 and *Universal Gym v ERWA Exercise Equipment* in 1987.

For pure patent license you need to see the leading case of *Brulotte v Thys Co.* decided by the Supreme Court in 1964 followed by number of the later cases and reaffirmed by the Supreme Court in *Kimble v Marvel* in 2015.

For hybrid license you have to see: *St. Regis Paper Co. v Royal Industries*, decided in 1977, *Span-Deck v Fab-Con Inco.* , decided in 1982, *Pitney Bowes v Mestre*, decided in 1983, *Boggilld v kenner Products*, decided in 1983 and other cases discussed by Jager in pp.229-236.

Reading Materials:

For detailed discussion see:

¹⁸ .CHROMALLOY AMERICAN CORPORATION ,a Delaware corporation , Plaintiff – Appellant , v. B. Wallace FISCHMAN, an individual, Defendant- Appellee . B.Wallace FISCHMANN, an individual , counterclaimant Appellant. United states Court of Appeals, Ninth circuit. 716F.2d 683

- 1- Wei-Lin Wang, *A Study on the Legality of Royalty Collection Clauses after Expiration of Patent Rights*, 15 J. MARSHALL REV. INTELL. PROP. L. 215 (2016),
- 2- Molly McCartney, caught in the Web of Stare Decisis: Why the Supreme Court's Holding in *Kimble v. Marvel Enterprises, Inc.*, was Wrongly decided, *Wake Forest Journal of Business and IP Law*, vol. 16, Nom. 4, 492.
- 3- Maxwell C. McGraw, *Kimble v. Marvel Entertainment, LLC: Economic Efficiency Caught in the Web of Improper, Judicial Restraint*, KANSAS LAW REVIEW, vol. 65, p. 177.
- 4- James M. Stephens, *Recent Decisions: Patents - Validity of Letters Patent - Licensee Estoppel to Dispute Validity [Lear, Inc. v. Adkins, 395 U.S. 653 (1969)]*, 21 Cas. W. Res. L. Rev. 279 (1970) Available at: <http://scholarlycommons.law.case.edu/caselrev/vol21/iss2/7>
- 5- Nissim, Stuart H. (1988) "The Federal Common Law of Patent Licensing," *University of Baltimore Law Forum*: Vol. 18: No. 2, Article 6, Available at: <http://scholarworks.law.ubalt.edu/lf/vol18/iss2/6>