

замовника, був вигідний обом сторонам та враховував всі особливості, які пов'язані за специфікою даного об'єкта.

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## **LICENSES AND LICENSE AGREEMENT IN THE SYSTEM OF CONTRACTS ON INTELLECTUAL PROPERTY RIGHTS**

Characterizing individual contractual structures in the field of intellectual property rights, we pay attention to licenses and license agreement. Based on the content of Art. 1108 of the Civil Code of Ukraine can give the following definition of licenses in the field of intellectual property. A license is a written authorization granted by a person who has the exclusive right to authorize the use of an intellectual property object (licensor) to another person (licensee) for the use of that object in a particular limited area.

In general, the term «license» (from Latin licitus – authorization, law) is quite widely used in modern legislative terminology. In the context of intellectual property laws, licenses have traditionally been considered as a permit to use an intellectual property object. Thus, according to Art. 1 of the Law of Ukraine «On Protection of Rights to Inventions and Utility Models» license – permission of the patent owner (licensor) granted to another person (licensee) to use the invention (utility model) under certain conditions.

With regard to license types, it should be noted that there are several criteria for classifying license types. The criteria for classification are the licensee's right to grant licenses to others and the licensee's right to protect their exclusive rights against the unlawful acts of others. In the former case, it is a simple (non-exclusive) license under which the licensee may grant the right to use the result of intellectual activity or the means of individualization to others. Licenses issued by a licensor to others must only provide for such use as is specified in the license agreement.

In the second case, it is an exclusive license under which the licensee is forbidden to issue licenses for the use of the result of intellectual activity or means of individualization to other persons. The essence of an exclusive license is the ability to use the facility in the absence of competitors. The right to prohibit all other persons from using the object still belongs to the right holder of the exclusive rights. Chapter 75 of the CC introduces the concept of a single license, which recognizes a license

issued to one licensee and excludes the licensor from granting licenses to other persons for the use of the intellectual property right in the field, which is limited by this license, but does not exclude the licensee's use of this license ect in the said field. The second classification of license agreements can be made depending on the will of the holder of exclusive rights to transfer the right to use the object of intellectual activity.

First, it is a «voluntary license» under which the intellectual property right holder – the licensor voluntarily grants or undertakes to grant the other party – the licensee the right to use the intellectual property object. Second, it is a compulsory license where, at the request of the person concerned, the court, in the cases specified by law, may decide to grant that person the right to use the result of intellectual activity under certain conditions, that is, against the will of the owner of intellectual property rights. The third classification is in accordance with the method of protection of the object of the license agreement. License agreements are divided into: patent; patent-free; complex.

Patent license agreements are contracts for the use of intellectual property that are protected by appropriate security documents: patents or certificates. Patent-free licenses include licensing agreements that grant the right to use scientific and technical achievements that do not have legal protection, production experience, confidential information of a managerial, commercial, organizational nature, ie production secrets («know-how») and decisions on which applications for legal protection were filed.

A special variety of patent and non-patent licenses should include license exchange agreements. This type of «cross-license» («cross-license») is widespread in practice for a variety of reasons. On the one hand, later patents are often dependent on previously issued ones and cannot be used without the acquisition of a patent protected prototype. In its turn, the owner of this prototype is interested in purchasing more advanced technical solutions. As a result, licenses are exchanged between owners of related patents. On the other hand, competing firms that are interested in improving the technical and economic level of their products are more likely to use licenses than sell them without sharing any secrets. Under a comprehensive license agreement, a licensee obtains the right to use several intellectual property objects, some of which have legal protection and the other does not.

Depending on the object, the following license agreements are distinguished: copyright; about the grant of related rights; granting an invention, utility model or industrial design right; on the granting of trademark rights; on granting rights to the topology of integrated circuits; about granting breeding achievement rights. As a kind of license agreements can be considered sub-license agreement, the provisions of

which are contained in part 2 of Art. 1109 of the Central Committee of Ukraine. Under this agreement, the licensee grants permission to use the intellectual property object to another person (sub-licensee). Sub-license agreement is possible only in cases, which are expressly stipulated in the license agreement between the licensee and the licensee. However, since the sublicensee is not in direct contractual relationship with the licensee, the licensee is liable to the licensee for the actions of the sublicensee, unless otherwise stipulated by the license agreement.

The Central Committee of Ukraine permits the possibility of issuing a license without concluding a license agreement. In Art. 1107 license and license agreement are defined as separate types of contracts for the disposal of intellectual property rights. However, the license itself is a one-sided transaction and cannot be regarded as a type of contract. Therefore, it is inappropriate to include it alongside a license agreement as a type of intellectual property rights management agreement. Assignment of a license to agreements on the disposal of intellectual property rights in Art. 1107 of the Central Committee of Ukraine is wrong.

Special laws, unlike the Central Committee of Ukraine (for example, Article 32 of the Law of Ukraine «On Copyright and Related Rights», Article 28 of the Law of Ukraine «On Protection of Rights to Inventions and Utility Models» Article 20 of the Law of Ukraine «On Protection of Rights to industrial designs », Article 16 of the Law of Ukraine» On Protection of Rights to Marks for Goods and Services «, Article 40 of the Law of Ukraine» On Protection of Rights to Varieties of Plants «, Article 16 of the Law of Ukraine» On Protection of Rights for Topographies integrated circuits») proceed from the fact that a license is always issued on the basis of a license agreement. Apparently, this approach is more grounded and correct. It is difficult to imagine the option of granting an entity that owns intellectual property rights a license to use the object without entering into a contract. It is the license agreement in this case that is the basis for granting the permit (issuing a license) and, at the same time, a means of determining the conditions for granting such a license.

Referring to the characteristics of the license agreement, it should be noted that it occupies an important place among the agreements on the disposal of intellectual property rights. According to Art. 1109 of the Civil Code of Ukraine under a license agreement one party (the licensee) grants the other party (the licensee) permission to use the object of intellectual property (license) on terms determined by mutual agreement of the parties, taking into account the requirements of the Central Committee of Ukraine and other law.

In the scientific literature, the following specific features of the license agreement are distinguished: the intellectual product offered for transfer under the contract is intangible; the licensee acquires the right to use the intellectual property

rights defined in the contract by the contract; tangible objects, if transferred under a license agreement, are only carriers of information that is the object of intellectual property; the core element of the license object – the exclusive intellectual property right does not pass to the licensee, but is only granted a temporary right to use the object of that right; the patent holder retains proprietary rights to the intellectual property when granting the license. A license agreement is considered to have been concluded if the parties have agreed to the essential terms (ie, those conditions which are recognized as essential by law or necessary for contracts of this type), ie such agreement is legally consensual. In addition, a mandatory condition for the validity of a license agreement is to conclude it in writing, since failure to comply with the written form results in the nullity of such agreement (Part 2 of Article 1107 of the Civil Code of Ukraine). Please note that the license agreement may not be the right to use an intellectual property object that was not valid at the time the contract was concluded. Based on the provisions of Part 1 of Art. 638 and Part 3 of Art. 1109 of the Civil Code of Ukraine to the essential terms of the license agreement belong to the subject of the contract; type of license; scope of the intellectual property right object (specific rights conferred by the contract, ways of using the said object, territory and terms to which the rights are granted, etc.), size, procedure and payment terms for the use of the intellectual property right object property.

The parties to the license agreement must clearly identify the possible extent of the use of the intellectual property object, the possibility of transferring the intellectual property object to third parties, maintaining the confidentiality of the content of the license agreement, the procedure and amount of payment. It should be noted that the Central Committee of Ukraine has expanded the scope of the license agreement. If in the special legislation on intellectual property the copyright contract in the field of copyright and the license agreement in the field of industrial property differ, then the Central Committee of Ukraine establishes a universal design of the license agreement, which applies to both the objects of copyright and the objects of industrial property.

The primary legal purpose of this agreement is to grant a license (license) for the use of a specific intellectual property right. The license agreement is one of the options for obtaining a license for the use of intellectual property rights (Part 2 of Article 1108 of the Civil Code of Ukraine). Therefore, the provisions of Art. 1108 of the Civil Code of Ukraine on licenses for the use of intellectual property rights should also be applied to the license agreements. Typical contracts have traditionally played an important role in the legal regulation of contractual relations in the field of intellectual property. In the Central Committee of Ukraine the provisions on standard license agreements are contained in Art. 1111. The Institute for Standard License

Agreements is intended to provide enhanced protection of the interests of the creator of the intellectual property object in the contractual relationship. The right to approve standard license agreements in accordance with Part 1 of Art. 1111 of the Central Committee of Ukraine was provided to authorized agencies and creative unions.

The license agreement may, in the cases provided for by law, entail the conclusion of a sub-license agreement whereby the licensee grants a sub-license to another (sub-licensee) for the use of the intellectual property object. In this case, the licensee shall be liable to the licensee for the actions of the sub-licensee, unless otherwise stipulated by the license agreement.

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#### ОКРЕМІ ФУНКЦІОНАЛЬНІ АСПЕКТИ ІТ-ПРАВА

Інформаційна сфера у сучасному суспільстві перетворюються на важливий чинник, що активно впливає на розвиток людства. Інформаційні технології вагомо сприяють перетворенням у житті конкретної людини і суспільства в цілому. Збалансований стан розвинутої інформаційної сфери має