aussetzung, dass die Lehre, die durch den eingeschränkten Anspruch definiert wird, bereits in den ursprünglichen Anmeldeunterlagen als Erfindung offenbart war.

4. Sollte ein Unterschied zwischen Rechtsmitteln bestehen, die Patentinhabern / Dritten zur Verfügung stehen, und / oder den materiellen Bedingungen, die Patentinhaber / Dritte erfüllen müssen, um eine Änderung nach Erteilung zuzulassen?

Für die schweizerische Gruppe der AIPPI erscheint es nicht als zwingend, dass Patentinhabern und Dritten unterschiedliche Rechtsmittel (Rechtsmittel hier verstanden als von der Rechtsordnung zur Verfügung gestelltes Verfahren zur Durchsetzung von Rechten, und nicht als Verfahren zur Anfechtung eines Entscheides einer unteren Instanz) zur Verfügung gestellt werden. Allerdings ist die schweizerische Gruppe der AIPPI der Ansicht, dass den Patentinhabern jedenfalls ein Administrativverfahren offen stehen sollte.

Die materiellen Voraussetzungen für eine Änderung nach Erteilung müssen nach Ansicht der schweizerischen Gruppe der AIPPI unabhängig davon, wer die Änderung beantragt, dieselben sein.

5. Was sollten die Folgen für die Haftung wegen Patentverletzung Dritter sein, wenn Patentansprüche nach Erteilung geändert werden?

Nach Ansicht der schweizerischen Gruppe der AIPPI sollten Änderungen von Patentansprüchen post Erteilung einerseits gegenüber jedermann, also erga omnes, und andererseits auch für die Vergangenheit, also ex tunc, wirken.

6. Hat Ihre Gruppe irgendwelche anderen Gesichtspunkte oder Vorschläge zur Harmonisierung in diesem Bereich?

Nein.

Contracts regarding Intellectual Property Rights (assignments and licenses) and third parties (Q 190)

Report of Swiss Group*

1. What forms of property right do IP rights take in your country?

In Switzerland IP rights are considered to constitute full property rights. They are rights in rem, i.e. IP rights or rights on intangible assets. They give their owner the full power to exploit them in any possible way: to sell them, to license them, to pledge them, to pass them on by inheritance or by any other means of disposal.

2. Is it required to register an assignment or licence of IP rights in order for it to be effective a) between the parties and b) against third parties?

Under Swiss law a license agreement is a contract sui generis, which is ruled by the general rules of the Code of obligations (CO).

The license agreement deploys full effect between the parties without any registration. However, in order to have a license taken into consideration by third parties, it must be registered with the federal office in charge of registration (for all registrable IP rights this office is the Federal Institute for Intellectual Property in Bern).

The law requires a written contract only for the assignment of trademarks, patents and designs.

Assignments of copyrights are effective even without written con-

* Members of the working group: Dr. Kamen Troller (chairman), Dr. Lorenza Ferrari Hofer, Dr. Paul Peyrot, Dr. Urs Hess-Odoni.

tracts and as there is no copyright register, no registration of the assignment is possible.

For the registration of licence on registered IP, a written statement of the IP owner confirming the existence of the licence is requested.

3. Does the a) exclusive and b) non-exclusive licensee of an IP right have a right to bring proceedings for infringement, and if so, what conditions must be satisfied for right to arise?

As a general rule, only exclusive licensees may bring proceedings for infringement and this only if this power is expressly stated in the license agreement and that it results furthermore from the license agreement that the parties really intended to give such power to the licensee (Supreme Court decision of 18th December 1998, sic! 1999, 447).

In the recent past however, there is a tendency to grant the exclusive licensee an eo ipso right to sue for infringement. The new law on designs grants this right in article 35, n° 4. The revised patent law, which will enter into force in 2006 or 2007 will contain the same disposition.

4. Is a licence transferable a) by the licensor and b) by the licensee?

A license agreement creates duties in personam and must be personally fulfilled by the licensee. Unless expressly stipulated in the license agreement, licensee may not grant sub-licenses (unless it results from the nature of the license agreement that such sub-licenses are inevitable and have been planned from the very beginning) or otherwise assign the rights licensed to him.

If the license is non-exclusive, then the licensor may obviously grant other licenses. If it is exclusive, he may not.

5. What is the effect on an assignment or licence of the invalidity of the underlying IP right?

If any underlying IP right is invalid, then the license agreement is or becomes invalid as of the date of the invalidity. Under Swiss law it is considered that the agreement is null and void due to its impossible content, i.e. it can no more be fulfilled (CO, art. 20, no 1). However, this only applies to license agreements which depend fully on the validity of the registered right. In patent license agreements the know-how part of the license may be more important than the patent part of it and therefore the license may still be valid for the know-how part.

The assignment of an IP right does as a principle not touch the license agreement. The licensor may not transfer the IP right to a third party without informing this third party of the existence of the license agreement. If he does not inform the third party, then he violates his obligations under the license agreement and also acts in bad faith under the assignment agreement. If the license has been entered into the register the assignee is obliged by law to continue the license agreement.

6. Can IP rights be used to provide security? If so what formalities are required?

As already stated, IP rights can be pledged or assigned for security purposes.

Such assignment or pledging must be entered into the register in order to be binding on third parties.

7. Does the bankruptcy law explicitly provide for the effect of bankruptcy on IP rights and contracts concerning them?

The bankruptcy law does not deal explicitly with IP rights. The general rules are applicable. In the event of bankruptcy, the total assets of the debtor including his IP rights form a sole mass (bankruptcy law, art. 197, no 1).

Art. 211 of the bankruptcy law can have a considerable impact on license agreements, as it provides for the conversion of contractual claims into monetary claims of corresponding value. Practically this often leads to a termination of the contract. However, the administration of the bankrupt estate (a function similar to the receiver in Anglo-Saxon systems) is given the choice to prevent conversion by fulfilling a synallagmatic contract. So if the owner and licensor of IP rights falls into bankruptcy, normally the licensee would lose his rights under the license as these are conversed into a monetary claim. If however, the administration of the bankrupt estate chooses to fulfil the license contract, the contract remains in force under its original terms.

If the administration of the bankrupt estate decides to fulfil the license contract and then sells the IP right to a third party, authors have suggested that the third party acquires the IP right together with all the obligations resulting from the licenses granted. Thus the new owner would be bound by the license agreement. There is no case law on this question however.

Art. 82–83 CO grant the creditor the possibility to hold back his own contribution in the event of insolvency of the other contractual party. If the licensor becomes bankrupt, then the licensee may retain license fee payments, except if there is sufficient surety that he can continue

to exploit the licensed rights as before the bankruptcy. If the licensee goes bankrupt, then the licensor may forbid him to use the licensed rights, unless the licensee, i.e. the appointed executor, gives sureties that the license fees will continue to be paid.

8. Do all intellectual property rights form part of a bankruptcy, or are some exempted?

The registered rights form part of the bankruptcy. Copyright protected objects can be drawn into the bankruptcy. The work of art as such can only fall into the mass if it has been published (copyright law, art. 18) and only to the extent the copyright owner has already exercised his rights.

With regard to inventions or to designs, the Supreme Court is of the opinion that an invention, as long as it is still secret and does not form part of a registered patent, cannot be subject to forced execution or cannot be pledged (Supreme Court 75 III 89).

Certain authors are of the opinion that technical secrets, as well as non-registered trademarks, can be pledged and can be the object of an insolvency procedure (K. TROLLER, Grundzüge des schweizerischen Immaterialgüterrechts, second edition, page 308 ff.).

9. What is the effect of the insolvency or bankruptcy of the licensor and the licensee on a contract regarding intellectual property?

a) Does one party have a right to terminate on the insolvency of the other?

See answers ad 7 above.

b) Can the insolvent party assign the rights concerned?

Since a party to a license agreement may not assign the rights if this is not expressly stipulated in the contract, it is obvious that in the case of insolvency it cannot do so either. If assignment is expressly allowed, it has to be considered that bankruptcy law restricts the bankrupt party's capacity to dispose of its assets. As license agreements constitute assets, only the administration of the bankrupt estate can assign the rights.

c) What effect do express contractual terms have in this situation?

If the contract contains express stipulations for the case of insolvency, then these stipulations will be applicable. However, they only bind the parties. A third creditor may not have to take those stipulations into consideration, unless they would be expressly entered into the register.

10. Is there any statutory or other protection for a licensee / licensor in the event of the insolvency of a licensor / licensee?

See answers ad 7 above.