

ЦИВІЛЬНЕ ПРАВО І ЦИВІЛЬНИЙ ПРОЦЕС; СІМЕЙНЕ ПРАВО; МІЖНАРОДНЕ ПРИВАТНЕ ПРАВО

UDC 347.77/.78-049.7
DOI <https://doi.org/10.32837/chern.v0i5.277>

T. I. Begova
*PhD in Law, Associate Professor,
Associate Professor at the Department of Civil Law № 1
Yaroslav Mudryi National Law University
orcid.org/0000-0001-9132-1157*

MODERN LEGAL MEANS OF TRANSFER OF INTELLECTUAL PROPERTY RIGHTS

For the development of the national economy, an effective system of legal support of relations is formed, which is formed as a result of transformation of intellectual activity results into innovative products and innovations, introduction of intellectual property rights into economic turnover.

Given the expansion and complexity of ways to commercialize intellectual property rights in connection with the acquisition of these rights of various qualities, it is important to study not only the statutory agreements on the disposal of intellectual property rights, but also to develop other legal forms that mediate acts of transfer objects of intellectual property in the field of management.

The purpose of the article is to refine the scientific and theoretical provisions on the legal forms of transfer of intellectual property rights in the field of management. The ways of involving intellectual property rights in the economic turnover within the framework of corporate, contractual, mortgage legal relations are revealed. It is established that the specificity of these relations leaves its mark on the legal forms of transfer of intellectual property rights. It has been found that with the complication of economic relations, the spheres and ways of involving intellectual property rights in economic turnover are expanding. Thus specificity of mechanisms of realization of the specified ways of transfer of the rights causes necessity of working out of the legal form adequate to this specificity.

It is proved that economic and legal regulation of transfer of intellectual property rights does not provide proper definition and differentiation of legal forms of transfer of intellectual property rights in the organization and implementation of economic activities, which should take into account the broad economic potential of these rights. The study substantiates the types of legal forms of transfer of intellectual property rights in the field of management in the case of these rights as: contribution to the formation of the authorized capital of the business organization, contribution to joint activities (simple partnership); use as a subject of pledge and subsequent alienation of the pledged property right as a result of foreclosure on it. On this basis, a conclusion was made about the expediency of improving the economic and legal regulation of relations in the field of transfer of intellectual property rights in terms of normative definition of types of legal forms of transfer of these rights.

Key words: property rights of intellectual property; intellectual property object; legal form; contract; transfer of rights; economic turnover.

Бегова Т. І. СУЧАСНІ ПРАВОВІ ЗАСОБИ ПЕРЕДАННЯ ПРАВ ІНТЕЛЕКТУАЛЬНОЇ ВЛАСНОСТІ

Для розвитку національної економіки формується ефективна система правового забезпечення відносин, яка формується в результаті трансформації результатів інтелектуальної діяльності в інноваційні продукти та інновації, впровадження прав інтелектуальної власності в господарський оборот.

Ураховуючи розширення та складність шляхів комерціалізації прав інтелектуальної власності у зв'язку з набуттям цими правами різної якості, важливим є не лише вивчення статутних договорів про розпорядження правами інтелектуальної власності, а й розробка інших правових форм, посередницькі акти передавання об'єктів інтелектуальної власності у сферу господарювання.

Метою статті є уточнення науково-теоретичних положень щодо правових форм передавання прав інтелектуальної власності у сфері господарювання. Розкрито шляхи залучення прав інтелектуальної власності до господарського обороту в рамках корпоративних, договірних, іпотечних правовідносин. Установлено, що специфіка цих відносин накладає свій відбиток на правові форми передавання прав інтелектуальної власності. Установлено, що з ускладненням економічних відносин розширюються сфери та способи залучення прав інтелектуальної власності до господарського обороту. При цьому специфіка механізмів реалізації зазначених способів передачі прав зумовлює необхідність розробки адекватної цій специфіці правової форми.

Доведено, що економіко-правове регулювання передавання прав інтелектуальної власності не забезпечує належного визначення та диференціації правових форм передавання прав інтелектуальної власності під час організації та здійснення господарської діяльності, що має враховувати широкий економічний потенціал цих прав. У дослідженні обґрунтовано види правових форм передавання прав інтелектуальної власності у сфері господарювання щодо таких прав, як внесок у формування статутного капіталу господарської організації, внесок у спільну діяльність (просте товариство); використання як предмета застави та подальше відчуження заставленого майнового права внаслідок звернення на нього стягнення. На підставі цього зроблено висновок про доцільність удосконалення гос-

подарсько-правового регулювання відносин у сфері передавання прав інтелектуальної власності в частині нормативного визначення видів правових форм передавання цих прав.

Ключові слова: майнові права інтелектуальної власності, об'єкт інтелектуальної власності, організаційно-правова форма, контракт, передавання прав, господарський оборот.

Formulation of the problem. Under the influence of globalization and European integration processes, Ukraine has chosen a course for the development of the national economy according to the innovative model. Achieving this goal requires an effective system of legal support for relations, which are formed in connection with the transformation of the results of intellectual activity into innovative products and innovations, the introduction of intellectual property rights in economic turnover.

The national market of intellectual property rights is in the process of formation. In countries with established innovative economies, the market for these rights is more efficient, as evidenced by the high economic performance of its volumes. In particular, the revenue of the United States, which controls 43% of science-intensive products in the world, from the export of licenses is estimated at 800 billion dollars, Germany – 520 billion dollars, Japan – 400 billion dollars [1, p. 261]. In Ukraine, given the optional nature of state registration of agreements in the field of intellectual property, the real situation regarding the types and scope of contractual implementation of intellectual property rights is not reliably known. In particular, in 2016, 382 copyright agreements were registered, of which 344 – on the alienation of copyright, 38 – license. The number of registrations of agreements on the disposal of industrial property rights was 2,152, of which: 1,953 – the transfer of exclusive property rights, 101 – the issuance of licenses, 98 – “open” licenses for the use of inventions, utility models, industrial designs [2].

At the same time, among the registered facts of transfer of rights, acts of disposition of trademark rights dominate, compared to a small number of patent and license agreements. This clearly reflects the low state of scientific and technological modernization of national industry. Manufacturers focus mainly on the acquisition of brands with a high business reputation of the right holder, including foreign, rather than on the creation of a powerful high-tech production. However, it can be argued that the industrial property market in Ukraine has significant development potential. Thus, as of January 1, 2018, 518,701 security documents were entered into the state registers, including: 120,731 patents, of which: 120 731 patent for inventions, 122,333 patents for utility models, 36,013 patents for industrial designs, 236,469 certificates for marks for goods and services, 13 certificates for IMC topography [3].

Among the existing problems in the field of transfer of intellectual property rights, the imperfect level of regulation of the peculiarities of legal

forms of transfer of these rights occupies a significant place. Normative regulation is limited to general provisions on classical contractual constructions (license agreement, agreement on creation of intellectual property object, agreement on transfer of exclusive property rights) regardless of the specifics of all variety of both intellectual property objects and acts of transfer of rights, therefore, in particular, in the practice of contractual regulation of these relations, established approaches to the legal forms of transfer of intellectual property rights have not yet been formed.

Research analysis. Problems of legal regulation of contractual relations in the field of intellectual property are covered in the scientific works of V. Kryzhna, V. Milash, O. Yavorska, I. Yakubivsky and others. The issues of the place of such agreements among civil law or commercial agreements, the division of agreements in the field of intellectual law according to various criteria, the state registration of these agreements and other aspects are studied.

At the same time, given the expansion and complexity of ways to exercise intellectual property rights in connection with their acquisition of various qualities, it is important to study not only the statutory agreements on the disposal of intellectual property rights, but also to develop other legal forms that mediate various acts of transfer. rights to intellectual property in the field of management.

The purpose of the study is to refine the scientific and theoretical provisions on the legal forms of transfer of intellectual property rights in the field of management.

Contradictions between: non-commodity essence of intellectual property objects and commodity form of their expression have a significant impact on the development of the intellectual property market; the essence of intellectual property as public property and forms of its manifestation as private (individual) property; appropriation of the ideal content of intellectual property objects and appropriation of their material carriers [4]. All of them determine its specificity.

These contradictions necessitate special legislative regulation of economic relations, which form the basis of the turnover of intellectual property rights. Currently, the regulatory regulation of the transfer of intellectual property rights is based on a set of legal requirements that establish: 1) general provisions on economic obligations and economic agreements defined in Chapters 19, 20 of the Commercial Code of Ukraine [5]; general provisions on transactions, agreements in the Civil Code of Ukraine, which are

applied on a subsidiary basis in the absence of special provisions in the Civil Code of Ukraine [6], 2) features of disposition of property rights in the field of intellectual property: Chapter 36 of the Civil Code of Ukraine, Art. 331 of the Civil Code of Ukraine; Chapters 75, 76 of the Civil Code of Ukraine, special laws in the field of industrial property (parts 6–9 of Article 28 of the Law of Ukraine “On protection of rights to inventions and utility models” [7]; parts 4–7 of Article 20 of the Law of Ukraine “On protection of industrial designs” [8]; Parts 7–9 of Article 16 of the Law of Ukraine “On protection of rights to marks for goods and services” [9].

The given location of the normative array reflects the processes of functional specialization in law, which, according to O. Belyanevych, is manifested in the “load distribution” as between the norms of one industry affiliation (general rules governing the procedure for concluding, amending, terminating business contracts, their content, implementation, etc.) and special rules governing certain types of business contracts, taking into account their specifics) and the rules of civil law (general provisions on contracts, obligations, knitting) [10].

At the same time, in the field of intellectual property, the processes of functional specialization are not fully provided. Economic and legal regulation of the transfer of intellectual property rights does not provide proper definition and differentiation of legal forms of transfer of intellectual property rights in the process of organization and implementation of economic activity, which should take into account the broad economic potential of these rights in terms of meeting the various economic interests of economic entities.

The current legislation establishes an exhaustive list of types of agreements on the disposal of intellectual property rights: license agreement, agreement on the creation and use of intellectual property rights, agreement on the transfer of exclusive intellectual property rights, other agreement on the disposal of intellectual property rights (h 1 Article 1107 of the Civil Code of Ukraine) [6].

At the initial stage of development of the market of intellectual property rights in Ukraine, these contractual designs fully met the needs of participants in intellectual property relations. Over time, the market has developed the practice of concluding unnamed agreements in this area (non-disclosure agreement, transfer of know-how) [11], as well as mixed agreements, which contain conditions (elements) specific to different types of agreements, including the disposal of intellectual property rights. (contract of sale of the enterprise as a single property complex, which includes intellectual property rights; contract for the creation of advertising, which defines the conditions of use of intellectual property rights).

With the complication of economic relations there is an expansion of areas and ways to involve intellectual property rights in economic turnover. Businesses are gradually realizing the possibility of obtaining economic benefits from various acts of commercialization of rights to intellectual products, in particular, by making them as a contribution to the authorized capital of a legal entity, use as collateral, involvement in joint activities, etc. Thus specificity of mechanisms of realization of the specified ways of transfer of the rights causes necessity of working out of the legal form adequate to this specificity.

Not all methods of transfer of intellectual property rights can be mediated only by enshrined in Art. 1107 of the Central Committee of Ukraine by contractual designs.

The transfer of intellectual property rights as a contribution to the authorized capital of a corporate organization gives the right holder the opportunity to expand its economic potential, to acquire corporate rights without spending in the process of such investment of cash, movable or immovable property. Legislative regulation of these relations is limited to general permits that intellectual property rights can be transferred as a contribution to the authorized capital of the business entity (Part 5 of Article 156, Part 6 of Article 157 of the Civil Code of Ukraine).

In practice, participants in corporate relations use different options for making such a contribution, in particular: draw up an act of transfer of rights, enter into a preliminary agreement or agreement of intent (if the rights are made to the newly created legal entity). The Supreme Commercial Court of Ukraine in paragraph 5.1 of the resolution of the Plenum of October 17, 2012 № 12 “On some issues of dispute resolution practice related to the protection of intellectual property rights” states: in addition to indicating this in the memorandum of association requires the conclusion of a separate agreement on the transfer of exclusive rights, and in cases provided by law, – as well as the state registration of such a separate agreement” [12].

This approach makes sense from a practical point of view, because, firstly, there is no separate regulation of the procedure and legal form of transfer of intellectual property rights in corporate relations, and secondly, the law establishes a mandatory written agreement on the disposal of such rights.

At the same time, the founding relations in the field of creating a corporate organization have their own specifics, which affects the legal form of transfer of rights to intellectual property. The founding revelation, as noted by V. Kravchuk, is expressed externally in the form of a transaction or administrative act of an administrative nature (depending on the type of legal entity). In this case, the legal entity acts as a special legal form of

achieving the interests of the founder [13]. Therefore, there is a difference in the mechanisms and, accordingly, the legal form of realization of the rights holder in the case of investing intellectual property rights in the authorized capital and the transfer of these rights on the basis of a license agreement or agreement on alienation. The latest agreements are aimed at obtaining income from the right holder from the complete alienation of rights or granting permission for their temporary use, and not in acquiring the status of a member of a corporate organization.

The mechanism of interaction of the founders in the process of determining the conditions and procedure for the formation of authorized capital is of a different nature. Their expression of will is aimed at determining, among other things, the legal regime of the property of the created corporate organization, which is fixed in the founding documents. The functions of the latter, depending on the organizational and legal form of the legal entity, perform the memorandum of association or charter.

In this case, if the memorandum of association has the characteristics of a contract, the charter is not given such a meaning (its effect is mainly related to the definition of the principles of management and operation of the company). In view of this, for companies that operate on the basis of the statute (for example, limited liability companies (LLC)) and are created by more than one person, the law provides for the possibility, if necessary, to enter into a “partnership agreement”, which is not is (Article 142 of the Civil Code of Ukraine), but is important at the stage of coordination of joint actions of organizational and property nature to create and ensure the activities of a legal entity, in particular regarding the terms and procedure for transferring property deposits.

Thus, at the stage of founding a corporate organization, the founders have a binding legal relationship, but they do not aim to mediate the fact of disposal of property – the contribution of the founders, but aimed at coordinating joint actions to form the authorized capital of the legal entity through their contributions.

This indicates that the conclusion of a license agreement or an agreement on the alienation of exclusive rights for the transfer of contributions – property exclusive rights does not correspond to the nature and purpose of the relationship, arising between the founders at the stage of creation of a legal entity, as well as between the founders and the created legal entity. The deposit of property rights by the founder is carried out by transfer of this right, which is made in fulfillment of obligations under the memorandum of association or the agreement on the establishment of the company and is confirmed by the act of transfer of property rights.

Thus, the procedure and legal form of transfer of intellectual property rights as a contribution to the authorized capital of a corporate organization includes: the conclusion of a memorandum of association (or agreement on the establishment of a company – for legal entities acting on the basis of the charter), which contains provisions on the introduction of intellectual property rights; transfer of rights by the founder, which is confirmed by the act of transfer; state registration of the transfer of rights to industrial property, which are valid after their state registration.

The use of intellectual property rights as collateral is a relatively new and underdeveloped method of contractual realization of these rights in Ukraine. National practice in this area shows that currently the predominant facts of involvement in the mortgage relationship are the rights to trademarks.

The analysis of the general provisions of the pledge legislation gives grounds to define the legal form of realization of intellectual property rights within the mortgage relationship as such, which includes: a pledge agreement, which enshrines the will of the right holder to provide satisfaction to the creditor an act of alienation of the pledged right, which is committed as a result of foreclosure on it in the manner prescribed by law or contract. To ensure proper legal registration of the transfer of rights to industrial property in the event of foreclosure on them as collateral to another person (creditor, buyer of rights to public auction, etc.) need to supplement the range of grounds necessary for state registration of the transfer of rights to inventions, utility models, industrial designs, marks for goods and services, as in the bylaws such grounds include only a license agreement and a contract for the transfer of ownership of an invention, industrial design, mark for goods and services. Among the documents confirming the fact of transfer of intellectual property rights within the mortgage relationship, should be provided by a notary issued a certificate of acquisition of mortgaged property at public auction, a certificate of acquisition of mortgaged property at auction, certificate of transfer of property to the collector or a contract to meet the requirements of the mortgagee.

The next way to commercialize intellectual property rights is to make them a contribution to joint activities. The legal form of such transfer of rights is also not defined in the legislation. In accordance with Part 1 of Art. 1133 of the Civil Code of Ukraine, the contribution of a participant in joint activities is “everything he contributes to joint activities, including cash, other property, professional and other knowledge, skills and abilities, as well as business reputation and business connections”. The legal regime of joint partial ownership shall be established in respect of the property contributed by the

participants, unless otherwise provided by a simple partnership agreement or law (Part 1 of Article 1134 of the Civil Code of Ukraine).

However, it should be noted that the construction of property rights, including joint partial ownership, does not apply to intellectual property rights, the objects of which are intangible assets.

For legal mediation of introduction of intellectual property rights to joint activity two models of transfer of the rights depending on the purpose, conditions of realization of joint activity, character of relations between its participants can be applied:

1. Granting permission for temporary use of intellectual property to partners in joint activities (in this case, there will be an agreement on joint activities of a different property regime than joint partial ownership, which is allowed by Article 1134 of the Civil Code of Ukraine); such a model protects the right holder in case of expiration of a simple partnership agreement or refusal of one of the participants to further participate in joint activities, the need to re-register patent rights, resolve conflicts with partners on the "division" of joint property rights, etc.; the legal form of transfer of rights in this case should be considered a simple partnership agreement, which should contain provisions on granting one of the participants to other participants a temporary permit for the use of an intellectual property object specifying the conditions, methods, territory of joint use of this object (the so-called "license component of the agreement on joint activity").

2. Transfer of property rights on the terms of its alienation and the establishment of a regime of joint ownership of this right by members of a simple partnership (ie participants in joint activities become, for example, co-owners of a patent). This model of transfer of deposit actually leads to the "splitting" of powers that constitute the content of intellectual property rights, between several entities and converts the depositor from a sole proprietor to one of the co-owners.

Thus, the specificity of the considered corporate, contractual, mortgage legal relations leaves its imprint on the legal forms of transfer of intellectual property rights. Unresolved issues of formal and legal qualification of legal forms of transfer of rights in these relations leads to uncertainty of the specific mechanism of disposal of these rights, the scope of rights of the owner and acquirer (user), their relationship in the use of industrial property, in case of termination of patent (certificate), invalidation, etc.

Conclusions. Analysis of modern legal forms of transfer of rights to the results of intellectual

activity proves the imperfection of the legal regulation of these relations. Today, the legal forms of transfer of intellectual property rights in the case of these rights are: contribution to the formation of the authorized capital of a business organization, contribution to joint activities (simple partnership); use as a subject of pledge and subsequent alienation of the pledged property right as a result of foreclosure on it. The trend is to further expand the methods and areas of commercialization of intellectual property rights, due to the objective need to increase the share of innovation-oriented manufacturers, increase their competitiveness and adaptability in modern conditions.

References

1. Швандар В., Горфинкель В. Инновационный менеджмент: Учебник / под ред. Швандара В.А., Горфинкеля В.Я. Москва : Вузовский учебник, 2004. 382 с.
2. Річний звіт за 2016 рік. URL: www.uipv.org/i_upload/file/AnnualReport/zvit6.pdf
3. «Станом на 1 січня 2018 року (з 1992 року) до державних державних реєстрів внесено охоронний документ на ОПВ» (Укрпатент), 2018. URL: <http://www.uipv.org/ua/vsjogo.html>.
4. Базилевич В.Д. Тенденції розвитку та суперечності сучасного ринку інтелектуальної власності URL: http://ir.znau.edu.ua/bitstream/123456789/7407/1/IEHTaNP_2016_9-15.pdf
5. Господарський кодекс України : Закон України від 16 січня 2003 р. № 436-IV. *Відомості Верховної Ради України*. 2003. № 18, № 19–20, № 21–22. Ст. 144.
6. Цивільний кодекс України : Закон України від 16 січня 2003 р. № 435-IV. *Відомості Верховної Ради України*. 2003. № 40–44. Ст. 356.
7. Про охорону прав на промисловий зразок : Закон України від 15 грудня 1993 р. № 3688-ХІІ. *Відомості Верховної Ради України*. 1994. № 7. Ст. 34.
8. Про охорону прав на винаходи і корисні моделі : Закон України від 15 грудня 1993 р. № 3687-ХІІ. *Відомості Верховної Ради України*. 1994. № 7. Ст. 32.
9. Про охорону прав на знаки для товарів і послуг : Закон України від 15 грудня 1993 р. № 3689-ХІІ. *Відомості Верховної Ради України*. 1994. № 7. Ст. 36.
10. Беляневич О. Про спеціалізацію в правовому регулюванні господарських договірних відносин. *Право України*. 2010. № 8. С. 66.
11. Яворська О. Договір у сфері інтелектуального права: проблеми захисту прав інтелектуальної власності. URL: <http://arhd.ua/publication-166>.
12. Про деякі питання практики вирішення спорів, пов'язаних із захистом прав інтелектуальної власності : Постанова Пленуму Вищого Господарського Суду Вищого Господарського суду України від 17 жовтня 2012 р. № 12. *Вісник господарського судочинства*. 2012. № 6.
13. Кравчук В. Корпоративне право : науково-практичний коментар законодавства та судової практики. Київ : Істина, 2005.