

QUESTION 97

Dependent patents and their exploitation

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Q97

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Resolution

- A. 1. A dependent patent is a patent which as a matter of law cannot be worked without falling within the scope of protection of another patent. The latter patent will be referred to as the dominant patent.

By way of examples of dependent patents, mention may be made of a patent which protects a novel process for the <production of a product which is protected by the dominant patent, a patent granted in respect of a novel application of a product or a process protected by the dominant patent, or an improvement patent.

2. Consequently, use of the patent would constitute infringement of the dominant patent. That means that in principle the proprietor of the dependent patent must obtain consent from the proprietor of the dominant patent for working his invention. Likewise the proprietor of the dominant patent cannot work the invention of the dependent patent without having obtained consent from the proprietor of the dependent patent. That is the normal consequence of the basic principle of patent law which is a prohibition right.

3. In some countries that principle is applied in its entirety and with full effect. In other countries there is an exception to that principle if it is considered that a compulsory licence should be granted in the public interest. Finally, a large number of other countries have laid down legislative provisions for granting a compulsory licence to permit the proprietor of a dependent patent to work his invention if he does not obtain consent from the proprietor of the dominant patent. It is that compulsory licence of dependency that this Resolution concerns.

- B. AIPPI affirms that a compulsory licence of dependency constitutes a serious derogation from the fundamental right of the patentee, which runs the risk of being

reduced to a simple right to recompense. Consequently AIPPI is opposed to the principle of compulsory licences of dependency, and affirms that at the least if provision were made for such licenses in domestic law, such licences could be granted only if extremely strict conditions were met.

C. Noting that many countries make provision in their domestic law for a compulsory licence of dependency which is granted under different conditions from one country to another, AIPPI considers that the conditions under which such a licence is to be granted should be harmonised and should comprise at least all of the following:

- a) considerable importance of the invention of the dependent patent;
- b) that the invention of the dependent patent cannot be worked at all without the licence;
- c) payment of fair compensation to the owner of the dominant patent having regard to the particular circumstances of the case, which compensation should be higher when the two patents are worked in competition with each other;
- d) that the licence be non-exclusive and not freely transferable;
- e) grant of a licence on the dependent patent to the proprietor of the dominant patent if the latter so wishes.

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