

Know-How As An Alternative For The Patent Form Of Protection Of Technical Solutions

Irik Sabirzhanovitch Mukhamedshin¹, Maya Igorevna Evdokimova², Taliko Emzarievna Tapatadze³, and Valeriya Borisovna Zolotova⁴

Abstract

The authors note that the practical study of progressive technical solutions is one of the most important areas of innovation. Traditionally, technical solutions are protected as objects of patent law. Federal Law No. 35-FZ of 12.03.2014 limited the range of information protected in the know-how mode to information only on the results of intellectual activity in the scientific and technical sphere and methods of conducting professional activities. It is concluded that know-how becomes an alternative to the patent form of protection of technical solutions.

Keywords: technical solution, know-how, patent law

Introduction

Technical solutions make up a significant proportion of the protected results of intellectual activity. Traditionally, they are objects of patent and legal protection [7][8].

According to clause 1 of Article 1350 of the Civil Code of the Russian Federation (hereinafter referred to as the Civil Code of the Russian Federation), a technical solution in any field related to a product (in particular, a device, substance, strain of a microorganism, plant or animal cell culture or a method (the process of performing actions on a material object with the help of material means), including the use of a product or method for a specific purpose), is protected as an invention that is a protectable object of patent rights (Article 1349 of the Civil Code of the Russian Federation). The technical solution related to the device can also be protected as a utility model (Article 1351 of the Civil Code of the Russian Federation). It should be noted that the rules and methods of economic activity under Russian law are not inventions (paragraph 4 of paragraph 5 of Article 1350 of the Civil Code of the Russian Federation), although in some countries (for example, in the USA) patents for inventions are issued for them.

Technical solutions and methods of carrying out professional activities according to the current Russian legislation can also be protected as know-how [7][8]. This follows from the analysis of Article 1465 of the Civil Code of the Russian Federation, according to which information of any nature is recognized as a secret of production (know-how) (production, technical, economic, organizational and others) on the results of intellectual activity in the scientific and technical sphere and on the methods of carrying out professional activity (highlighted by me - I.M.). The results of intellectual activity in the scientific and technical sphere that meet the requirements for inventions and utility models established by the Civil Code of the Russian

Federation are objects of patent rights (paragraph 1 of Article 1349 of the Civil Code of the Russian Federation).

It should be noted that the restriction of the range of objects protected as know-how to the two above-mentioned (technical solutions and methods of professional activity), introduced by Federal Law No. 35-FZ of 12.03.2014, contradicts the Agreement on Trade Aspects of Intellectual Property Rights (TRIPS) - one of the basic WTO agreements, which does not limit the range of information that can be protected as "closed" ("undisclosed", "undisclosed") information [5][6].

Materials and methods

The study is based on data from 2019 to 2021, including use of statistical data studies in the Know-how usage field. In the preparation of the material an author used methods of analysis, comparison, conclusion, generalization.

Results

A common technical solution protected by patent law and know-how as a technical solution is that, in accordance with Article 1225 of the Civil Code of the Russian Federation, inventions and utility models, as well as production secrets (know-how) are classified as protected results of intellectual activity, for which, according to Article 1226 of the Civil Code of the Russian Federation, intellectual rights are recognized, which include an exclusive right, and in cases provided for by the Civil Code of the Russian Federation, also personal non-property rights. The exclusive (property) right is assigned to the rightholder, and personal non-property rights belong to the author of the result of intellectual activity (in this case, the author of the invention, utility model and know-how).

The author of the result of intellectual activity is recognized as a citizen whose creative work created such a result (paragraph 1 of Article 1228 of the Civil Code of the Russian Federation, highlighted by me - I.M.). In Chapter 72 of the Civil Code of the Russian Federation "Patent law", the combination of "author (co-author) of an invention, utility model" is quite common (see, for example, articles 1345, 1347, 1348, 1356, etc. Civil Code of the Russian Federation). The criteria for the creative nature of the work of the author of the invention are, in particular, novelty and inventive level (paragraph 1 of Article 1350 of the Civil Code of the Russian Federation, utility model - novelty (paragraph 1 of Article 1351 of the Civil Code of the Russian Federation). None of the eight articles of Chapter 75 of the Civil Code of the Russian Federation "The right to the secret of production (know-how)" contains the word "author".

Nevertheless, in Article 1465 of the Civil Code of the Russian Federation, the legislator refers to the criteria for the protection of know-how as "actual or potential commercial value", "unknown information to third parties", the absence of third parties "free access to know-how on a legal basis", "the owner of the information takes reasonable measures to respect their confidentiality". The fact of the applicability of the concept of "creation" to know-how is confirmed by Article 1470 of the Civil Code of the Russian Federation. From the above, it can be concluded that the know-how may have an author who created it through creative work, which is qualified by a person with relevant information (most often an employer).

Discussion

In the case of an invention and utility model, the exclusive right and the right of authorship are certified by a patent - a document issued by the State after conducting an appropriate examination. As one author said, the validity period of the exclusive right was calculated from the priority date [10].

The exclusive right to know-how arises at the time of the introduction of the confidentiality regime of the information constituting its content, which is confirmed by an act of an economic entity (for example, an order for the organization in which the know-how was created). The state registration of know-how and rights to it is not provided for by the legislation of the Russian Federation. According to paragraph 2 of Article 1466 of the Civil Code of the Russian Federation, a person who has become in good faith and independently of other know-how holders the owner of the information constituting the content of the know-how acquires an independent exclusive right to this know-how. From the moment of loss of confidentiality of the relevant information, the exclusive right to know-how is terminated for all copyright holders (Article 1467 of the Civil Code of the Russian Federation).

It should be noted that according to Federal Law No. 35-FZ of 12.03.2014, which amended Article 1465 of the Civil Code of the Russian Federation, the introduction of a trade secret regime for the protection of information as know-how is not mandatory, but is considered as one of the possible measures to respect its confidentiality.

Analysis of the norms of the Civil Code of the Russian Federation and the Federal Law "On Trade Secrets" dated July 29, 2004 No. 98-FZ (hereinafter, Federal Law No. 98) confirms the existence of two ways of legal protection of commercially valuable information about technical solutions and ways of carrying out professional activities.

The first is as a know-how (the secret of production). In this case, the "owner" of such information (know-how) is the owner of the exclusive right to it as a result of intellectual activity, i.e. an intangible object.

According to the special literature, information of any nature (production, technical, economic, organizational and others), including the results of intellectual activity in the scientific and technical field, as well as information about the methods of professional activity that have actual or potential commercial value due to their unknown to third parties, to which third parties do not have free access on a legal basis and in respect of which the owner of such information has introduced a trade secret regime, is recognized as a secret of production (know-how)[9].

One of the most important advantages of know-how, in my opinion, is the absence of mandatory state registration requirements. It is this criterion that is often decisive for the copyright holder when choosing a method of protecting confidential information. Indeed, in order for information to be considered a secret of production and protected by law, only a number of measures are required, provided by the copyright holder himself; and of course compliance with the criteria established by Article 1465 of the Civil Code of the Russian Federation.

The second is as information constituting a trade secret. In this case, the "owner" of the information is the owner of the relevant information in inseparable connection with the material carrier (thing) on which it is fixed. Such transfer of a tangible medium does not entail, in accordance with paragraph 2 of Article 1227 of the Civil Code of the Russian Federation, the transfer or granting of intellectual rights to information expressed in this tangible medium [3, 4].

According to Article 1233 of the Civil Code of the Russian Federation, the holder of the exclusive right to know-how may dispose of the exclusive right belonging to him in any way that does not contradict the law and the essence of such exclusive right, including by alienating it to another person or granting another person the right to use know-how within the limits established by the license agreement. As the most common cases of using know-how, the legislator in paragraph 1. of Article 1466 of the Civil Code of the Russian Federation identifies the manufacture of products and the implementation of economic and organizational solutions.

Conclusion

In case of alienation of the exclusive right, the person who has disposed of his right (the rightholder) is obliged to maintain the confidentiality of the know-how until the termination of the exclusive right to know-how (Article 1468 of the Civil Code of the Russian Federation). If the term for which the license agreement is concluded is not specified in this agreement, either party has the right to withdraw from the agreement at any time by notifying the other party no later than six months in advance, unless the agreement provides for a longer period (clause 2. 1469 of the Civil Code of the Russian Federation). Clause 3. of Article 1469 of the Civil Code of the Russian Federation defines the obligations of the licensor and the licensee to preserve the confidentiality of know-how.

Unlike patent law, the exclusive right to service know-how belongs to the employer. The norm contained in paragraph 1. of Article 1470 of the Civil Code of the Russian Federation is imperative.

Protection in the know-how mode is preferable in comparison with the patent form in the case of methods where it is not possible to prove their use. Information about technical solutions that are not reflected in the description of the application for an invention or utility model may be protected as know-how. In the absence of sufficient means to ensure patent protection, in particular, in the case of foreign patenting, know-how seems to be the only way to ensure legal protection of technical solutions [1, 2].

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